Supreme Court, U.S.
FILED

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No. _____ OFFICE OF THE CLERK

IN THE
SUPREME COURT OF THE UNITED STATES

MARTHA ROBI

Petitioner,

v.

HERBERT REED, JOHN VILLANO,
J.P. PRODUCTIONS

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

PETITION FOR WRIT OF CERTIORARI

MARTHA ROBI
IN PRO SE

10737 RIVERSIDE DRIVE
NORTH HOLLYWOOD, CA 91206
(818) 763-6289

BECKER GALLAGHER LEGAL PUBLISHING, INC., CINCINNATI, OHIO 800-890-5001

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QUESTIONS PRESENTED

1. Must the Ninth Circuit Court of Appeals adhere to the decisional authority of both the Supreme Court, and its own published case authority with regard to the doctrine of claim and issue preclusion, and give preclusive effect to the last judgment in time when confronted by two (2) or more inconsistent judgments?

2. Is the Ninth Circuit precluded from establishing a federal partnership law, and must the Ninth Circuit apply the partnership law of the applicable state in resolving a state partnership law issue?

3. Must the Ninth Circuit follow the established doctrine of trademark law ownership, and not find simultaneously both that Respondent Reed has rights to the trademark "The Platters," thereby upholding the District Court's injunction of Petitioner Robi's rights of thirty (30) years duration, and at the same time hold that the Circuit Court make no determination that Respondent Reed has any rights in the trademark "The Platters?"

PARTIES TO THE PROCEEDING

Petitioners

Martha Robi. Martha Robi is not a corporate entity.

Respondents

Herb Reed, John Villano, J.P. Productions. Petitioner Martha Robi represents on information and belief that none of the Respondents are corporate parties.

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OPINIONS BELOW

The Opinion of the United States Court of Appeals for the Ninth Circuit is reported at 173 F.3d 736 (9th Cir. 1999). A copy of the Opinion is included in the Appendix at Appendix A at page 1a. The opinion of the District Court for the District of Nevada is unpublished, and is included in Appendix C at 12a.

JURISDICTION

The United States Court of Appeals for the Ninth Circuit issued its Opinion on April 2, 1999. (App. A at 1a.) Petitioner requested and received an additional one (1) week extension to file its Petition for Rehearing and Suggestions for Rehearing En Banc. Petitioner timely filed a Petition for Rehearing and Suggestion for Rehearing *En Banc*, which the United States Court of Appeals denied on May 28, 1999. (Appendix D at 25a.)[1] This Petition for Writ of Certiorari is filed within ninety days of the denial of the Petition for Rehearing. The Court's jurisdiction is invoked pursuant to 28 U.S.C. §§ 1254(1) and 2106.

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[1] Citations to "App." are to the appendix filed with this Petition for Writ of Certiorari pursuant to Supreme Court Rule 14(i).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Const., art. VI, cl. 2
Supremacy Clause

This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any thing in the Constitution or Law of any State to the Contrary notwithstanding.

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U.S. Const., art. I section 8, cl. 3
Commerce Clause
The Congress shall have Power. . .

To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.

STATEMENT OF THE CASE

The following facts pertaining to the conflicting claims to the tradename "The Platters" are either specific adjudicated facts directly quoted as findings of the prior January 27, 1988 Ninth Circuit Opinion, Robi v. Five Platters, Inc., (FPI), and Williams v. FPI, 838 F.2d 318 (9th Cir., 1990) (App. E at 26a), which upheld the May 22, 1985, District Court Order and Findings (App. F at 55a), which adopted the November 14, 1974, California State Court Findings (App. G at 67a), or are facts not in dispute.

1. "In 1953, a singing group named The Platters was formed and struggled to gain recognition. By 1954, the group consisted of five performers (known) as the 'original' Platters." (App. E at 28a, App. F at 57a, App. G at 68a.)

2. "During the years 1954 thru 1959, this group became enormously popular, made 12 'gold' records...appeared on nationwide television shows and made concert tours." (App. E 28a, App. F at 57a, App. G at 68a). The five (5) "original Platters," were Tony Williams, David Lynch, Zola Taylor, Paul Robi, and Herbert Reed (App. E at 27a, App. F at 56a, App. G at 68a).

3. "In January 1956, when the group began to achieve worldwide popularity, its manager and musical director, Buck Ram, suggested that a corporation be formed. "...the Corporation was incorporated under the name 'The Five Platters, Inc.' ("FPI"). "...original Platters...Robi and Williams (and the four (4) other original Platters) executed employment contracts with the Corporation. They assigned to the Corporation their rights in the name THE PLATTERS...." (App. E at 28a, App. F at 58a, App. G at 69a.)

4. "Robi was the only Platter who had had musical training. When he joined the group, he assisted the other Platters with musical arrangements, and organized and led the group's rehearsals." (App. F at 57a.)

5. From 1965 to May 22, 1985, the date of the District Court Order, which made this finding (App. F at 66a) "...there have been two performing groups known as 'The Platters.' One group is controlled by Buck Ram and his corporation, The Five Platters, Inc. The other group is Robi's." (App. F at 58a.)

6. As of 1966, three "original platters," Paul Robi, Zola Taylor and Tony Williams, had left the FPI group, and had formed their rival Platters group. "Robi then formed his own group called The Platters." (App. F at 58a), (App. O at 111a (Jan., 1966 Picture of three "original platters," Taylor, Robi and Williams as ("the rival") Platters, after leaving the FPI group.) As of 1966, the fourth "original platter," David Lynch had also left the FPI group. For a limited time, "original platter," David Lynch performed with the rival Paul Robi Platters, and thereafter ceased performing. (David Lynch is now deceased.)

7. As of 1967, of the five "original platters," only one "original member," Respondent Herbert Reed, remained with the FPI Corporation group. In 1967, "original Platter" Herbert Reed, on behalf of FPI Corporation and as the President of the Five Platters Inc., Corporation, asserted in California State Court, in a FPI Corporation action brought to prohibit defendants in that action, "original platters" Robi and Taylor (App. P at 112a), from performing as "The Platters," that the employment agreements between the original platters, and FPI Corporation was valid (App. P at 114a) and that the FPI Corporation owned all rights to the name "The Platters." (App. P at 116a). On July 22, 1968,

Respondent Reed, as President of and on behalf of FPI Corporation, wrote a letter to The American Guild of Variety Artists attempting to prohibit "original platters," Robi and Taylor from performing as "The Platters." (App. CC at 208a).

8. In 1974, in a California State Court action by FPI Corporation, to prohibit "original platter" ROBI from performing as The Platters: "The Corporation claimed it owned the exclusive right to the name `THE PLATTERS' based upon the assignments it had received from Robi and the other original Platters." (App. E at 29a, App F at 60a, App. G at 67a.) "The California Superior Court...granted judgment in 1974 in favor of Robi." (App. E at 29a, App F at 60a, App. H at 73a.) "The California Court determined (vis-a-vis ROBI) that the Corporation...was a sham used by Mr. Ram to obtain ownership of the name `Platters,'...that the Corporation's issuance of stock to the original platters was `illegal and void' because the stock was issued in violation of California's corporate securities law." (App. E at 29a, App. F at 61a.)

9. In 1984, ten (10) years after the 1974 California State Court decision (App. G at 67a), the FPI Corporation again sued Paul Robi in Federal Court to prohibit him from performing as The Platters. Based upon the November 14, 1974 California State Court Decision (App. G at 67a) on May 22, 1985, the District Court dismissed the FPI Corporation subsequent FPI Corporation Federal Court action against Robi (App. F at 55a), which decision was upheld in Jan., 1988, by the Ninth Circuit (App. E at 39a).

10. During the fifteen (15) year period from January 1, 1974, prior to the California State Court decision in favor of Robi (App. G at 67a) to November 14, 1990 (the date of the Second Ninth Circuit Appellate Court Decision in

favor of Robi, Robi v. FPI, 918 F.2d 1439 (9th Cir. 1990) (App. I at 75a), each of the five "original Platters," each acting independently of the other "original platter" undertook the following with regard to their claims of rights in the tradename "The Platters:"[2]

(1.) On February 1, 1974, "original Platter," Zola Taylor in D. Colo., FPI v. Taylor, No. C-5249, stipulated to the entry of a permanent injunction in favor of the FPI Corporation as against Taylor. (App. E at 31a (Note 1).) (As of 1999, Zola Taylor apparently has health problems and no longer performs.)

(2.) On February 26, 1974, "original platter," Tony Williams "...petitioned the Trademark Trial and Appeal Board to cancel the Corporation's registration of the service mark, THE PLATTERS, (which petition was) "...rejected when he (Williams) failed to respond to the Corporation's motion for summary judgment." Williams v. Five Platters, Inc., 181 U.S.P.Q. (BNA) 409, 409-10 (Feb. 26, 1974), aff'd 510 F.2d 963 (C.C.P.A. 1975) (App. E at 29a). "Several years later, the Corporation filed an action against Williams in the Supreme Court of the State of New York." "The New York Court permanently enjoined Williams from using the name THE PLATTERS except to refer to his previous membership in the group, and concluded that Williams was

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[2]

During the 1970's though "original platters" Paul Robi, Zola Taylor and Tony Williams each performed as their own Platters group, they apparently took no action adverse to each other's use of the name "The Platters," as between Robi, Williams and Taylor. Original Platter Reed never performed with Robi's, Williams' and Taylor's group after they left the FPI Corporation group in the early 1960's.

"barred by res judicata from challenging...the decision of the Court of Customs and Patent Appeals...." (App. E at 30a.) (Williams passed away in the early 1990's.)

(3.) Original Platter David Lynch retired from performing, and passed away in the 1980's.

(4.) As to Respondent Reed, on April 1, 1975 (five (5) months after Robi's November 14, 1994 favorable State Court Decision against the FPI Corporation) (App. G at 72a), Respondent Reed entered into an agreement with the FPI Corporation (App. Q at 120a), where Respondent Reed retroactively ratified Respondent Reed's ownership interest in FPI Corporation for the period of time when FPI was in litigation with Robi (App. Q at 121a, 122a), and Respondent Reed thereafter agreed with FPI to perform as a licensee as "Herb Reed Formerly of The Platters and His Group" (App. G at 124a) of FPI Corporation and assist the FPI Corporation in its efforts to enforce its "exclusive rights" in the trademark "The Platters." (App. Q at 125a.) After Respondent Reed entered into the April 1, 1975 Agreement (App. Q at 120a), apparently for ten years, from April 1, 1975, to sometime in 1986, Respondent Reed, as a licensee of FPI Corporation, under the April 1, 1975 Agreement with FPI Corporation (App. Q at 125a) performed with his group called "Herbert Reed and The Platters."

(a) In 1986, Respondent Reed and the FPI sued each other in Florida District Court over the April 1, 1975 Agreement, over the ownership rights to the FPI Corporation Stock and over the rights to the tradename "The Platters." (App. K at 95a, App. L at 99a.) On May 5, 1987, in the Florida District Court litigation between the FPI Corporation and Respondent Reed, Respondent Reed sought summary judgment against FPI Corporation, now based upon the favorable Robi November 11, 1974 State Court Decision

(App. L at 100a, which references App. G) and also based upon the favorable Robi May 22, 1985 District Court Decision, (App. L at 100a which references App. F).

(b) On May 5, 1987, the Florida District Court denied Respondent Reed's motion requesting a finding of "collateral estoppel" against FPI Corporation based upon the State Court 1974 (App. G) and the 1985 (App. F) District Court Decisions against FPI Corporation, and held: "However, this denial is without prejudice to the Defendant (REED) renewing his Motion for Summary Judgment should Judge Marshall's decision (App. F at 55a) be upheld by the Ninth Circuit prior to trial." (App. L at 100a.)

(c) Respondent Reed does not wait (or cannot wait) for what thereafter became the Jan. 27, 1988 Ninth Circuit decision (App. E at 26a) "... upholding Judge Marshall's decision" (App. F at 55a), and on December 19, 1987, Respondent Reed stipulates to a final District Court Order of Settlement in the Florida District Court action, affirming the FPI Corporation's rights to the tradename "The Platters" (App. K at 96a), with the Corporation FPI granting to Respondent Reed a "lifetime," license (other than with regard to "audio or video recordings") to utilize the designation "Herb Reed and the Platters," or as "Herb or Herbert Reed of the Original Platters...." (App. K at 96.)

(d) The December 10, 1987 Florida District Court Final Order with regard to both Respondent Reed's claims against FPI Corporation, and FPI Corporation's claims against Reed provided that: "The instant action and all other actions between the parties in this and any other court shall be dismissed with prejudice." (App. K at 95a.)

(e) After the entry of the Florida District Court Settlement Order of December 19, 1987 (App. K at 95a),

apparently (from December 10, 1987 to the present) Respondent Reed, in his capacity as a licensee of the FPI Corporation under the December 10, 1987 Final Order of Settlement (App. K at 96a) continued to perform as a performing group entitled "Herbert Reed and The Platters."

(5.) After the entry of the May 22, 1985, District Court Order where "original platter" Paul Robi prevails and obtains dismissal of the FPI D.C. Action brought against Robi (App. F at 55a), "original platter," Williams then seeks collateral estoppel against FPI in the same District Court of California based upon the May 22, 1985 favorable Robi District Court decision against FPI (App. E at 40a). The District Court grants Williams' motion (App. E at 40a), based upon its own favorable Robi v. FPI judgment, which favorable judgment as to Williams as against FPI is then reversed by the Ninth Circuit under the "last in time rule," in the same Ninth Circuit decision (App. E at 47a, 54a), which upheld the Robi District Court decision. (App. E at 39a.)[3]

(6.) In 1989, the District Court conducts a trial as to Paul Robi's claims against FPI Corporation for tortious business interference. Paul Robi prevails, and is awarded $1,510,000.00 in compensatory, and $2,000,000.00 in punitive damages (App. J at 91a). Paul Robi dies of cancer in February, 1989, one month after completion of the trial.

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The Ninth Circuit found that the District Court cannot utilize its own Robi v. FPI decision (App. F at 55a) as issue preclusion to overcome the prior two final Williams adverse decisions which are to be granted claim preclusion under the last-in-time rule (App. E at 50a).

(7.) Prior to his death, on "9 Nov. 1988," Paul Robi assigns his "thirty-three years (33) use," and "all right, title and interests in and to the rights in the trademark 'The Platters' together with the good will and the business associated with these trademarks..." to his wife Martha Robi (App. BB at 206a), who becomes the substituted Plaintiff in the 1990 D.C. Judgment (App. J at 90a), and the substituted party on the appeal, which is affirmed by the Ninth Circuit (App. I at 75a).

(8.) The Second Amended District Court Judgment (App. J at 91a) also "...permanently enjoins FPI...and all those acting on (its) their behalf...from initiating any litigation against plaintiff (now Martha Robi), pertaining to plaintiff's right to utilize the name "The Platters" and (the defendants and those who act on their behalf) are permanently enjoined from communicating to any party that plaintiff Robi has no rights to utilize the tradename, "The Platters...." (App. J at 92a).

THE GENESIS OF THE PRESENT ACTION

During the 1960's 70's and 80's Martha Robi participated with Paul Robi in management of the Paul Robi Platters Group, and upon his death, in February, 1989, Martha Robi continued the Paul Robi group in the same manner and style, using the same musical arrangements as her late husband, Paul Robi. In 1995, Martha Robi applied for a U.S. trademark for "The Platters." On July 7, 1995, Respondent Reed opposed Petitioner Martha Robi's application for registration of the United States service mark in the name, "The Platters," (App. Y at 195a, Para. No. 95), and Respondent Reed sent letters to venues stating Martha Robi has no rights to the name "The Platters." In 1995, Petitioner Martha Robi then sues Respondent Reed in Nevada District Court. Respondent Reed counterclaims against

Petitioner Martha Robi asserting that Respondent Reed has the exclusive rights to the name "The Platters."

During the period of time of 1990-1995, there are several groups performing as "The Platters," Martha Robi's group, FPI Corporation has several groups performing, one being licensee Herbert Reed, all performing as The Platters.[4]

On September 18, 1996, Respondent Reed moves the Nevada District Court for Summary Judgment against Petitioner Robi, based upon Reed's assertion: "...that he was the first to create the mark, he was the first to use the mark, and Martha Robi's use of the mark did not begin until 1988." (App. W at 181a, 183a.) On September 18, 1996 Respondent Reed also moves for a protective order prohibiting Martha Robi from inquiring into Respondent Reed's past and present relationship or association with FPI Corporation, which motion for a protective order is granted (App. AA at 205a).

Respondent Reed's affidavit in support of summary judgment does refer to "...a settlement agreement between the parties (FPI Corporation and Reed) reached in November 1987...." (App. Y at 194a, Para. No. 62.)

Petitioner's Attorney's FRCP Rule 56 (f) Affidavit asserted that discovery would demonstrate "...REED assisted

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In 1993, Martha Robi again sues FPI Corporation. Though Martha Robi had obtained cancellation of FPI's two incontestable Federal registrations upheld by the Ninth Circuit (App. J at 84a), FPI asserts common law rights to "The Platters" trademark and is sponsoring several Platters groups. The District Court in an interim decision on FPI's Motion for Summary Judgment holds it has not ruled whether FPI has lost all of its rights. (App. U at 160a).

others in attempts to stop and deny his partners their rights in the trade name `The Platters'" (App. Z at 200a, Para. No. 30), and "...that REED undertook to enter into stipulations where he agreed not to utilize the name `The Platters,' for a period of twenty (20) years." (App. Z at 201a, Para. No. 31.)

Petitioner Martha Robi's "Statement of Facts Either Not at Issue in Favor of Robi, or at issue in Opposition to REED's Motion" (App. X at 187a, 188a) asserted that Respondent Reed was in privity with FPI Corporation, and referenced the October 31, 1967 Declaration of Respondent Reed where Reed asserts the FPI Corporation owned all of the rights and that Robi and Taylor should be enjoined. (App. P at 112a referred to at App. X at 188a.) In October, 1996, the Nevada District Court takes Reed's Motion for Summary Judgment under submission.

On February 24, 1997, while Respondent Reed's Motion for Summary Judgment was under submission, Petitioner Robi requests the Nevada District Court to Take Judicial Notice of a December, 1996 FPI Corporation's Bankruptcy Petition filed in the Nevada District Court which indicates in its Schedule B, titled "Personal Property," that the FPI Corporation asserted, as an asset, a license to Herbert Reed. (App. R at 133a.)

On September 26, 1997, the Nevada District Court rendered its decision granting Summary Judgment in favor of REED (App. C at 12a), permanently enjoining Martha Robi from the use of the name "The Platters" (App. C at 22a), holding (not on the theory advanced by Respondent Reed, that Reed being the first to use the mark owned the mark), but that "...when a partner brings a valueless name to a partnership, which name then gains value through the joint efforts of all partners, the name is deemed property of the partnership,"

(App. C at 15a), and that (when a partnership owns the name) "...the Court also concludes that right to use the name remained with the group whenever one of its members left the group" (App. C at 18a), and that therefore: "Since Reed was the original member who remained with The Platters as the others left, it is Reed who now owns the exclusive right to the mark The Platters." (App. C at 19a, 20a.)

As to Paul Robi's right to assign the trademark to Martha Robi (App. BB at 206a), the District Court also held that: "Any right Paul would have taken would have been personal to him. As such, he could not have assigned the right to Robi. Rather, his right to use the service mark `The Platters' ceased upon his death in 1989." (App. C at 20a.)

The District Court Judgment (App. C at 23a) was not final, in that the District Court retained jurisdiction to award damages. (App. C at 23a.) Petitioner Robi appealed the interlocutory order under 28 U.S.C. 1292(a)(1), and requested in her Interlocutory Appeal of a "permanent injunction," that the Ninth Circuit exercise pendant appellate jurisdiction and consider the underlying merits of Respondent Reed's summary judgment motion.

In November, 1998, pending her appeal, Petitioner Robi initially sought from the Ninth Circuit Motions Panel, a stay of the permanent injunction pending appeal, and an injunction in favor of Petitioner Robi as against Respondent Reed based upon the Permanent Injunction provided by the District Court's May 31, 1990 Second Amended Judgment against FPI and its agents and employees (App. J at 91a, 91b), asserting that Reed was most likely in privity with the FPI Corporation and was enjoined from having initiated the very action initiated by him. On January 26, 1998, the Ninth Circuit Motion's Panel denied Petitioner Robi's Motion for a stay (App. B at 11a) denied without prejudice Petitioner

Robi's Motion for an injunction (App. B at 11a), and granted Petitioner Robi's request to take Judicial Notice of, among other matters, the May 7, 1987 Order of the Florida District Court (App. L at 99a).

Thereafter, on April 2, 1999, the Ninth Circuit in a published decision (App. A at 1a) affirmed the District Court's decision (App. C at 12a), holding, among other matters that:

> "Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for the name of a musical group when one of its members departs and continues to perform under the group's name. Courts that have confronted this problem have determined that members of a group do not retain rights to use the group's name when they leave the group." (App. A at 6a.)
> "On the other hand, it has also been held that a person who remains continuously involved with the group and is in a position to control the quality of its services, retains the right to use of the mark, even when that person is a manager rather than a performer." (App. A at 7a.)[5]
>
> "Under these circumstances, we hold that the District Court was correct in ruling that Reed

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This element of the Ninth Circuit is holding appears inconsistent with the District Court's finding that "Paul could not have assigned the right to name to Martha Robi prior to his death." (App. C at 20a.)

> had a right to use of the name to the exclusion of Robi. We...hold that when Paul Robi left the group, he took no rights to the service mark with him. Rather, the mark remained with the original group. Paul Robi therefore had nothing to assign to Martha Robi." (App. A at 8a.)
>
> "Reed, who founded the group and is the only person who has remained and performed with it from its inception, retains the right to use of the service mark to the exclusion of Robi." (App. A at 8a.)

The Ninth Circuit Opinion also held at Footnote One (App. A at 8a):

> "No issue has been presented concerning the rights, if any, of Reed's present group, or the other named plaintiffs, (sic) to use the Platters service mark."

Petitioner then sought a Petition for rehearing and an en banc review, both of which were denied on May 28, 1999. (App. D at 24a.)

ARGUMENT FOR GRANTING WRIT

The published decision of the Ninth Circuit Court of Appeals, conflicts in principle, and undermines the precedential value of the Supreme Court cases of Parklane Hosiery Company v. Shore, 439 U.S. 322 (1979), Brown v. Felsen 422 U.S. 127 (1979), and Erie R. Co. v. Thompkins 304 U.S. 64 (1938), and appears directly contrary to the Ninth Circuit cases of Americana Fabrics, Inc., v. L & L

Textiles 754 F.2d 1542 (9th Cir. 1985), Robi v. Five Platters, Inc.; Five Platters, Inc. v. Robi, Williams v. Five Platters, Inc., 838 F.2nd 318 (9th Cir. 1988), and Robi v. Five Platters Inc., 918 F.2d 1439 (9th Cir. 1990). The published decision is contrary to the Supreme Court and Ninth Circuit authority as to the operation of claim and issue preclusion, and the "Last in Time" rule, and is contrary, in part, to the Doctrine enunciated in Erie R. Co. v. Thompkins that a Federal Court cannot disregard the rule of law of the State applicable to the State substantive issue presented for resolution to the Federal Courts. The Ninth Circuit will not protect its own case law, and possibly will not protect the final injunctive orders of the District Court (App. J at 91a), which injunctive Order the District has affirmed (App. I at 75a, 77a).

The present decision of the Ninth Circuit Court of Appeals (App. A at 6a, 7a), in part, directly pre-empts California State Partnership Law, (particularly California Corporations Code Section 15308 (3)), and operates in part to pre-empt the partnership law of the individual states, by creating a federal law of partnership pertaining to ownership of partnership property rights to a partnership tradename and its goodwill.

The present decision (App. A at 6a) itself appears to invite Supreme Court review asserting that:

> "Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for the name of a musical group when one of its members departs and continues to perform under the group's name." (App. A at 6a.)

Petitioner Robi suggests that the Ninth Circuit's singular formulation of the issue as to ownership of a

partnership musical tradename does not provide the appropriate judicial framework to resolve issues of ownership of musical tradenames between competing interests of original members or their assigns, and that Supreme Court guidance is required to indicate that the Circuit Court cannot abandon the established doctrine of claim and issue preclusion, and the doctrine which requires the Federal Court to apply, in part, state partnership law to resolve issues of ownership in a musical group tradename.

ARGUMENT NO. 1

The decision is inconsistent and undermines Supreme Court and Circuit Authority as to the Doctrine of Claim and Issue Preclusion.

In Paul Robi v. Five Platters, Inc.; Five Platters, Inc v. Paul Robi et al; Tony Williams v. Five Platters, Inc., 838 F.2d 318 (9th Cir., January 27, 1988) (App. E), the Ninth Circuit reaffirmed "The Last In Time Rule," which requires that when a third court is presented with conflicting judgments of two (2) prior courts, that the third court must adopt the last judgment in time, in that:

> "...the implicit or explicit decision of the second court, to the effect that the first court's judgment is not res judicata, is itself res judicata and therefore binding on the third court." (App. E at 48a.)

The Nevada District Court which granted Respondent Herbert Reed's Motion for Summary Judgment (App. C at 16a) is the "third court," the Florida District Court of 1987 12/10/87 Order of Settlement which dismissed both FPI's and Respondent Reed's claims as against each other with prejudice

(App. K at 95a) is the "second court," and the U.S. District Court for the Central District of California, which granted P. ROBI's claim preclusion against FPI on May 22, 1985 (App. F at 55a) is the "first court."

The Ninth Circuit in Williams v. Five Platters 838 F.2d 318, 328, citing to Americana Fabrics, Inc. v. L & L Textiles, Inc. 754 F.2d 1524 (9th Cir., 1985) held:

> "The rule finds support in the societal interests in 'ending the chain of relitigation' ... by stopping it where it (stands)." Americana, 754 Fed at 1530 (quoting Porter v. Wilson 419 F.2d at 259). (App. E at 49a.)

The Ninth Circuit Appellate Court, in Robi v. Five Platters, Inc., 838 F.2d 318, 323, quoted Judge Sneed's statement in Americana Fabrics, Inc. v. L&L Textiles, Inc. 754 F.2d 1524 (9th Cir. 1988) holding that:

> "The most recent decision is not binding because it is correct: it is binding because it is last. Id. This concept of finality is central to the entire body of res judicata doctrine, see 18 Wright Section 4403, at 15." (Emphasis added.) (App. E at 49a.)

In Robi v. Five Platters, Inc. (App. E at 39a), the Ninth Circuit upheld Robi's Motion for Claim Preclusion as against FPI Corporation based upon Robi's prior favorable 1974 State Court judgment (App. E at 39a) but did not allow "original platter" Williams the benefit of the favorable 1985 Robi Federal Court judgment (App. E at 50a) to, in effect, overturn the prior two (2) decisions adverse to Williams. (App. E at 50a.)

The Nevada District Court, by applying the prior favorable Robi decisions to benefit Reed, utilized the

favorable Robi decision to, in effect, overturns Reed's December, 1997 dismissal with prejudice of his claims against FPI Corporation (App. K at 95a) and does not address the issue of privity as between Reed and FPI.

With regard to Respondent Reed, the Ninth Circuit April 2, 1999 Opinion in Martha Robi v. Herbert Reed (App. A at 6a) does not adhere to the "last in time rule," as a doctrine "central to the entire body of res judicata doctrine...." If the Appellate Court precluded Williams from benefitting from the issue preclusion benefits of the Robi decisions, the Court should not allow Reed to benefit from those same decisions and ignore the claim preclusive effect of Reed's dismissal with prejudice of his claims against FPI on 12/10/87 (App. K at 95a).

The Ninth Circuit and District Court abandoned the Ninth Circuit case law as to claim preclusion, by adopting the favorable Robi decision (App. A at 6a (referencing App. E and App. G), in favor of Reed to Defendant Martha Robi's rights.[6]

In adopting the factual findings of the favorable Robi decisions in favor of Reed to defeat Martha Robi, both the Circuit Court and District Court adopt certain particular findings of prior decisions to support their decisions, and ignore other specific findings in these same decisions which are inconsistent with findings in favor of Respondent Reed.

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Not only did the Ninth Circuit not protect its own case law which is "...central to the entire body of res judicata doctrine..." Americana, supra, at 754 F.2d 1524, but appears reluctant to allow enforcement of the District Court's injunction Order (App. J at 91a).

Judge Marshall found (App. F at 58a) that "Robi left the Platters in 1965...Robi then formed his own group called The Platters" (App. F at 58a), and "From 1995 to the present, there have been two performing groups known as The Platters. One group is controlled by Buck Ram and his corporation, The Five Platters Inc. The other group is Robi's." (App. F at 58a.) The Ninth Circuit, without any basis in the record, finds Robi left FPI and did not perform for many years (App. A at 8a).

ARGUMENT NO. 2

The Panel decision (App. A at 7a) does not adhere to the partnership law of the state applicable to the partnership law issues before the Federal Court, but attempts to create a Federal Partnership Law for music performing groups contrary to the doctrine of Erie R. v. Thompkins 304 U.S. 64 (1958). The April 2, 1999 Decision (App. A) holds that:

> "Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for a name of a musical group when one of its members departs and continues to perform under the group's name. Court that have confronted this problem have determined that members of a group do not retain rights to use the group's name when they leave the group." (App. A at 6a.)

This holding is incorrect as a matter of California and other states statutory partnership law and implicitly establishes a federal partnership law as to ownership of partnership goodwill and tradename.[7]

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[7] All 50 states have adopted a version of Uniform Partnership Act and all 50 states have developed through their case law their

The District Court's Opinion (App. C at 19a that "when Paul Robi left the group, he took no rights to the service mark with him" ignores California Corporations Code Section 15038(3) and similar statutes and interpretation of the California state case law which provides that "...The rights of partners to partnership property..." under dissolution caused by wrongful acts of a partner in contravention of the partnership agreement shall be as follows:

> "...(b) The partners who have not caused the dissolution wrongfully, if they all desire to continue the business in the same name, either by themselves or jointly with others, may do so...."

App. O at 111a is an advertisement for "The Platters" with Paul Robi ("P. ROBI"), Zola Taylor ("TAYLOR") and Tony Williams ("WILLIAMS") (without REED), "Concert Hall, City Hall," January, 1966, as "The Platters" after P. ROBI, TAYLOR and WILLIAMS' departure from Five Platters, Inc., ("FPI") and its president, REED, which under California Corporate Code §15038(3) (a question of fact exists) after REED's wrongful dissolution by undertaking to assist FPI, as president, against the interests of the partnership (App. P at 112a, App. CC at 208a), would, under California Corporations Code §15038(3), allow P. ROBI, TAYLOR and WILLIAMS the right to have exclusive control of "The Platters" partnership's goodwill.

The authorities cited by the Circuit Opinion as to the lack of rights (to the group trade name) to those who "leave the singing group," Boogie Kings v. Guillory, 188 SD 2d

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interpretation of the equivalent of California Corporations Code 15038(3) and other statutes as to ownership of partnership goodwill.

446, 448 (LA APP 1966), Giammarsee v. Delfino, 197 USPQ, 102, 103, Nov. 11, 1977 (App. A at 7a) also relied upon the Nevada District Court (App. C at 15a), arose out of either State Court or Federal Court interpretation of state substantive law where (in when a performing group member left) there was no dispute that the remaining partnership members as the partnership itself both owned and controlled the partnership's goodwill (not as in the case of Robi v. FPI Corp., found by three (3) courts (App. E at 28a, App. F at 58a, App. G at 69a), where the FPI Corporation had misappropriated and controlled "The Platters'" goodwill). The authorities supporting the Ninth Circuit and District Court Opinions pertain to situations where there had not been previous wrongful dissolution by a "remaining partner," and, in these particular cases alone, consistent with the State Law of the particular state Boogie Kings v. Guillory, 188 SD 2d 445, 448 (La. App. 1966) (cited at App A at 7a) in which the partnership existed, a departing performing member was prohibited from claiming partnership goodwill property controlled by the remaining non-breaching partnership members.

Paul Robi's "leaving the group" along with TAYLOR and WILLIAMS to form a competing group in 1966 (App. O at 111a) is specifically provided by California Corporations Code §15038(3), which allows non-breaching partners (P. ROBI, WILLIAMS and TAYLOR) to carry on the business of the partnership "in the same name" after the dissolution caused by the breaching partners.[8]

8

While the Ninth Circuit Opinion is correct that neither the Supreme Court nor the Ninth Circuit has specifically addressed Partnership Law of departing members of a singing group, the Ninth Circuit, when called upon to do so, does apply state

The Circuit Court's April 2, 1999 decision (App. A at 7a) replaces the State of California Corporations Code §15038(3), or any applicable state partnership law with a Federal rule of partnership law that holds: whoever physically (spatially) stops performing (who physically "leaves" or stops participating in group activities) takes with them no rights to the goodwill of the partnership, whether or not the remaining

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partnership law when considering state law partnership issues. As provided in Moseley v. Moseley, 196 F2d 663 (9th Cir, 1955):

> "After alluding to the fact that thereafter each of the former partners had the right to go into business for himself, the court held, citing 76 Cal.App. at page 25: 'Defendant, of course, had the same right.'"

The Ninth Circuit Rule of the last to depart is akin to finding that when the Serbian Soldiers overtook Kosovo, that if any Kosovo Albanians had assisted the Serbs and remained in Kosovo while their countrymen fled Kosovo, those that remained therefore retained all property rights of the fleeing Kosovars in that those who assisted the Serbs and stayed behind to reap the benefits "were the last," to leave.

Under the Ninth Circuit decision, if the order of departure of original Platters was Robi first, Taylor second to join Robi, and Williams was the third to leave and Lynch was the fourth, and if Reed retired from the FPI group, then Lynch could have obtained an injunction against Robi, Taylor and Williams, and Williams, who left before Lynch, could have obtained an injunction against Taylor and Robi, and Taylor could have enjoined Robi, though Taylor and Robi and Williams joined initially together and thereafter in their individual struggles against the FPI Corporation, whose claims and rights were ratified by "remaining" member Reed. (App. Q at 120a.)

performer or performers caused a breach of the partnership agreement and cause an unlawful dissolution of the partnership, or whether the partnership property was even under control of the partners at the time Robi, Williams and Taylor physically left. The Ninth Circuit's "first to physically leave the group" rule is inconsistent with the underlying rules of state law of partnership dissolution under California Corporations Code §15038(3) or any of the states.

Remarkably, the very federal court favorable Robi decisions, upon which the present Ninth Circuit Opinion relies (App. A at 6a) as the basis for its holding in providing Respondent Reed the benefit of the favorable Robi federal court decisions (those federal court decisions being App. E at 26a, and App. F at 55a) were themselves based upon the adoption of the California Superior Court Findings (App. G at 67a), which decision was based upon the California State Court's application of California State Law.

The Ninth Circuit in its prior decision (App. E at 33a) recognized the obligation of the Federal Courts to apply substantive state law in considering the doctrine of claim and issue preclusion: "Accordingly, we apply California law of res judicata to the California judgment, New York law to the New York judgment and federal law to the federal judgments." (App. E at 33a.) Neither the Appellate Court nor the District Court in the present case undertook to apply the applicable law to the Florida District Court Decision (App. K at 99a).

THE ELEMENTS OF THE DECISION WITH TRADEMARK LAW ARE SIMPLY NOT CONSISTENT

The decision is anomalous.

Though finding for REED, as against M. ROBI, the Circuit also found at Footnote 1: "No issue has been presented concerning the rights if any of REED's present group or the other named Plaintiffs (sic) to use the Platters service mark." If the Circuit does not find that REED has rights to use "The Platters" service mark, then REED cannot be the prevailing party. (App. A at 8a)

CONCLUSION

The Ninth Circuit Court may be correct in its holding:

> "Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for the name of a musical group when one of its members departs and continues to perform under the group's name."

However, the Supreme Court and the Ninth Circuit have held that the doctrines of claim and issue preclusion are fundamental to the administration of justice and that "...collateral estoppel, like the related doctrine of re judicata, has the dual purpose of protecting litigants from the burden of relitigating an identical issue with the same party or his privy and of promoting judicial economy by preventing needless litigation." Parkland Hosiery Company v. Shore 439 U.S. 322 at 326 (Citing to Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation 402 U.S. 313). Robi v. Five Platters, Inc., Five Platters, Inc. v. Williams 838 F2d 318 (9th Cir. 1988).

The Supreme Court and the Ninth Circuit have also held that the Federal courts should apply the law of the state in resolving state substantive legal issues. Erie v. Thompkins, 304 U.S. 64 (1938).

The Supreme Court's granting of this petition assists in the preservation of the fundamental doctrines of Claim and Issue Preclusion and the requirement of applying State Law under Erie v. Thompkins, supra, and would correctly reestablish the appropriate framework of analysis to these complex musical group trademark issues which often intermix issues of trademark law, state partnership law, and the doctrine of claim and issue preclusion, and would avoid the erroneous doctrine as provided by the Ninth Circuit Opinion, which abandons the doctrine of claim preclusion, and the doctrine of applying state substantive law enunciated by Erie v. Thompkins, supra and would require that the Ninth Circuit to protect its own fundamental case authority in adjudicating the issues presented before the Circuit Court.

Respectfully submitted:

/s/_____

Martha Robi
In Pro Se
10737 Riverside Drive
North Hollywood, California 91206
(818) 763-6289

APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed: April 2, 1999]

No. 97-16909

Appeal from the United States District Court for the District of Nevada

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation,
Defendants-Appellees.

Before: William C. Canby, Jr., and Andrew J. Kleinfeld, Circuit Judges, and Judith N. Keep, District Judge.*

OPINION

KEEP, District Judge:

This case presents conflicting claims over the rights to the use of the trademark name "The Platters" by individuals associated with the group. In essence, this court must determine which party is "The Great Pretender," and which is not. Plaintiff-Appellant Martha Robi appeals the district court's grant of summary judgment in favor of Herb Reed, John Valano, Reed's booking agent, and John P. Productions, Inc., Valano's booking company. The district court held that Paul Robi, as an individual, had no right to use the name "The Platters," which was the name of the singing group of which Robi and Reed were members. Hence, the court held that Robi's purported assignment of this right to Martha Robi was invalid. The court also concluded that Herb Reed has the right to use the service mark "The Platters" to the exclusion of Robi. We affirm the judgment of the district court.

BACKGROUND

Defendant Herb Reed founded The Platters in 1953 he was also the manager and one of the group's original singers along with Joe Jefferson, Alex Hodge, and Cornell Gunther.

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* The Honorable Judith N. Keep, District Judge, United States District Court for the Southern District of California, sitting by designation.

In 1954, Jefferson and Gunther ceased to perform with the group and were replaced by David Lynch and Tony Williams. After this new group had recorded several songs, Zola Taylor joined the group. In August or September 1954, Paul Robi began performing with The Platters, having replaced Alex Hodge. Around 1957, after the group had achieved commercial success, Paul Robi met and later married plaintiff-appellant Martha Robi. Martha Robi has never performed with the group. Paul Robi severed his relationship with the group in 1965, when he was arrested and convicted of felony narcotics possession charges; he did not leave Reed's group for the purpose of starting a new group, nor did Robi return to the Platters group managed by Reed after his release from prison.

Since the late 1960s, there have been numerous disputes concerning the right to use the mark "The Platters," some of which involve The Five Platters, Inc. ("FPI") . In 1956, the members of The Platters group, including both Paul Robi and Herb Reed, assigned to FPI their interests in the name "The Platters" and executed employment contracts with FPI in exchange for equal shares of stock. In 1974, a California Superior Court held that FPI could not enjoin Paul Robi from performing under "The Platters" name, finding that the performers' assignment of their interest in the name to FPI was ineffective.

A later suit was brought by Paul Robi in federal court. In *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988), this court upheld the district court's preliminary injunction which prevented FPI from further challenging Paul Robi's use of the name "The Platters." After losing at trial, FPI appealed. FPI challenged, inter alia, the district court's

cancellation of FPI's registration of "The Platters" mark and the district court's order enjoining FPI from challenging Paul Robi's right to use the mark. This court affirmed the holdings of the district court. *See Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990). Paul Robi died while that appeal was pending. By stipulation, the parties to that action substituted as plaintiff Martha Robi, Paul Robi's wife and assignee of his rights to "The Platters" name and goodwill. *See id.* at 1441 n. 1. In sum, our previous decisions did not address Paul Robi's rights to use the name "The Platters" as compared to Herb Reed's, nor did they address Martha Robi's rights to use that name as compared to Herb Reed's. Rather, they addressed FPI's right to prevent Paul Robi from using the name "The Platters."

In November of 1988, Paul Robi executed a written "assignment of trademark" ostensibly transferring to Martha Robi all of his rights in "The Platters" mark. The written assignment also purported to transfer the goodwill and business symbolized by this mark. Since that time, Martha Robi has managed, booked, and presented a singing group called "The Platters." This group lacks any original member of The Platters.

Martha Robi brought this suit against Herb Reed et al., asserting that she has exclusive rights to "The Platters" name. Reed counterclaimed, maintaining that he has exclusive rights to the mark as the founder and manager of the group. The district court entered summary judgment in favor of Reed. We affirm.

STANDARD OF REVIEW

This court reviews a district court's grant of summary judgment de novo. *Margolis v. Ryan*, 140 F.3d 850, 852 (9th Cir. 1998). Viewing the evidence in the light most favorable to the nonmoving party, the appellate court determines whether there are any genuine issues of material fact and whether the district court correctly applied the relevant substantive law. *See id.* The district court's entry of a permanent injunction is reviewed for an abuse of discretion or application of erroneous legal principles. *See Easyriders Freedom F.I.G.H.T.v. Hannigan*, 92 F.3d 1486, 1493 (9th Cir. 1996).

DISCUSSION

Robi first contends that the district court erred when it denied her motion for a continuance under Fed. R. Civ. Pro. 56(f) and granted Reed's request for a protective order under Fed. R. Civ. Pro. 26(c) . We review such decisions for an abuse of discretion. *See Citizens Comm'n on Human Rights v. FDA*, 45 F.3d 1325, 1329 (9th Cir. 1995). Robi failed to show that the discovery she sought, which was very burdensome, was material to her claim of right to the service mark. We therefore find no abuse of discretion, and turn to the merits of Robi's appeal.

Martha Robi asserts that she obtained exclusive rights to "The Platters" name through an assignment from her husband Paul Robi. As an initial matter, Martha Robi's rights are derivative of her husband's rights.

[1] Paul Robi's rights derive from his membership in the singing group The Platters, of which he was a member when the group achieved fame. Paul Robi remained a member until 1965. Herb Reed, on the other hand, has been continuously associated with The Platters since 1953, a year before Paul Robi joined the group. As the district court noted, Herb Reed is the only member of the group who remained as the others left and were replaced.

[2] In 1974, when the California Superior Court found the assignment of rights to FPI invalid, that court recognized that "until January 1956, the name the 'Platters' was owned by five individuals comprising a group as a partnership." *The Five Platters, Inc. v. 12319 Corp., Superior Court of the State of California for the County of Los Angeles*, No. C 43926. Thus, prior to 1956, the group, which included Reed and Robi, owned the mark collectively. Because the 1956 purported transfer of the rights to the mark to FPI was held invalid, see *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988); *Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990), the group maintained collective rights to the mark even after the purported transfer. As the district court documents indicate, Herb Reed was asserting his right to use the name in the early 1980s, and he continued to do so thereafter. Martha Robi, on the other hand, first used "The Platters "name in 1988, well after Herb Reed's use began in the 1950s; his claim to the name was asserted at least in the early 1980s.

[3] Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for the name of a musical group when one of its members departs and continues to perform under the group's name. Courts that

have confronted this problem have determined that members of a group do not retain rights to use the group's name when they leave the group. *See, e.g., HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. 991 (C.D. Cal. 1980) (former members of a group prohibited from performing under the band's name when members of the original group, with certain replacement members, continued to use the name); *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983) (holding, *inter alia*, that the former lead singer of The Kingsmen, who was with the group when it recorded the hit song "Louie Louie," did not have the right to use the name after his departure). It has been held also that there is no inalienable interest at stake that would attach to the departing member. *See Giammarese v. Delfino*, 197 U.S.P.Q. 162, 163 (N.D. 111. 1977) (former member of The Buckinghams enjoined from performing under the name because he was "clearly not possessed of a sufficient proprietary interest in the name to justify his conveyance of the entire trade name for use by a new and entirely distinct musical group.") (quoting the unpublished Seventh Circuit opinion affirming the preliminary injunction); *cf. Boogie Kings v. Guillory*, 188 So.2d 445, 448 (La. App. 1966) (holding that individual members of The Boogie Kings had no right to transfer exclusive rights to use the name because it belonged to the band as a whole).

[4] On the other hand, it has also been held that a person who remains continuously involved with the group and is in a position to control the quality of its services retains the right to use of the mark, even when that person is a manager rather than a performer. *See Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y. 1985). In the present case, as between Reed and Paul and Martha Robi, Reed is the person who has

maintained continuity with the group and has been in a position to control the quality of its services. Reed is the only surviving member of the five singers who originally began with the group in 1953. He founded the group, gave the group its name, managed the group, and is the only member who has continuously performed with the group.

[5] In contrast, Paul Robi left the group and never returned to it; moreover, he ceased to perform at all for a period of years, and is now deceased. Martha Robi, who claims the right to use "The Platters" name by assignment from Paul Robi, has never performed with that group and does not currently perform in any capacity. She asserts the right to use the name for performances by musicians who have also never had a connection with the original group or its evolving successor.

[6] Under these circumstances, we hold that the district court was correct in ruling that Reed had a right to use of the name to the exclusion of Robi. We adopt the holdings of HEC Enters., Ltd. and Kingsmen and hold that when Paul Robi left the group, he took no rights to the service mark with him. Rather, the mark remained with the original group. Paul Robi therefore had nothing to assign to Martha Robi. Reed, who founded the group and is the only person who has remained and performed with it from its inception, retains the right to use of the service mark to the exclusion of Robi.[1]

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[1] No issue has been presented concerning the rights, if any, of Reed's present group, or the other named plaintiffs, to use the Platters service mark.

This holding is consistent with the basic purposes of trademark law and the Lanham Act. Allowing Martha Robi to organize a rival group called "The Platters" and allowing it to perform music as that group would lead to confusion among reasonable consumers. *See HEC Enters., Ltd.*, 213 U.S.P.Q. at 993 (holding, inter alia, that two bands performing under the name "Deep Purple" created a likelihood of confusion).

The judgment of the district court is affirmed.

AFFIRMED.

APPENDIX B

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed: January 26, 1998]

No. 97-16909

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation,
Defendants-Appellees.

Before: BROWNING and THOMAS, Circuit Judges

ORDER

Appellees' motion to extend time to file the opposition to appellant's motions for stay, injunctive relief and expedited briefing is granted. The Clerk shall file appellees' response, received on December 22, 1997.

Appellant's motion for stay of the district court's permanent injunction pending appeal is denied.

Appellant's motion for injunctive relief is denied without prejudice to its renewal following presentation to the district court. See Fed. R. App. P. 8(a).

Appellant's request to take judicial notice is granted.

Appellant's request for expedited hearing is denied. The briefing schedule previously established shall remain in effect.

Appellees' request for an award of attorneys fees and costs associated with opposing appellant's motions is denied.

APPENDIX C

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed: September 29, 1997]

Case No. CV-S-95-1029-LDG(LRL)

MARTHA ROBI,	)
Plaintiff,	)
	)
v.	)
	)
HERB REED, et al.,	)
Defendants.	)
	)

ORDER

Who owns the mark The Platters. Does Reed own the mark as the man who created a quarter in 1953 that he called The Platters? Or does Martha Robi (hereinafter Robi) own the name? Robi met Paul Robi (hereinafter Paul) in 1957, and married him later. Having considered the question carefully, including the pleadings and papers filed by both parties, and the respective motions for summary judgment and summary adjudication, the Court concludes that Reed owns and has the exclusive right to use the mark "Platters."

Paul Robi was the last "original"[1] member to join The Platters in 1954, replacing "founding" member Alex Hodge. While The Platters sang together and engaged in some commerce prior to Paul's arrival, they had achieved commercial success and fame long before he met Robi. By October 1956, a short *Hit Parade* article featured the group. "A more compatible group is hard to find," the article proclaimed. As for the group's future, *Hit Parade* predicted that The Platters will "stay in the limelight as long as folks love good singing."

By the early 1960's, the limelight began to fade and "original" members began to leave the group. Following the defections, however, the public renewed its interest in The Platters' music and, by 1967, at least two groups were touring and claiming to be the rightful Platters. Each group contained at least one original member of the Platters. As various groups claimed to be or simply identified themselves in some manner as Platters, skirmishes and battles, both in and out of court, broke out in what is now a thirty-year war over the right to use the mark The Platters.

Many of the suits involved The Five Platters, Inc. (FPI), a corporation ostensibly created by The Platters in January 1956, to protect the name "Platters" from pretenders to the mark. To protect themselves, the group's members

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[1] Following the lead of several other courts, this Court will refer to the quintet of Herb Reed, David Lynch, Tony Williams, Paul Robi, and Zola Taylor, that is the group as composed when it first achieved success, as the "original" Platters. The Court notes, however, that with the exception of Reed, none of these singers were involved as founding members of the group.

assigned their interest in the name to FPI in 1956, receiving equal shares in the corporation in exchange.

While FPI won several legal victories suggesting that it rightfully owned the name The Platters, it lost its suit against Paul, who had left the group in 1965. In 1974, a California Superior Court held that FPI could not enjoin Paul from performing as The Platters, finding that the original members' assignment of their interest to FPI was ineffective. In a separate suit brought later by Paul, FPI's registrations of the mark were canceled and FPI was enjoined from taking any action inhibiting Paul's use of the mark. Prior to his death in 1989, Paul assigned his right to use the mark to Robi, who has since continued to present a singing group as The Platters. Unlike Paul's group, however, this group lacks any original member of The Platters. Claiming an exclusive right to use the mark, Robi brought this suit against Reed, who continues to tour as "Herb Reed and The Platters" and as "The Platters." Once attacked Reed has responded that he, and only he, has a right to use the mark The Platters because he founded the group. Although the Court disagrees that Reed's owns the right to Platters because of his initial efforts to create the group, the Court nevertheless agrees that, as a matter of law, he has the superior right to exclusive use of the mark.

Robi argues that Paul owned an interest in the mark as one of five members of the partnership that performed as The Platters. Reed counters that the members of the group did not own the name, but that he individually owned the name because he originated the group in 1953, thereby first appropriating and using the name. As noted by the Ninth Circuit, "[a] right to a trade-mark stems from prior

appropriation and use." *Tillamook County Cream Ass'n v. Tillamook Cheese & Dairy Ass'n*, 345 F.2d 158, 160 (9th Cir. 1965). Although right to a mark arises from prior use, the Court also notes that when a partner brings a valueless name to a partnership, which name then gains value through the joint efforts of all partners, the name is deemed property of the partnership. *Peterson v. Lightfoot*, 191 P.48, 49 (Cal.N.Y.Ct.App. 1920). The Court finds no reason why a similar principle should not apply to a singing group. *Giammarese v. Delfino*, 197 U.S.P.Q. (BNA) 162, 163 (N.D.Ill.1977) (singing group as a whole owned name as a partnership); *Boogie Kings v. Guillory*, 188 So.2d 445, 449 (La.Ct.App.1966) (band as a whole owned name as an unincorporated association). Prior to formation of a quarter in 1953 by the founding members, the mark The Platters had no value. Reed has not offered any evidence indicating that he, alone, used the name Platters prior to its adoption by the quartet. With time, the name began to gain value until widespread success was achieved by the original members. Through the next six years, the name gained the value it currently enjoys through the joint efforts of all five original members. The record, and history, does not support a finding that any one of the original members can be credited as being solely responsible for The Platters' success sufficient to bestow that one members, rather than the group, with the exclusive right to use the mark.

Reed himself, has acknowledged that he gave a valueless name to an unknown group, which name then gained value through the joint effort of all members. As set forth in his 1967 affidavit: "The Platters were formed as an unknown group of singers in 1953. I was the individual responsible for the creation of the group and it was I who gave it the name

The Platters. . . . Between the time of our organization and 1956, we had grown from an unknown group to a group of major importance in the music industry." Most importantly, Reed stated that "[a]lthough we were five individual members of the singing group, we were known as a singing group and not five individual singers. The continuity of the Platters and the continued success which it has enjoyed as a group is largely due to that fact." And as pointed out by Robi, the California Superior Court's recognized in 1974, "[u]ntil January 1956, the name the 'Platters' was owned by the five individuals comprising the group as a partnership." *The Five Platters, Inc. v. 12319 Corp.*, Superior Court of California for Los Angeles County, No. C 43926, Findings of Fact and Conclusions of Law (emphasis added). Accordingly, this Court finds that, prior to January 1956, the group as a whole, whether as a partnership or as an unincorporated association, owned the mark The Platters. Conversely, ownership of the name did not vest in the individual members, or any individual member, of The Platters.

As both parties have pointed out, the issue whether the group assigned its interest in the mark to FPI in January 1956 has been the focus of several suits. Unfortunately, the results of that litigation has been inconsistent. FPI lost its suit against Paul, in part, because the California court found that the assignment was ineffective. *See Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988). In contract, FPI won its suit against Tony Williams as the New York court concluded that the assignment was effective. *Id.* The District of Maryland also concluded the assignment was effective. *Five Platters, Inc. v. Purdie*, 419 F.Supp.372 (1976). As regards Robi, however, the most recent judicial decision, that of the Ninth Circuit in 1990, upheld the California Superior Court's

1974 finding, and this Court will likewise adopt these following findings of the California court, which are binding upon Robi:

> In January 1956, [FPI] was formed by a lawyer selected by Buck Ram. Shortly thereafter, . . . Paul Robi, and the other members of the group, executed employment contracts with the corporation by which purportedly the right to the name the "Platters" were transferred to the corporation in return for the corporation's stock. The corporate stock was thereafter issued to the members of the group. This stock issue was illegal and void in that it did not comply with the terms of the permit issued by the Division of Corporations of the State of California.
>
> The members of the group received nothing from the corporation for their interest in the name, the "Platters" or other assets of the predecessor partnership. No capital was put in the corporation. The corporation was at all times dominated by Buck Ram and was a sham used by Mr. Ram to obtain ownership of the name the "Platters."

Robi has failed to offer any argument, nor could she, suggesting that the group's assignment of the name owned by the group was ineffective as to Paul but not as to Reed. Accordingly, this Court finds that the group's assignment of the name was ineffective both as to Paul and as to Reed. Thus, after January 1956, the group as a whole continued to

own the name the "Platters."

Having determined that the group owned the name, the Court also concludes that right to use the name remained with the group whenever one of its members left the group. Courts that have found a name to be owned by a musical group as a group have also found that departing members do not take with them the right to use the name of the group. *The Four Aces Litigation: What's in a Name?*, 5 Art & the Law 67 (1980), describes a suit over the right to use the name Four Aces as between the original and replacement band members. Following their initial popularity, the original members of the Four Aces left the group one at a time until each had been replaced. Later, the original members re-grouped to sing their old material and again named themselves the Four Aces. The original members also sued their replacements, who had continued to perform as the Four Aces, over the right to use the name. Holding in favor of the replacements, the court concluded that, as each original member left the group, he essentially divorced himself from the name and its attendant goodwill.

A similar result was reached in *Boogie Kings v. Guillory*, 188 So.2d 445 (La.Ct.App. 1966). Except for Guillory, the members of the band, Boogie Kings, became dissatisfied with the venue in which they were playing. When the band decided to quit playing the venue, Guillory quit playing with the band. In the subsequent suit, the court held that the band owned the name and that, in departing, Guillory did not take with him or gain an individual right to use the name.

In the present matter, Tony Williams left The Platters in the early 1960s and was replaced by Sonny Turner. Robi does not present any argument that, with Williams' departure, he took with him an individual right to use the name Platters in derogation of the group's continued right to use the name. Rather, the remaining members of the group, including Paul, continued to perform as The Platters. By 1964, Zola Taylor left and was replaced by Barbara Rudolph. Again, the remaining members of the group, including Paul, continued to perform as The Platters. Accordingly, the Court fails to find any basis to find that, when Paul departed from the group in 1965, he took with him an individual right to use the name The Platters in derogation of the group's ownership of that mark. That Williams, Taylor, and Paul formed a new group in 1967, and identified themselves as the Platters did not divest the original group of its exclusive right to use the name since none of the individuals had taken with them the right to use the name.

Paul's litigation against FPI is consistent with this conclusion. That litigation demonstrated only that FPI lacked the right to use the name Platters. Accordingly, FPI could not preclude Paul from using the name. Implicit in this litigation, Robi (claiming as an assignee, wife, and heir of Paul), suggests that Paul somehow retained an individual right to use the name Platters, even though that name was owned by the group he left. She fails, however, to offer any argument or law suggesting that he gained an individual and separate right to a mark owned collectively by the group. To this implicit claim, this Court holds that the group (as opposed to FPI) owned and had the exclusive right to use the name prior to Paul's departure and continued to own and have the exclusive right to the name subsequent to his departure. Since Reed

was the original member who remained with The Platters as the others left, it is Reed who now owns the exclusive right to the mark The Platters.

The Court would also note that, as between Reed and Robi, its conclusion that Robi lacks any right to the service mark would not change even if Paul somehow obtained an individual right to the group-owned name when he departed. Any right Paul would have taken would have been personal to him. As such, he could not have assigned the right to Robi. Rather, his right to use the service mark The Platters ceased upon his death in 1989.

Accordingly, the Court finds that summary judgment is appropriate in favor of Reed and against Robi.

THE COURT **ORDERS** that Defendants and Counter claimants Herb Reed, John Villano, and John P. Productions, Inc.'s Motion for Summary Judgment (#87) is GRANTED;

THE COURT FURTHER **ORDERS** that Plaintiff and Counter defendant Martha Robi's Motion for Summary Adjudication of Issues (#119) is DENIED;

THE COURT FURTHER **ORDERS** that Plaintiff and Counter defendant Martha Robi's Motion to Strike Portion's of Herb Reed's Affidavit (#106) is DENIED;

THE COURT FURTHER **ORDERS** that Plaintiff and Counter defendant Martha Robi's Objection to Minute Order (#107) is DENIED;

THE COURT FURTHER **ORDERS** that Plaintiff and

Counter defendant Martha Robi's Application for Court to Consider Supplemental Papers (#108) is DENIED;

THE COURT FURTHER **ORDERS** that Plaintiff and Counter defendant Martha Robi's Request to Take Judicial Notice in Support of Her Motion for Summary Adjudication (#109) is GRANTED;

THE COURT FURTHER **ORDERS** that Defendants and Counter claimants Herb Reed, John Villano, and John P. Productions, Inc.'s Motion to Strike and Dismiss Counterclaims in Reply (#121) is GRANTED;

THE COURT FURTHER **ORDERS** that Defendants and Counter claimants Herb Reed, John Villano, and John P. Productions, Inc.'s Motion for Attorney's Fees (#134) is DENIED;

THE COURT FURTHER **ORDERS** that Plaintiff and Counter defendant Martha Robi's Request to Take Judicial Notice (#137) is DENIED.

DATED this 25 day of September, 1997.

/s/_____
Lloyd D. George
Chief United States District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed: September 29, 1997]

Case No. CV-S-95-1029-LDG(LRL)

MARTHA ROBI,
Plaintiff,

v.

HERB REED, et al.,
Defendants.

JUDGMENT

The Court having considered the pleadings and papers, and having rendered its decision in favor of Defendants and Counter claimants Herb Reed, John Villano, and John P. Productions, Inc., therefore,

THE COURT **ORDERS AND ADJUDGES** that the complaint of Plaintiff Martha Robi is DISMISSED with prejudice and she shall take nothing.

THE COURT FURTHER **ORDERS AND ADJUDGES** that Martha Robi, her agents, servants, employees, attorneys, and persons in active concert or participation with them, are permanently enjoined from using in any manner the mark "The Platters" alone or in conjunction with any other names or words.

THE COURT FURTHER **ORDERS AND ADJUDGES** that Martha Robi, her agents, servants, employees, attorneys, and persons in active concert or participation with them, shall deliver to this Court (or to an officer appointed by this Court) for destruction all goods, articles, or other matters bearing the mark "The Platters", including goods, articles, and other matters bearing the mark "The Platters" alone or in conjunction with any other names or words.

THE COURT FURTHER **ORDERS AND ADJUDGES** that Martha Robi's Nevada Registration of the service mark "The Platters" and all other state registrations by Martha Robi of the service mark "The Platters" are canceled.

THE COURT FURTHER **ORDERS AND ADJUDGES** that JUDGMENT is GRANTED in favor Counter claimants Herb Reed, John Villano, and John P. Productions, Inc., and that Counter claimants are awarded damages in an amount to be determined at hearing.

DATED this 25th day of September, 1997.

/s/_____
Lloyd D. George
Chief United States District Judge

APPENDIX D

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

NOT FOR PUBLICATION

[Filed: May 28, 1999]

No. 97-16909

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation,
Defendants-Appellees.

BEFORE: CANBY and KLEINFELD, Circuit Judges, and KEEP,[1] District Judge

ORDER

The panel, as constituted above, has unanimously voted to deny the petition for rehearing. Judge Kleinfeld has voted to deny the petition for rehearing en banc, and Judges Canby and Keep have so recommended.

The petition for en banc rehearing has been circulated to the full court, and no judge of the court has requested a vote on the petition for rehearing en banc. Fed. R. App. P. 35(b).

The petition for rehearing and the petition for rehearing en banc are denied.

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[1] The Honorable Judith N. Keep, United States District Judge for the Southern District of California, sitting by designation.

APPENDIX E

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed: January 27, 1988]

Nos 85-6061, 85-6062, 87-5514

PAUL ROBI,
Plaintiff-Appellee,

v.

FIVE PLATTERS, INC.,
Defendant-Appellant.

FIVE PLATTERS, INC.,
Plaintiff-Appellant,

v.

PAUL ROBI, AMERICANA HOTEL CORP., GINO TONETTI and HOWARD WOLFE,
Defendants-Appellees.

TONY WILLIAMS,
Plaintiff-Appellee,

v.

THE FIVE PLATTERS, INC.,
Defendant-Appellant.

OPINION

Before: HALL, NOONAN and THOMPSON, Circuit Judges.

DAVID R. THOMPSON, Circuit Judge:

These consolidated appeals present competing claims to the name THE PLATTERS based upon prior conflicting judgments which the parties, selectively, assert as *res judicata*. Appellant The Five Platters, Inc. (the "Corporation") contends that the district court should have given preclusive effect to a 1975 decision by the Court of Customs and Patent Appeals and to a 1982 New York judgment. The Corporation claims these judgments establish its exclusive right to the name THE PLATTERS for use in connection with a musical entertainment service.

Appellees Paul Robi and Tony Williams are two of the original music entertainers who were known as THE PLATTERS. Appellee Robi contends the district court was correct when it decided to give preclusive effect, not to the

judgments relied upon by the Corporation, but to a 1974 California Superior Court judgment in Robi's favor and against the Corporation. Appellee Williams presents this same argument. As to Williams, however, there is the added circumstance that the district court decided his case a few months after it decided the Robi cases. Thus, at the time Williams' case was decided there was yet another judgment to consider--the district court's own judgment in the recently decided Robi cases.

We affirm in the two Robi cases (No. 85-6061 and No. 85-6061), and reverse in the Williams case (No. 87-5514).

I
FACTS AND PROCEEDINGS

In 1953, a singing group named The Platters was formed and struggled to gain recognition. By 1954, the group consisted of five performs we refer to as the "original" Platters. These performers appeared together on television and in concert . . . records," that is, records which sold over one million copies.

In January 1956, when the group began to achieve worldwide popularity, its manager and musical director, Buck Ram, suggested that a corporation be formed. He selected an attorney for this purpose, and the Corporation was incorporated under the name "The Five Platters, Inc." The original Platters, who included appellees Robi and Williams, executed employment contracts with the Corporation. They assigned to the Corporation their rights in the name THE

PLATTERS in exchange for the issuance to them of shares of stock in the Corporation. Later, in the 1960s, all of the original Platters sold their shares of stock to Buck Ram or to a corporation he controlled.

By 1972, appellee Robi had left the original group, and was performing with other artists. That year, the Corporation sued Robi in a state court action in California. It sought to prevent him from presenting his group as THE PLATTERS. The Corporation claimed it owned the exclusive right to the name THE PLATTERS based upon the assignments it had received from Robi and the other original Platters. The California Superior Court (the "California Court") granted judgment in 1974 in favor of Robi. The California Court determined that the Corporation "was a sham used by Mr. Ram to obtain ownership of the name 'Platters'"; that Ram benefitted from an unequal bargaining position between the parties and was guilty of laches and unclean hands; and that the Corporation's issuance of stock to the original Platters was "illegal and void" because the stock was issued in violation of California's corporate securities law. The Corporation appealed, but later dismissed the appeal.

While the California action was pending, and before that court entered its judgment, appellee Tony Williams also became involved in litigation with the Corporation. He petitioned the Trademark Trial and Appeal Board to cancel the Corporation's registration of the service mark, THE PLATTERS. The Board rejected Williams' petition when he failed to respond to the Corporation's motion for summary judgment. He moved to vacate that decision on the ground that he had failed to respond due to "inadvertence, accident or

mistake." The Board denied Williams' motion, and its denial was upheld on appeal. *See Williams v. Five Platters, Inc.*, 181 U.S.P.Q. (BNA) 409, 409-10 (Feb. 26, 1974), *aff'd*, 510 F.2d 963 (C.C.P.A.1975).

Several years later, the Corporation filed an action against Williams in the Supreme Court of the State of New York for New York County (the "New York Court"). The New York Court determined that Williams had breached a 1967 contract, pursuant to which he had sold all of his stock in the Corporation and had received approximately $15,000. In this contract, Williams had covenanted to refrain from using the name THE PLATTERS. The contract also contained the following provision:

> Having previously by employment contract dated July 5, 1956 acknowledged that the name "The Platters" is owned exclusively by the corporation Five Platters, Inc., it is hereby expressly acknowledged again by WILLIAMS that the name "The Platters" is now owned exclusively by a corporation known as The Five Platters, Inc.

The New York Court permanently enjoined Williams from using the name THE PLATTERS except to refer to his previous membership in the group. The court also concluded that Williams was "barred by res judicata from challenging [the Corporation's] Federal registration of THE PLATTERS mark . . . by reason of" the decision of the Court of Customs and Patent appeals in *Williams v. Five Platters, Inc.*, 510 F.2d

963 (C.C.P.A.1975).[1] These three judgments, the 1974 California Court judgment in which Robi prevailed against the Corporation; the 1975 decision by the Court of Customs and Patent Appeals in favor of the Corporation and against Williams; and the 1982 New York judgment in which the Corporation prevailed against Williams, were three of the judgments for which varying effects of *res judicata* were argued by the parties in the district court.

II
APPLICABLE LEGAL PRINCIPLES

A. *Standard of Review*

We review de novo a district court's ruling on the availability of *res judicata* both as to claim preclusion and as to issue preclusion. *Blasi v. Williams*, 775 F.2d 1017, 1018 (9th Cir. 1985) (claim preclusion); *Davis & Cox v. Summa Corp.*, 751 F.2d 1507, 1519 (9th Cir. 1985) (issue preclusion). The preclusive effect of a judgment in a prior case presents a mixed question of law and fact in which the legal issues predominate. *Blasi*, 775 F.2d at 1018. As to issue preclusion, "[o]nce we determine that [it] is available,

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[1] The Corporation also has litigated its claim to the exclusive rights to THE PLATTERS against other members of the original group, *see The Five Platters, Inc. v. Taylor*, No. C-5249 (D.Colo., Feb.1, 1974), and against other entities which were not connected with the original Platters. *See The Five Platters, Inc. v. Purdie*, 419 F.Supp. 372, 377 (D.Md.1976) ("Since 1967, plaintiff has been in a constant battle to stem the tide of proliferating imitators [of The Platters].").

the actual decision to apply it is left to the district court's discretion." *Davis & Cox*, 751 F.2d at 1519.

B. *Res Judicata*

Generally, the preclusive effect of a former adjudication is referred to as "*res judicata*". The doctrine of *res judicata* includes two distinct types of preclusion, claim preclusion and issue preclusion.[2] Claim preclusion "treats a judgment, once renders, as the full measure of relief to be accorded between the same parties on the same 'claim' or 'cause of action.'" *Kaspar Wire Works, Inc. v. Leco Eng'g & Mach., Inc.*, 575 F.2d 530, 535 (5th Cir. 1978); *see also McClain v. Apodaca*, 793 F.2d 1031, 1037 (9th Cir. 1988). Claim preclusion "prevents litigation of all grounds for, or defenses to, recovery that were previously available to the parties, regardless of whether they were asserted or determined in the prior proceeding." *Brown v. Felsen*, 442 U.S. 127, 131, 99 S.Ct. 2205, 2209, 60 L.Ed.2d 767 (1979) *quoted in Americana Fabrics, Inc. v. L&L Textiles, Inc.*, 754 F.2d 1524, 1529 (9th Cir. 1985).

The doctrine of issue preclusion prevents relitigation

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[2] We prefer to use these terms rather than "merger," "bar," and "collateral estoppel," *See Americana Fabrics, Inc. v. L&L Textiles, Inc.*, 754 F.2d 1524, 1529 (9th Cir. 1985). The Supreme Court has encouraged the use of claim preclusion and issue preclusion rather than *res judicata* (as merger or bar) and collateral estoppel, respectively. *See Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1, 104 S.Ct. 892, 894 n.1, 79 L.Ed.2d 56 (1984).

of all "issues of fact or law that were actually litigated and necessarily decided" in a prior proceeding. *Segal v. American Tel. & Tel. Co.*, 606 F.2d 842, 845 (9th Cir. 1979), *quoted in Americana*, 754 F.2d at 1529. "In both the offensive and defensive use situations the party against whom estoppel [issue preclusion] is asserted has litigated and lost in an earlier action." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 329, 99 S.Ct. 645, 650, 58 L.Ed.2d 552 (1979). The issue must have been "actually decided" after a "full and fair opportunity" for litigation. 18 C. Wright, A. Miller & E. Cooper, *Federal Practice & Procedure: Jurisdiction § 4416*, at 138 (1981) [hereinafter 18 Wright].

Under the Full Faith and Credit Act, federal courts must give state judicial proceedings "the same full faith and credit . . . as they have by law or usage in the courts of [the] State . . . from which they are taken." 28 U.S.C. § 1738; *see Parons Steel, Inc. v. First Alabama Bank*, 474 U.S. 518, 519, 106 S.Ct. 768, 770, 88 L.Ed.2d 877 (1986). This Act requires federal courts to apply the *res judicata* rules of a particular state to judgments issued by courts of that state. *Id.* at 523, 106 S.Ct. at 771. Accordingly, we apply California law of *res judicata* to the California judgment, New York law to the New York judgment and federal law to the federal judgments.

C. *Inconsistent Judgments*

Courts are not required to apply *res judicata sua sponte*. Thus, if a second court to face a claim or issue is not presented with *res judicata* arguments, or rejects these arguments, an inconsistent judgment may arise. If two or

more courts render inconsistent judgments on the same claim or issue, a subsequent court is normally bound to follow the most recent determination that satisfies the requirements of *res judicata*. *See Americana*, 754 F.2d at 1529-30; *see also Treinies v. Sunshine Mining Co.*, 608 U.S. 66, 75-78, 60 S.Ct. 44, 49-51, 84 L.Ed. 85 (1939); *Porter v. Wilson*, 419 F.2d 254, 259 (9th Cir. 1969), *cert. denied*, 397 U.S. 1020, 90 S.Ct. 1260, 25 L.Ed.2d 531 (1970). Restatement (Second) of Judgments § 15 (1982).[3] This is referred to as the "last in time" rule. *Americana*, 754 F.2d at 1526.

In *Americana* we applied the last in time rule to resolve conflicting judgments rendered by a California Superior Court and a United States District Court for the Southern District of New York ("SDNY"). A contract dispute arose between Americana Fabrics and L & L Textiles. Americana sought to compel arbitration as provided by the contract. The California Court issued an order staying arbitration. Approximately one month later, the SDNY found the contract's arbitration clause enforceable and ordered arbitration. *Id.* at 1527. A federal district court in California was then asked to enforce the SDNY judgment. It refused to

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[3] The Restatement suggests that a court might justifiably part with the last in time doctrine when the second of two conflicting judgments results from an error in the application of "full faith and credit to the judgment of a sister state and the losing party was denied review in the Supreme Court of the United States." Restatement (Second) of Judgments § 15 comment c (1982) (citing Restatement (Second) Conflict of Laws § 114 comment b (1971)). This issue is not presented by these consolidated appeals.

do so. We reversed, holding that the SDNY judgment — right or wrong — was binding because it was the last in time. *Id.* at 1530.

When two inconsistent judgments exist, it is tempting for a court to reexamine the merits of the litigants' dispute and choose the result it likes best. There are important reasons to avoid this temptation. First, if one party could have raised *res judicata*, but it did not, that litigant must bear the cost of its tactic or inadvertence. *See* 18 Wright § 4404 at 26-27. Second, the most recent court to decide the matter may have considered and rejected the operation of the prior judgment as *res judicata*, and *its* decision should be treated as *res judicata* on the preclusive effect of the prior judgment. *See Americana*, 754 F.2d at 1530. Finally, the last in time rule is supported by the rationale that it "'end[s] the chain of relitigation . . . by stopping it where it [stands]' after entry of the [most recent] court's judgment, and thereby discourages relitigation in [yet another] court." *Id.* (quoting *Porter v. Wilson*, 419 F.2d 254, 259 (9th Cir.1969), *cert. denied*, 397 U.S. 1020, 90 S.Ct. 1260, 25 L.Ed.2d 531 (1970)). Therefore, even when we think that the most recent judgment might be wrong, we still give it *res judicata* effect so that finality is achieved and the parties are encouraged to appeal an inconsistent judgment directly rather than attack it collaterally before another court. *See id.*

III
THE ROBI CASES

In the two Robi cases now before us, the district court granted Robi's motion for preliminary injunction (No. 85-

6061), and dismissed the Corporation's complaint against Robi for alleged trademark infringement and unfair competition (No. 85-6062). In both of these cases, the district court gave claim preclusive *res judicata* effect to the 1974 California Superior Court judgment.

A. *The California Judgment*

In its suit against Robi in California, the Corporation described the essence of its complaint in its trial brief: "Plaintiff seeks to establish, once and for all, that the only entity entitled to use the name 'The Platters' is plaintiff itself." The Corporation argued that the employment contracts it had negotiated with Robi and the other original Platters transferred to it whatever personal rights those performers might have had in the name THE PLATTERS. The Corporation entered into evidence its federal service mark registration of THE PLATTERS and it advanced legal theories of trademark ownership to support its claim to the name. After a full trial on the merits, the California Superior Court denied the Corporation any injunctive relief or damages. Judgment in favor of Robi was entered.

B. *The Present Robi Cases*

In the first Robi case in these consolidated appeals, No. 85-6061, Robi sued the Corporation. He asked the district court to declare the rights of the parties to the name, THE PLATTERS, and to enjoin the Corporation from interfering with his use of that name. The district court granted Robi's application for a preliminary injunction against the Corporation. The district found that Robi was likely to

succeed on the merits of his case "due to the collateral estoppel effect of the 1974 Superior Court judgment." *Robi v. The Five Platters, Inc.*, No. CV-84-3326-CBM (C.D.Cal. May 22, 1985). Robi also established the possibility of irreparable injury if injunctive relief were denied. *Id.*

In the other Robi case, No. 85-6062, the Corporation sued Robi and others for trademark infringement and unfair competition. The district court granted Robi's motion to dismiss the Corporation's complaint. The district court referred to principles of *res judicata* (in the sense of claim preclusion) and collateral estoppel, again based on the 1974 California Court judgment. It decided that these principles precluded the Corporation from relitigating its claim that, as against Robi, it had the exclusive right to use the name THE PLATTERS.

C. *The Res Judicata Effect of the 1974 California Judgment in the Robi Cases*

We look to California law to determine the *res judicata* effect of a California judgment. Because the doctrine of claim preclusion disposes of the two Robi cases on appeal, we do not consider the possible application of issue preclusion to his cases We also reject the Corporation's estoppel and statute of limitations arguments. These arguments do not defeat the claim preclusive effect of the 1974 California judgment.

The application of claim preclusion in California focuses on three questions: (1) was the previous adjudication on the merits, (2) was it final, and (3) does the current dispute

involve the same "claim" or "cause of action"? *See Slater v. Blackwood*, 15 Cal.3d 791, 795, 543 P.2d 593, 594, 126 Cal.Rptr: 225, 226 (1975). The California Superior Court judgment was on the merits and final. *See Palma v. United States Industrial Fasteners, Inc.*, 36 Cal.3d 171, 182, 681 P.2d 893, 900, 203 Cal.Rptr. 626, 633 (1984). The Corporation does not challenge the 1974 judgment on either of these grounds. Instead, it argues that the dispute resolved by the district court in the two Robi cases does not involve the same claim or cause of action which was before the California Superior Court. The Corporation argues that the claim that was before the California Court involved the interpretation of the contract between Robi and the Corporation by which Robi allegedly transferred to the Corporation all of his rights in the name THE PLATTERS. The claims that were before the district court in the two Robi cases, the Corporation argues, involve the Corporation's trademark rights; and these trademark rights, it contends, are separate and distinct from the Corporation's contract rights.

We disagree. The Corporation is asserting in the present Robi cases the same right it asserted in the California case, that is, its claim to the exclusive use of the name THE PLATTERS as against Robi. The Corporation also presents the same legal theories in the current Robi cases as it did in the California case. Even if it were now asserting trademark and unfair competition theories, and only had asserted a contract theory before the California Court, the right which it now seeks to protect is the same right it sought to protect in California. "California has consistently applied the 'primary rights' theory, under which the invasion of one primary right gives rise to a single cause of action." *Slater*, 15 Cal.2d at

795, 543 P.2d at 894, 126 Cal.Rptr. at 226. As we recently observed, California's "primary rights" theory "does not mean that different causes of action are involved just because relief may be obtained under . . . either of two legal theories." *Los Angeles Branch NAACP v. Los Angeles Unified School Dist.*, 750 F.2d 731, 737 (9th Cir. 1984) (en banc) *cert. denied*, 474 U.S. 919, 106 S.Ct. 247, 88 L.Ed. 2d 256 (1985).

The present Robi cases involve the same cause of action decided by the California Court in 1974. The claim preclusive effect of the 1974 California judgment precludes the Corporation from challenging Robi's use of the name THE PLATTERS. "*Res judicata* [claim preclusion] prevents litigation of all grounds for, or defenses to, recovery that were previously available to the parties, regardless of whether they were asserted or determined in the prior proceeding." *State Bd. of Equalization v. Superior Court*, 39 Cal.3d 633, 641, 703 P.2d 1131, 1136, 217 Cal.Rptr. 238, 242, (1985) (quoting *Brown v. Felsen*, 442 U.S. 127, 131, 99 S.Ct. 2205, 2209, 60 L.Ed.2d 767 (1979)).

We conclude that the district court did not err in giving the 1974 California judgment claim preclusive effect in the Robi cases. It correctly granted Robi's motion for a preliminary injunction and dismissed the Corporation's complaint.

IV
THE WILLIAMS CASE

Like Paul Robi, Tony Williams has been engaged in

a long battle with the Corporation over the name THE PLATTERS. Williams began his attack by challenging the Corporation's federal service mark registration. That challenge proved to be unsuccessful when Williams, perhaps due to inadvertence, did not oppose the Corporation's motion for summary judgment. *Williams v. Five Platters, Inc.*, 510 F.2d 963 (C.C.P.A.1975). When the Corporation later sued Williams in New York, the New York Court did not permit Williams to challenge the Corporation's service mark registration. The New York Court gave *res judicata* effect (presumably claim preclusion) to the 1975 Court of Customs and Patent Appeals' decision. It rejected Williams' argument that Robi's 1974 California judgment should be given "*res judicata*" or "collateral estoppel" effect against the Corporation in Williams' case. The New York court noted that Williams had been "dilatory and unsuccessful [in providing the New York court with] an admissible transcript of the California lawsuit." It found that the claimed defects in the Corporation's issuance of stock in California were "technical"; that Williams had realized substantial benefits from his ownership of the shares and from his employment by the Corporation; and that there was "no evidence of unclean hands on the part of [the Corporation]."

The district court rejected the New York judgment and the decision of the Court of Customs and Patent Appeals on which the New York Court relied. The district court concluded that the New York Court had failed to give full faith and credit to the 1974 California judgment. Giving the California judgment the faith and credit the district court felt it deserved, the district court permitted Williams to use offensive issue preclusion (sometimes referred to as

"offensive collateral estoppel") from the California judgment to defeat any claim preclusive effect of the New York judgment.

A trial court has broad discretion to apply offensive issue preclusion. *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 331, 99 S.Ct. 645, 651, 58 L.Ed.2d 552 (1979). Whether the district court abused this discretion is the issue we confront. To answer this question, we must first consider the *claim* preclusive effect of the New York judgment against Williams.

A. *Claim Preclusion and the New York Judgment*

We look to New York law to determine the *res judicata* effect of the New York judgment against Williams. *See* 28 U.S.C. § 1738. Under New York law, a valid final judgment bars any future action between the same parties on the same cause of action. *See Reilly v. Reid*, 45 N.Y.2d 24, 27, 379 N.E.2d 172, 174, 407 N.Y.S.2d 645, 647 (1978). Whether claim preclusion applies in a particular New York case depends on the definition of a "cause of action." If the current Williams dispute involves the same cause of action as the New York case, which was concluded with a final judgment, then claim preclusion prevents any recovery in the current action. *Id.* New York courts generally require a plaintiff to include all possible theories of recovery for one transaction in one lawsuit, "'regardless of the number of substantive theories or variant forms of relief . . . available to the plaintiff.'" *Smith v. Russell Sage College*, 54 N.Y.2d 185, 192, 429 N.E.2d 746, 749, 445 N.Y.S.2d 68, 71 (1981) (quoting Restatement (Second) of Judgments § 61 comment a

(Tent. Draft No. 4, 1978)).

New York law, however, apparently departs from the Restatement formulation of claim preclusion. In New York, "two or more different and distinct claims or causes of action may often arise out of a course of dealing between the same parties, even though it is not, except in refined legal analysis, easy to say that a different gravamen is factually involved." *Reilly*, 45 N.Y.2d at 28, 379 N.E.2d at 175, 407 N.Y.S.2d at 648. One New York court applied *Reilly* to find three separate "causes of action" arising from a single transaction. *See Lukowsky v. Shalit*, 110 A.D.2d 563, 566-67, 487 N.Y.S.2d 781, 784 (1985). There the court held that a prior action for nonpayment of rent under a sublease agreement was not claim preclusive in a second action for fraud that challenged the validity of the same sublease agreement. This was true even though fraud was presented as a defense in the first action. The court reasoned that "the second [action] may not be barred if the requisite elements of proof and evidence necessary to sustain recovery vary materially" from the earlier action. *Id.* at 566, 487 N.Y.S.2d at 784. We are thus required to examine the earlier New York action and compare it to the present Williams action.

Long ago, Judge Cardoso, writing as the chief judge of the Court of Appeals of New York, stated that claim preclusion applies "when the two causes of action have such a measure of identity that a different judgment in the second would destroy or impair rights or interests established by the first." *Schuylkill Fuel Corp. v. b. & C. Nieberg Realty Corp.*, 250 N.Y. 304, 306-07, 165 N.E. 456, 457 (1929). Relitigation of Williams' claims in the district court in this

case would have necessarily impaired the Corporation's rights established by the New York judgment. Identical issues and indeed identical legal theories were presented in both cases: ownership of THE PLATTERS as determined by trademark law, the legal effect of the 1956 and 1967 contracts, and the *res judicata* effect of the 1974 California judgment. New York law protects the Corporation from being "vexed by further litigation" with Williams. *See Reilly*, 45 N.Y.2d at 28, 379 N.E.2d at 175, 407 N.Y.S.2d at 647.[4]

The dispute between Williams and the Corporation over the name THE PLATTERS is a single cause of action for purposes of claim preclusion under New York law. Both cases require a determination of whether the Corporation can prevent Williams from using the name THE PLATTERS. The cases certainly draw upon the same "congeries of facts." *See Smith v. Russell Sage College*, 54 N.Y.2d 185, 192, 429 N.E.2d 746, 749, 445 N.Y.S.2d 68, 71 (1981). "[W]here the same foundation facts serve as a predicate for each proceeding differences in legal theory and consequent remedy do not create a separate cause of action." *Reilly*, 45 N.Y.2d at 30, 379 N.E.2d at 176, 407 N.Y.S.2d at 649. Accordingly, the

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[4] We also note that Williams' present claim against the Corporation does not satisfy the "separate cause of action" exception under the New York rule of *Lukowsky v. Shalit*. In the litigation between Williams and the Corporation in New York, the New York Court considered precisely the same elements of proof and evidence that are relevant to proof of Williams' claim in his present case. The possibility that Williams did not fully pursue *res judicata* arguments available to him when presenting his case in New York does not alter this result.

New York judgment is claim preclusive against Williams. We now consider the effect this claim preclusion has on Williams' offensive use of issue preclusion.

B. *The District Court's Application of Issue Preclusion*

At the time the district court granted summary judgment in favor of Williams, there were three cases in which *Robi* had prevailed against the Corporation on substantially the same set of facts involved in the present Williams case. One of the cases which had been decided in Robi's favor was the California action in which judgment had been entered in 1974. The other two were the two Robi cases which the district court had decided approximately seven months before it decided the Williams case. Under the doctrine of issue preclusion, "once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in subsequent suits based on a different cause of action." *Shapley v. Nevada Bd. of State Prison Commissioners*, 766 F.2d 404, 408 (9th Cir. 1985). The issue in the prior action must be identical to the issue for which preclusion is sought. *Id.*[5] Only a final judgment that is "sufficiently firm" can be issue preclusive. *See Luben Indus. v. United States*, 707 F.2d 1037, 1040 (9th Cir. 1983). The party against whom issue preclusion is asserted must have litigated that issue in an earlier action and lost. *Parklane*

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[5] The Corporation does not claim that issue . . . sufficient incentive to litigate the district court cases involving Robi and the 1974 California case. *See Parklane Hosiery Co. v. Shore*, 439 U.S. 227, 330, 99 S.Ct. 645, 651, 58 L.Ed.2d 352 (1979).

Hosiery Co. v. Shore, 439 U.S. 322, 329, 99 S.Ct. 645, 650, 58 L.Ed.2d 552 (1979).[6]

Both the 1974 California judgment and the district court's earlier decision in the two Robi cases were final for purposes of issue preclusion. A final judgment "includes any prior adjudication of an issue in another action that is determined to be sufficiently firm to be accorded conclusive effect." Restatement (Second) of Judgments § 13 (1982). The California judgment clearly was sufficiently firm to be accorded conclusive effect. So was the district court's judgment in the two Robi cases. The following factors, which we draw from the Restatement, were present in the Robi cases the district court decided: the parties were fully heard, the district court supported its decision with a reasoned opinion, and that opinion is the proper subject of appellate review. *See* Restatement (Second) of Judgments § 13 comment g (1982), *quoted in Luben Indus. v. United States*, 707 F.2d 1037, 1040 (9th Cir. 1983).

The present appeals in no way affect the "firmness" of the Robi decisions in the district court for purposes of issue preclusion. *See United States v. Abatti*, 463 F.Supp. 596, 598-99 (S.D.Cal.1978((Thompson, J.) (reasoning that "a decision rendered by a court of competent jurisdiction is

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[6] The requirement that issue preclusion can only be asserted against a party that already enjoyed one opportunity to litigate the issue prevents the Corporation from asserting in these consolidated appeals other decisions in its favor that do not involve Williams or Robi, such a *The Five Platters, Inc. v. Purdie*, 419 F.Supp.372 (D.Md.1974).

presumptively correct"); Restatement (Second) of Judgments § 13 comment f 91982); 18 Wright § 4433, at 305 ("in federal courts . . . the preclusive effects of a lower court judgment cannot be suspended simply by taking an appeal that remains undecided"). This conclusion is all the more reasonable in these consolidated appeals because we affirm the district court judgment in the Robi cases.

We conclude that the district court's decision in the Robi cases, as well as the California Court's decision in the 1974 Robi case, generated issue preclusion against the Corporation. We now return to the question we posed earlier: Did the district court abuse its discretion in applying offensive issue preclusion from these decisions to defeat the claim preclusive effect of the New York judgment?

1. *The California Judgment*

As we have previously noted, the California Robi judgment preceded the New York Williams judgment. Because the New York judgment is later in time, and because it is claim preclusive against Williams, the district court could not apply any issue preclusive effect from the California judgment to defeat the claim preclusive effect of the later New York judgment. *Americana Fabrics, Inc. v. L & L Textiles, Inc.*, 754 F.2d 1524, 1530 (9th Cir. 1985).

2. *The District Court's Judgment in the Robi Cases*

Two conceptually distinct theories support application of offensive issue preclusion from the district court's decision

in the Robi cases. First, it may be argued that the district court's decision in the Robi cases should prevail over the New York judgment as *res judicata* simply because the district court's judgment is the last judgment in time in a sequence of inconsistent judgments involving the right to the name THE PLATTERS.[7] *See id.* Second, as we have noted, the district court has broad discretion to decide whether to permit offensive issue preclusion to trump the claim preclusive effect of a prior judgment. *See Parklane Hosier Co. v. Shore*, 439 U.S. 322, 331, 99 S.Ct. 645, 651, 58 L.Ed.2d 552 (1979).

(a) *The Last in Time Rule*

In *Americana*, we stated the general rule that when two courts face the same claim or issue, the second court to reach judgment should apply *res judicata* and therefore resolve the same claim or issue consistently with the first court. *Americana*, 754 F.2d at 1529. Sometimes, however, the second court reaches a different conclusion either because *res judicata* is not asserted by the parties in the second court or because the second court decides, rightly or wrongly, that *res judicata* does not apply. *Id.* If a third court is then presented with the same claim or issue, it faces conflicting judgments from the first two courts. The general rule under these circumstances is that the third court "should give *res judicata* effect to the last previous judgment entered." *Id.* at 1530; *see also* Restatement (Second) of Judgments § 15

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[7] The district court's simultaneous decisions in the Robi cases are so similar that we treat them as one decision in our analysis of the last in time rule.

(1982). Likewise if a fourth court faces three inconsistent judgments it should treat the third judgment (*i.e.*, the last in time) as *res judicata*. *Americana*, 754 F.2d at 1530 n. 2.

When the district court considered the present Williams action seeking declaratory relief, there were four relevant prior judgments for purposes of the last in time rule:

> (1) the California Court's 1974 judgment against the Corporation and in favor of Robi (issue preclusion),
>
> (2) the Court of Customs and Patent Appeals' 1975 judgment against Williams and in favor of the Corporation,
>
> (3) the New York Court's 1982 judgment in favor of the Corporation against Williams (claim preclusion), and
>
> (4) the district court's own simultaneous rulings in favor of Robi against the Corporation (issue preclusion).

Americana explained that one rationale underlying the last in time rule is "the implicit or explicit decision of the second court, to the effect that the first court's judgment is not *res judicata*, is itself *res judicata* and therefore binding on the third court." *Id.* at 1530 (citing *Porter v. Wilson*, 419 F.2d 254, 259 (9th Cir. 1969)). Another rationale behind the last in time rule is the finality that it offers to the litigants. The rule finds support in the societal interest in "'end[ing] the chain of relitigation . . . by stopping it where it [stands].'"

Americana, 754 F.2d at 1530 (quoting *Porter v. Wilson*, 419 F.2d at 259). As Judge Sneed stated; the most recent decision "is not binding because it is correct; it is binding because it is last." *Id.* This concept of finality is central to the entire body of *res judicata* doctrine. *See* 18 Wright § 4403, at 15.

The rationale that a subsequent court's consideration of prior judgments is itself *res judicata* assumes that the subsequent court could have or did consider the *res judicata* effect of earlier cases. *See Americana*, 754 F.2d at 1530; Restatement (Second) of Judgments § 15 comment b (1982). The district court, however, could not have considered either the claim preclusive or issue preclusive effect of the New York judgment against Williams when it decided the two Robi cases. Robi was not a party to the New York litigation between the Corporation and Williams. And the Corporation won that case. Therefore, so far as Robi was concerned, the New York judgment had no *res judicata* effect, either as to claim preclusion or issue preclusion, in Robi's cases. *See Lawlor v. National Screen Serv. Corp.*, 349 U.S. 322, 326, 75 S.Ct. 865, 867, 99 L.Ed. 1122 (1955). There was no issue, express or implied, in the two Robi cases concerning whether the New York judgment had any *res judicata* effect. *See Americana*, 754 F.2d at 1530. The first rationale for the last in time rule which we articulated in *Americana* is absent.

The second rule of *Americana* underpinning the last in time rule, that of ending the chain of litigation by following the judgment which is last in time, would be better served in Williams' case by giving *res judicata* effect to the New York judgment, not to the district court's judgments. The New York judgment is the last in time in which both Williams and

the Corporation were parties. We can think of no rational reason to permit Williams to avoid the claim preclusive effect of the New York judgment by trying to draw issue preclusion from a subsequent case in which he was not involved. Williams participated in the New York case and let the judgment in that case become final without appealing it. "If an aggrieved party believes that the second court [New York] erred in not giving *res judicata* effect to the first court's [California's] judgment, then the proper avenue of redress is appeal of the second court's judgment, not collateral attack in a third court." *Americana*, 754 F.2d at 1530.

(b) *Discretion to Apply Offensive Issue Preclusion*

In *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 99 S.Ct. 645, 58 L.Ed.2d 552 (1979), the Supreme Court outlined some potential hazards that could arise if offensive issue preclusion were applied under inappropriate circumstances.[8] Nonetheless, the Court concluded that the advantages of avoiding burdensome relitigation on identical issues and promoting judicial economy warranted permitting the use of offensive issue preclusion at the discretion of the trial court: "[T]he preferable approach for dealing with [the tension between issue preclusion's advantages and disadvantages] in the federal courts is not to preclude the use

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[8] The Court defined offensive issue preclusion, then described as offensive collateral estoppel, as occurring when "the plaintiff seeks to foreclose the defendant from litigating an issue the defendant has previously litigated unsuccessfully in an action with another party." *Parklane*, 439 U.S. at 326 n. 4, 99 S.Ct. at 649 n. 4.

of offensive collateral estoppel, but to grant trial courts broad discretion to determine when it should be applied." *Id.* at 331, 99 S.Ct. at 651. In the present Williams case, the district court exercised its discretion and applied offensive issue preclusion against the Corporation. We will not disturb a district court's exercise of discretion unless we have "'a definite and firm conviction that the court . . . committed a clear error of judgment in the conclusion it reached upon a weighing of the relevant factors.'" *Fjelstad v. American Honda Motor Co.*, 762 F.2d 1334, 1337 (9th Cir. 1985) (citations omitted).

In outlining guidelines for district courts to consider when determining whether to apply offensive issue preclusion, the Court described two basic purposes for issue preclusion: "protecting litigants from the burden of relitigating an identical issue with the same party or his privy and . . . promoting judicial economy by preventing needless litigation." *Parklane*, 439 U.S. at 326, 99 S.Ct. at 649. The Court recognized that these purposes might be disserved by the application of offensive issue preclusion in some circumstances. Indeed, offensive issue preclusion was expected to "increase rather than decease the total amount of litigation". *Id.* at 330, 99 S.Ct. at 651. The Court encouraged district courts, however, to apply offensive issue preclusion in such a way that the incentives to increase rather than decrease the total amount of litigation would be minimized. *See id.* at 331, 99 S.Ct. at 651. The Court observed that offensive issue preclusion allows potential plaintiffs to benefit by waiting on the sidelines rather than joining in the first litigation. This is true because an interested observer will be able to rely on a judgment

favorable to his interests against the defendant and yet not be bound by that judgment if the defendant wins. *Id.* at 330, 99 S.Ct. at 651. The potential for this abuse exists in a case such as the present one.

The *Parklane* Court also cautioned that use of offensive issue preclusion may be unfair to some defendants. *Id.* It identified one example of such possible unfairness as the application of offensive issue preclusion in the presence of inconsistent judgments. "Allowing offensive collateral estoppel may also be unfair to a defendant if the judgment relied upon as a basis, for the estoppel is itself inconsistent with one or more previous judgments in favor of the defendant." *Id.* Williams' appeal presents this circumstance. The district court applied offensive issue preclusion in the presence of the inconsistent New York judgment in favor of the Corporation.[9]

The Court in *Parklane* looked to the Restatement (Second) of Judgments to explain why offensive issue

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[9] As an illustration of the unfairness which could result from the application of offensive issue preclusion in the fact of inconsistent judgments, the Court in *Parklane* referred to Professor Currie's example of a railroad collision injuring 50 passengers all of whom bring separate actions against the railroad. After the railroad wins the first 25 suits, a plaintiff wins in suit 26. Professor Currie argues that offensive issue preclusion should not be applied so as to allow plaintiffs 27 through 50 automatically to recover. *Parklane*, 439 U.S. at 330 n. 14, 99 S.Ct. at 65 n. 14, *citing* Currie, *Mutuality of Estoppel: Limits of the Bernhard Doctrine*, 9 Stan.L.Rev. 281, 304 (1957).

preclusion should not be applied to inconsistent judgments. *See id.* at 330-31 nn. 14-16, 99 S.Ct. at 651 nn. 14-16 (discussing the Restatement (Second) of Judgments § 88 (Tent. Draft No. 2, Apr. 15, 1975), the precursor to current § 29). The Restatement states that one purpose of issue preclusion is to promote confidence in the accuracy of judicial determinations. One way this can be achieved is to stop a second court from rendering an inconsistent judgment by applying the doctrine of issue preclusion. *See* Restatement (Second) of Judgments § 29 comment f (1982). The District of Columbia Circuit has interpreted *Parklane* to prohibit the application of offensive issue preclusion "where the judgment relied on is inconsistent with other decisions." *Jack Faucett Assocs. v. American Tel. and Tel. Co.*, 744 F.2d 118, 125-26 (D.C.CIR.1984), *cert. denied*, 469 U.S. 1196, 105 S.Ct. 980, 83 L.Ed.2d 982 (1985). We do not read *Parklane* to be this restrictive. We prefer to read *Parklane* as providing guidance to the district courts for the appropriate exercise of discretion as to when to apply offensive issue preclusion in the presence of inconsistent judgments. In our case, however, it is not just the presence of inconsistent judgments which renders unfair the application against the Corporation of issue preclusion generated by the district court's Robi judgments. The unfairness to the Corporation is magnified enormously when, as in the present case, the judgment which generates issue preclusion (the district court's Robi judgment) is itself inconsistent with a judgment (the New York judgment) which the Corporation has obtained against the very plaintiff, Williams, on whose behalf issue preclusion is asserted. This is different from the scenario in *Parklane*. There the party against whom issue preclusion was asserted had experienced inconsistent judgments in litigation with parties other than the

present party opponent. *Parklane*, 439 U.S. at 324, 329, 99 S.Ct. at 650, *see also* Restatement (Second) of Judgments § 29 comment f (1982).

We conclude that the district court erred in applying offensive issue preclusion against the Corporation in Williams' case in the face of the claim preclusive effect of the New York judgment against Williams.

V
CONCLUSION

We affirm the district court's grant of the preliminary injunction in favor of Robi in appeal No. 85-6061. We affirm the district court's dismissal of the Corporation's complaint against Robi in appeal No. 85-6062. We reverse the district court's grant of summary judgment in favor of appellee Williams and against the Corporation in appeal No. 87-5514, and remand that case to the district court with instructions to vacate the summary judgment in favor of Williams and enter summary judgment in favor of the Corporation, The Five Platters, Inc.

Appellee Robi shall recover his costs on appeal in appeals No. 85-6061 and No. 85-6062. The Corporation shall recover its costs on appeal in appeal No. 87-5514.

AFFIRMED IN PART, REVERSED IN PART, AND REMANDED.

APPENDIX F

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

[Filed: May 22, 1985]

No. CV-84-9873-CBM

THE FIVE PLATTERS, INC.,
Plaintiffs,

v.

PAUL ROBI,
Defendant.

ORDER GRANTING MOTION TO DISMISS & REQUEST TO TAKE JUDICIAL NOTICE AND DENYING MOTIONS TO CONSOLIDATE & FOR PRELIMINARY INJUNCTION

1. FACTS

A. Procedural History

This action and action No. CV-84-3326-CBM, involve the ownership of the right to use the name "The Platters" in connection with a singing group.

The Five Platters, Inc. has repeatedly sued Robi and the venues at which he is to perform, claiming that The Five Platters, Inc. owns the tradename "The Platters". The first of these actions brought in the 1960's, was dismissed for failure to prosecute. The second, filed one month after the first was dismissed, was decided in Robi's favor. Despite this prior court decision, the Five Platters, Inc. has continued to sue Robi and to threaten theater owners who engage Robi.

Robi has moved to dismiss The Five Platters, Inc.'s complaint in action CV-84-9873 on the basis of res judicata. He also moved for a preliminary injunction in case CV-84-3326 against The Five Platters, Inc.'s continuing to file and threatening to file these actions. He also requests that the Court impose sanctions under Local Rule 4.4, as The Five Platters, Inc. has filed an action in Florida without giving this Court notice of the Florida action.

The Five Platters, Inc. originally brought action CV-84-9873 in Illinois; United States District Judge Prentice Marshall transferred that action here in response to Robi's motion for change of venue. The Five Platters, Inc. now moves to consolidate both cases, and for preliminary injunction in case No. CV-84-9873, against Robi using the name "The Platters" in connection with his performance.

B. The History of "The Platters"

Thirty years ago, in September, 1954 Paul Robi joined Herbert Reed, Tony Williams, Zola Taylor and David Lynch in a singing group which had been formed in 1953 and had performed with little success in the Los Angeles area. The

group was called "The Platters".

Robi was the only Platter who had musical training. When he joined the group, he assisted the other Platters with musical arrangements, and organized and led the group's rehearsals. They foreswore further performances in 1954, spending their time rehearsing.

In early 1955, the five Platters emerged as a performing group. Success came quickly. During the period from 1955 to 1960 The Platters recorded many hit records; thirteen of their recordings made during this period sold more than a million records. Among their hits were "The Great Pretender" and "Twilight Time". All told, The Platters sold over forty million records during this time period. They performed throughout the United States, and all over the world. They made appearances in moves and on television shows, including The Ed Sullivan Show.

From 1955 through 1964, The Platters had a recording contract with Mercury Records. All of The Platters' hit records were recorded during this nine year period. The only persons to perform as The Platters during this period were Robi, Taylor, Reed, Williams, and Lynch.

The Five Platters, Inc. has presented a list of major hit records and performance credits of The Platters. This list evidences the goodwill created by Robi, Taylor, Reed, Williams, and Lynch in the name "The Platters".

From 1955 on, The Platters was managed by Buck Ram. Ram managed the group, promoted the group, and

composed many of its songs. He also acted as The Platters' financial and legal advisor. He represented Robi and to the other members of the group that he would look after their welfare. Robi and the other Platters were young and inexperienced in business. Ram obtained control of the financial, legal and business affairs of The Platters.

In 1956, based on Buck Ram's advice, The Platters undertook to form a corporation known as "The Five Platters, Inc." (a party here). Robi, Taylor, Reed, Williams and Lynch were the original stockholders of the corporation. As recommended by Ram, Robi and the other Platters assigned their rights to the trade name "The Platters" to the corporation in exchange for stock in the corporation.

Between 1960 and 1965, Ram illegally obtained all the shares of stock in the corporation; The Platters worked as the corporation's employees.

Robi left The Platters in 1965, after several disagreements with Ram, and after Robi had come to believe that Ram had unfairly taken advantage of Robi and the other Platters, and apparently after some personal problems as well. Robi then formed his own group called "The Platters".

From 1965 to the present, there have been two performing groups known as "The Platters". One group is controlled by Buck Ram and his corporation, The Five Platters, Inc. The other group is Robi's.

During the period 1967 to 1976, Robi was a defendant in a series of legal actions brought by The Five Platters, Inc.

in Los Angeles County Superior Court. This prior litigation spanned a nine-year period. Three times The Five Platters, Inc. attempted unsuccessfully to obtain preliminary injunctions against Robi. This prior litigation resulted in a judgment at trial against The Five Platters, Inc. and in Robi's favor. As will be discussed later, this judgment acts as a complete bar to action No. 84-9873. As a result of the findings of the Los Angeles Superior Court after trial, The Five Platters, Inc. is estopped from denying Robi's allegations in action No. 84-3326.

C. The California Superior Court Litigation

There has been extensive litigation in California Superior Court concerning the identical claims and issues now brought before this Court by The Five Platters, Inc. This prior litigation was brought by The Five Platters, Inc. against Robi and against the owners of venues at which Robi was to, or did, perform.

The prior litigation filed by The Five Platters, Inc., and involving Robi, is as follows:

1. A complaint was filed by The Five Platters, Inc. against Robi, et al., on September 28, 1967 in Los Angeles Superior Court case No. 918695, requesting a temporary restraining order, preliminary and permanent injunction against Robi and others prohibiting Robi from appearing, performing or recording under the name "The Platters." The Five Platters, Inc.'s application for temporary restraining order was denied on September 28, 1967. On November 1, 1967 The Five Platters, Inc.'s motion for

preliminary injunction was denied. This action was dismissed for failure to prosecute on October 10, 1967.

2. One month after the first action was dismissed for failure to prosecute, The Five Platters, Inc. filed another complaint against Robi, et al. One of the nightclubs in which Robi was performing was also named as a defendant; early in the litigation, this defendant entered into a stipulated judgment, agreeing to an inunction.

3. The second action was tried, commencing on September 4, 1974. At the time of trial, a trade name/trademark had been issued for the use of the name "The Platters" to The Five Platters, Inc. for one year. Proof of registration was entered into evidence at the trial. The Five Platters, Inc. also filed a trial brief which extensively argued its trade name/trademark rights to use the name "The Platters." The trial brief argued: That The Five Platters, Inc. was the owner of the U.S. Trademark registration "The Platters"; that The Five Platters, Inc. claimed infringement of its trademark and that the resolution of the trial turned on questions of trademark law; and that The Five Platters Inc.'s marks on Robi's marks were similar, and that the parties were in direct competition.

Findings of fact and conclusions of law and a judgment in Robi's favor were filed on November 14, 1974. The Superior Court, in its findings of fact and conclusions of law found:

1. That during the year 1954, a singing group of five individuals began appearing professionally under the

name of The Platters and that Paul Robi was a member of the group;

2. That during the period 1954-1959, when the group became enormously popular, the composition of the group remained the same and included Paul Robi, and that the name "The Platters" was owned by the five individuals comprising the group as a partnership, and that the five individuals, including Robi, are the individuals in the public mind who comprise the group "The Platters", and were responsible for its success;

3. That The Five Platters, Inc. was formed by a lawyer selected by Buck Ram, and that shortly thereafter, Robi and the other members of the group executed employment contracts with the corporation where the right to the name "The Platters" purportedly was transferred to the corporation in return for the corporation's stock;

4. That the corporation's stock which was thereafter issued to the members of the group was issued illegally and that the issuance was void in that it did not comply with the terms of the permit issued by the Division of Corporations of the State of California;

5. That Robi's purported transfer of his rights in the name The Platters to the corporation was never effectuated since the stock transfer was illegal and in violation of California's securities laws;

6. That members of The Platters received nothing from the corporation for their interest in the name The

Platters, and that the corporation was dominated by Buck Ram and was a sham used by Ram to obtain ownership of the name;

7. That an unequal bargaining position existed between Ram and the members of The Platters, including Robi;

8. That the group sponsored by The Five Platters, Inc. includes none of the people who made the name The Platters famous;

9. That The Five Platters, Inc. has been acting with the intention of misleading the public into believing that the group it is presenting as The Platters is the original Platters, and that a substantial portion of the public has been misled by the corporation's acts;

10. That The Five Platters, Inc. has been guilty of laches, does not come into equity with clean hands, and is not entitled to injunctive relief.

The issues which resulted in these findings of fact were fully litigated, fully adjudicated on the merits with finality, and the fundamental rights of the parties were judicially determined.

Plaintiff took an appeal of the trial court's decision of November 18, 1974; this appeal was abandoned, and was dismissed on July 19, 1976.

Since the time that the above final and binding

determination was entered in 1974, The Five Platters, Inc. has repeatedly instituted litigation against Robi, based on the same claims that were decided by the 1974 judgment. One such action, filed by The Five Platters, Inc. against Robi in Australia, resulted in an Australian court granting a temporary restraining order against Robi. Apparently, no court hearing was held, and the Australian court was not made aware of the prior California judgment in Robi's favor. The Five Platters, Inc. has sent letters to venues at which Robi was scheduled to or did appear threatening litigation should Robi be permitted to perform using the name "The Platters" in connection with his act. These threats have interfered with Robi's ability to pursue his business. The corporation has also filed suit in U.S. District Court in Florida against one of the venues at which Robi performed.

In the instant litigation, case No. 84-9873 was originally filed in a distant location, Illinois. Robi denies having recently performed in Chicago with his group. Robi was forced by The Five Platters, Inc.'s acts to appear in Illinois, and to move for change of venue to this district.

II. ANALYSIS

A. Robi's Motion to Dismiss The Five Platters, Inc.'s First Amended Complaint in CV-84-9873 Shall be Granted.

"Under the doctrine of res judicata, a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based upon the same cause of action." Parklane Hosiery Co. v. Shore, 439 U.S. 322 n. 4 (1979).

Under the doctrine of collateral estoppel, "the second action is upon a different cause of action and the judgment in the prior suit precludes relitigation of the issues actually litigated and necessary to the outcome of the first action." Id. A state court judgment is accorded full faith and credit in the Federal Court, 28 U.S.C. § 1738.

The Five Platters, Inc.'s 1972 Superior Court complaint brought damages and an injunction against Robi. That action alleges that The Five Platters, Inc. had the sole right to use the name "The Platters"; the heart of that complaint sounded in unfair competition. The Five Platters, Inc. extensively argued its trademark and trade name rights before the Superior Court. The finding that the corporation's trademark was invalid and was necessary to the outcome of the first action. The trial court found that the transfer of the name "The Platters" to "The Five Platters, Inc." by Robi was illegal, unconscionable, and a result of false representations made by Ram. The court further found that The Five Platters, Inc. had misled the public, and was guilty of unclean hands and laches. These findings invalidated The Five Platters, Inc.'s trademark.

The Five Platters, Inc. now comes before this Court, alleging in its complaint No. CV-84-9873 that its trademark/ service mark in the name "The Platters" has been infringed upon, and that Robi and the other defendants are guilty of unfair competition by using the name "The Platters" to promote Robi's act - the exact same issues decided by the trial court in 1974.

The Five Platters, Inc. also contends that facts have

changed since the entry of the judgment against it. It contends that the singing group it sponsors now calls itself "The Five Platters" and alleges that the public can no longer confuse this group with the original Platters due to the name change. This alleged change in circumstance does not alter the fact that in 1974, the trial court found that Robi, not the corporation, has the right to use the name "The Platters" in connection with his act. The change in name is de minimus, and does not affect the vitality of the 1974 judgment.

The Five Platters, Inc. also argues that a stipulated judgment in the 1974 action between it and 12319 Corporation conflicts with the trial court's 1974 judgment. This stipulated judgment was entered into without a trial. At a hearing to discuss the findings after trial, this issue was raised with the corporation's lawyer. The judge indicated that the stipulation conflicted with his findings; the corporation's lawyer opined that "a person can stipulate to something that he might otherwise successfully defend." The corporation is now judicially estopped to deny that its lawyer disclaimed any conflict between the court's findings and the stipulated judgment.

The motion to dismiss shall be GRANTED and The Five Platters, Inc.'s first amended complaint, CV-84-9873, DISMISSED with prejudice.

B. Robi's Request to Take Judicial Notice

Federal Rule of Evidence 201(b)(2) provides: "A judicial noticed fact must be one not subject to reasonable dispute in that it is . . . capable of accurate and ready

determination by resort to resources whose accuracy cannot reasonably be question." Here Robi has requested that this Court take notice that certain pleadings have been filed in the California Superior Court actions; that the Superior Court entered judgment in his favor after trial; that The Five Platters, Inc. appealed from that judgment, but abandoned its appeal; and that The Five Platters, Inc. has filed actions against Robi in Western Australia and Denver, Colorado. The records have been authenticated as required by 28 U.S.C. § 1738, are entitled to full faith and credit in this Court.

III. CONCLUSION

Accordingly this Court has granted Robi's Motion to Dismiss, that The Five Platters, Inc.'s first amended complaint in this action (No. CV-84-9873) be dismissed with prejudice, The Five Platters, Inc.'s Motions to Consolidate and For Preliminary Injunction are moot and DENIED on that basis. Robi's request to take judicial notice is GRANTED.

IT IS SO ORDERED.

DATED: May 22, 1985.

/s/_____
CONSUELO B. MARSHALL, Judge
United States District Court

APPENDIX G

SUPERIOR COURT OF THE STATE OF CALIFORNIA FOR THE COUNTY OF LOS ANGELES

[Filed: November 14, 1974]

No. C 43926

THE FIVE PLATTERS, INC., a California corporation,
Plaintiff,

v.

12319 CORPORATION, et al.,
Defendants.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The above-entitled cause came on regularly for trial on September 4, 1974, in Department 21, of the above-entitled Court, the Honorable William H. Levit, Judge, presiding, without a jury and was actually tried on that date and on September 5, 1974, plaintiff appeared by Loeb & Loeb by Robin Meadow, its attorney, and defendant, Paul Robi, appeared by Bernard R. Schulhof, his attorney.

Said cause having been heard, evidence both oral and documentary having been introduced and defendant having made motion for judgment pursuant to section 513;8 [sic] of the Evidence [sic] Code and the Court having granted that motion and having rendered its judgment in favor of defendant, now makes the following findings of fact and conclusions of law:

FINDINGS OF FACT

The Court finds that:

1. During the year 1954, a singing group made of 5 individuals began appearing professionally under the name of the "Platters". Defendant Paul Robi, was a member of this group.

2. During the years 1954 thru 1959, this group became enormously popular, made 12 "gold" records (phonograph records selling over one million copies), appeared on nationwide television shows and made concert tours.

3. The composition of this group remained the same from 1954 thru 1962. The public thought of the "Platters" as the five individual performers and in the public mind, the individuals who comprised the group were responsible for its success.

4. From 1954 to the present date, Buck Ram was the musical director of the group and personally or thru a corporation known as Personality Productions, Inc. which was

owned by him originally and then by one of his associates, acted as manager for the group.

5. Until January 1956, the name the "Platters" was owned by the five individuals comprising the group as a partnership. Buck Ram represented to the group that it was necessary for the best interest of the group and to protect the group, to form a corporation. That this would prevent others from utilizing the group name and trading on the group's reputation.

6. In January 1956, the plaintiff corporation was formed by a lawyer selected by Buck Ram. Shortly thereafter, defendant Paul Robi, and the other members of the group, executed employment contracts with the corporation by which purportedly the right to the name the "Platters" were transferred to the corporation in return for the corporation's stock. The corporate stock was thereafter issued to the members of the group. This stock issue was illegal and void in that it did not comply with the terms of the permit issued by the Division of Corporations of the State of California.

7. The members of the group received nothing from the corporation for their interest in the name, the "Platters" or other assets of the predecessor partnership. No capital was put in the corporation. The corporation was at all times dominated by Buck Ram and was a sham used by Mr. Ram to obtain ownership of the name the "Platters".

8. At the time the corporation was formed, Buck Ram was a law school graduate while the members of the group were young and inexperienced in business. An unequal bargaining position existed between the parties.

9. In the years 1962 thru 1966, all of the original five members of the group sold their interests in the corporation to Buck Ram as an individual.

10. The corporation has continued to present and is presenting to the public a group called the "Platters". This group includes none of the five people who made that name famous. Plaintiff has been and is doing this with the intention of misleading the public into believing that the group it is presenting as the "Platters" is the original "Platters". This group uses the same arrangements and fifty percent or more of the same repertoire and the same singing style as that popularized by the members of the original group.

11. The plaintiff and Buck Ram have misled a substantial portion of the public into believing that the group now presented as the "Platters" is the same as the original group. That a substantial portion of the public is misled by the way the present group is presented.

12. That the representation by Buck Ram, that the formation of the plaintiff corporation was for the best interests and protection of the members of the group, was false. That plaintiff corporation has been used to obtain the rights of the original members of the group to the name the "Platters".

13. That in 1967, plaintiff filed a suit on substantially the same facts and asked for the same relief as the present one against defendant Paul Robi and others. Said suit bearing Case No. 918695 was dismissed in 1972 for failure to bring it to trial in five years. Plaintiff has been guilty of laches in respect to prosecuting this cause of action and as a result is barred from proceeding therewith.

14. That plaintiff presented no proof of money damages to it from defendant's conduct.

15. By reason of the foregoing, the plaintiff does not come into equity with clean hands and is not entitled to injunctive relief.

16. If anything is stated herein as a finding of fact which is in fact a conclusion of law, it shall be deemed a conclusion of law.

CONCLUSION OF LAW

From the foregoing Findings of Fact, the Court makes the following Conclusions of Law:

1. That plaintiff is not entitled to money damages.

2. That plaintiff is not entitled to injunctive relief.

3. If anything is stated herein as a conclusion of law which is in fact a finding of fact, it shall be deemed a finding of fact.

4. That defendant is entitled to judgment and to his cost.

Let judgment be entered accordingly.

DATED: November 14, 1974

/s/_____
William H. Levit
JUDGE OF THE SUPERIOR COURT

APPENDIX H

SUPERIOR COURT OF THE STATE OF CALIFORNIA FOR THE COUNTY OF LOS ANGELES

[Filed: November 14, 1974]

No. C 43926

THE FIVE PLATTERS, INC., a California corporation,
Plaintiff,

v.

12319 CORPORATION, et al.,
Defendants.

JUDGMENT

The above-entitled cause came on regularly for trial on September 4, 1974, in Department 21, of the above-entitled Court, the Honorable William H. Levit, Judge, presiding, without a jury, a jury having been duly waived. Plaintiff appeared by Loeb & Loeb by Robin Meadow, its attorney, and defendant, Paul Robi, appeared by Bernard R. Schulhof, his attorney, and evidence both oral and documentary having been presented by both parties and the cause having been argued and submitted for decision and the Court having made and caused to be filed its written Findings of Fact and

Conclusions of Law.

IT IS ORDERED, ADJUDGED AND DECREED that plaintiff, The Five Platters, Inc., a California corporation, take nothing by its complaint from defendant Paul Robi and that defendant Paul Robi have and recover from plaintiff, his costs and disbursements amounting to the sum of $26.00.

Dated: November 14, 1974.

/s/_____
William H. Levit
JUDGE OF THE SUPERIOR COURT

APPENDIX I

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed: November 14, 1990]

No. 89-55433
D.C. No. CV 84-3326 (CBM)

Appeal from the United States District Court
for the Central District of California

MARTHA ROBI,
Plaintiff-Appellee,

v.

FIVE PLATTERS, INC., JEAN BENNETT AND BUCK RAM,
Defendants-Appellants.

Before: Harry Pregerson, Stephen Reinhardt and Cynthia Holcomb Hall, Circuit Judges.

OPINION

PREGERSON, Circuit Judge:

Paul Robi,[1] former member of the successful musical group "The Platters," brought this action against Buck Ram, the group's former manager, Ram's corporation, "Five Platters, Inc." (hereinafter, "FPI"), and FPI President Jean Bennett. Robi sought declaratory relief, cancellation of FPI's "Platters" trademark registration, damages for intentional interference with contractual relations and prospective economic advantage, and injunctive relief.

This is the second time this case has come before us on appeal. The first appeal arose after the district court granted a preliminary injunction preventing FPI from conducting vexatious litigation or interfering with Paul Robi's use of "The Platters" name. In granting the injunction, United States District Judge Consuelo Marshall gave claim preclusive *res judicata* effect to a prior action brought by FPI against Robi in a California Superior Court regarding its right to "The Platters" trademark. After trial in that prior state action (hereinafter, "the 1974 Decision"), Superior Court Judge William Levit made specific findings and entered judgment for Paul Robi.[2]

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[1] Upon Paul Robi's death, pending this appeal, the parties substituted Martha Robi, Paul Robi's wife and the assignee of his rights in the name and goodwill of The Platters, as Plaintiff by stipulation pursuant to Fed.R.Civ.P.25(a).

[2] Among Judge Levit's important findings are the following:

On the first appeal, we upheld the district court's preliminary injunction and held that the 1974 Decision generated both claim preclusion and issue preclusion against FPI which prevented FPI from further challenging Paul Robi's use of the name "The Platters." *See Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988).[3]

After we affirmed the preliminary injunction, the action continued in the district court. Prior to trial, the district court granted Robi's motion for Summary Adjudication of Issues pursuant to Fed.R.Civ.P.56(c) and 56(d) and adopted the findings set forth in the 1974 Decision. After a 20-day bench trial, the district court entered judgment for Paul Robi on all causes of action, set forth numerous

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a) That an unequal bargaining position existed between Ram and the group members, and that the new corporation was a sham used by Ram to obtain the "Platters" name.

b) That the FPI stock was issued to the group members illegally, that the members received nothing for their interest in the "Platters" name, and that Robi's transfer to FPI of his rights in the name was never effectuated.

c) That the group later sponsored by FPI did not include any of the artists who made the name "The Platters" famous, and that FPI had intentionally misled the public into believing that its group was the original Platters.

d) That FPI was guilty of laches, came into equity with unclean hands, and was not entitled to injunctive relief.

[3] That decision, which included other cases consolidated on appeal, describes the background of this case more fully.

findings of fact and conclusions of law, which included the 1974 Decision's findings, and ordered FPI to pay Robi $1,510,000 in compensatory damages and $2,000,000 in punitive damages.

The district court later amended the judgment twice: first, to cancel FPI's trademark, "The Platters" and enter a permanent injunction prohibiting FPI from challenging Paul Robi's right to use "The Platters" name; and later, to clarify that all *three* of FPI's registered "Platters" marks were to be canceled.

FPI appeals both the judgment as amended and the summary adjudication of issues. We affirm the grant of summary adjudication, the damage awards, and the cancellation of all the "Platters" trademarks.

I. SUMMARY ADJUDICATION OF ISSUES

Whether *res judicata* or collateral estoppel operates to bar claims is a mixed question of law and fact which this court reviews de novo. *Springs v. First National Bank of Cut Bank*, 835 F.2d 1293, 1295 (9th Cir. 1988). A summary judgment motion brought pursuant to Fed.R.Civ.P.56(c) is a proper way to establish claim preclusion and issue preclusion. *See Takahashi v. Board of Trustees of Livingston Union School District*, 783 F.2d 848, 849 (9th Cir. 1986), *cert. denied* 476 U.S. 1182, 106 S.Ct. 2916, 91 L.Ed.2d 545 (1986). Issue preclusion precludes relitigation of all issues actually litigated and necessarily decided in prior proceedings. *Robi*, 838 F.2d at 322.

In the prior appeal in this case, we determined that the

1974 Decision generated issue preclusion against FPI. *Robi*, 838 F.2d at 327. Our prior ruling also rejected FPI's argument, made again here, that the issue of "The Platters" trademark was not raised in the 1974 Decision. Specifically, we found that FPI entered its registration of the mark into evidence in that action and advanced various legal theories to support its claim to the group name. *Id.* at 323. Thus, the district court did not err in adopting the 1974 Decision's findings — which under the doctrine of issue preclusion are deemed conclusive in subsequent actions — in its summary adjudication of issues.

II. DAMAGES FOR INTENTIONAL INTERFERENCE WITH CONTRACTUAL RELATIONS

A. Compensatory damages

The district court's findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous. Fed.R.Civ.P.52(a); *Rozay's Transfer v. Local Freight Drivers, Local 208*, 850 F.2d 1321, 1326 (9th Cir. 1988) *cert. denied*, 1095 S.Ct. 1768 (1989). Particular deference must be paid to the district court's credibility findings. *Id.* at 1327, citing *Anderson v. City of Bessemer City*, 470 U.S. 564, 579-80, 105 S.Ct. 1504, 1514, 84 L.Ed.2d 518 (1985). The district court's computation of damages, which is a finding of fact, will not be set aside unless clearly erroneous. *Galindo v. Stoody Co.*, 793 F.2d 1502, 1516 (9th Cir. 1986).

To establish a claim of intentional interference with contractual relations under California law, Paul Robi had to show (1) that he had valid and existing contracts; (2) that FPI

had knowledge of his contracts and intended to induce their breach; (3) that the contract was in fact breached; (4) that the breach was caused by FPI's wrongful conduct; and that (5) that Robi suffered damage.[4] *See Olivet v. Frischling*, 104 Cal.App.3d 831, 837, 164 Cal.Rptr. 87, 89-90 (1980).

Ample evidence existed to support the district court's findings that FPI defendants damaged Paul Robi's business and professional reputation, including:

> 1) Over 50 letters and telegrams written by parties associated with FPI to numerous trade magazines, booking agents, promoters, and performance venues claiming that Robi had no right to perform as The Platters and threatening to sue anyone who hired or promoted Robi. The evidence included correspondence sent by FPI after the district court entered its preliminary injunction enjoining such activity.
>
> 2) Testimony of three music producers who stated that FPI representatives told them that Robi's group was phony and had no rights to the name "The Platters;" that the representatives threatened to put Robi out of

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[4] Robi must establish the same five elements to sustain a claim of intentional interference with prospective economic relations, except that an economic or business relationship with "the probability of economic benefit" must be established in lieu of a specific contract. *See Buckaloo v. Johnson*, 14 C.3d 815, 827, 122 Cal.Rptr. 745, 752 (1975).

business and threatened them with litigation; and that but for FPI's actions, they would have hired and promoted Robi in more frequent and lucrative bookings.

3) Testimony of Paul and Martha Robi regarding the income and business opportunities lost as a result of FPI's interference.

While some of the Robis' testimony may have been conflicting, we defer to the trial court's findings regarding the credibility of the various witnesses. *See Rozay's Transfer*, 850 F.2d at 1327. Although Paul Robi did not present his own business records,[5] he did present ample written evidence of FPI's harassing behavior, which the court determined was intended to and did discourage parties from hiring or promoting him.

In calculating the compensatory damage award, the district court assumed that, but for interference from FPI, Paul Robi's group would have grossed at least as much, if not more than, FPI's group. The court then took the most conservative difference between the two groups' gross earnings for the period in question and applied Paul Robi's lowest profit rate, as established by the testimony of several witnesses.

[2] It is well-established under California law that while the *fact* of damages must be clearly shown, the *amount*

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[5] Robi claimed that his business records had been lost.

need not be proved with the same degree of certainty, so long as the court makes a reasonable approximation. *See, e.g., Hutcherson v. Alexander*, 264 Cal.App.2d 126, 135, 70 Cal.Rptr. 366, 372 (1968); *Johnson v. Cayman Dev. Co.*, 108 Cal.App.3d 977, 983, 167 Cal.Rptr. 29, 32 (1980); 6 Witkin, *Summary of California Law*, § 1325 at 782 (9th ed. 1988). Under the Restatement (2d) of Torts, once an injured person proves that his business would have been profitable, he need not prove precisely "the amount of the profits he would have made or the amount of harm that the defendant has caused"' rather, he need only "present such evidence as might reasonably be expected to be available under the circumstances." Rest. 2d of torts, § 912(d) at 482.

The seminal California case regarding uncertainty as to the amount of damages in a tort action is *Hutcherson v. Alexander*, 264 Cal.App.2d 126. *Hutcherson* involved a dispute between neighboring business owners over a large sign erected by one owner which blocked the other establishment from the public's view. The trial court concluded that although it was clear that the plaintiff owners had suffered business losses, the evidence regarding the amount of the damages was insufficient, because the business had only recently been established. Rather than attempt to estimate the plaintiffs' damages, the trial court retained jurisdiction over the matter in order to fix plaintiffs' damages at a later date.

On appeal, the California Court of Appeals ruled that the trial court erred in refusing to estimate damages at the close of trial. The appellate court held that because the trial court had determined that the defendant's conduct in fact damaged the plaintiffs, and because the evidence was

speculative only in the sense that the court "could not calculate the damages with certainty," the court "should have nevertheless resorted to the best evidence available and fixed damages accordingly." *Id.* at 135.

In the present case, the district court attempted to do just that. After Paul Robi established the fact of damages through testimony by several witnesses that his business would have been profitable, the district court made a reasonable approximation of the amount of Robi's damages. The court calculated approximate damages by taking the most conservative difference between the FPI group's gross earnings and Robi's gross earnings for the period in question, and then multiplying that amount by Paul Robi's lowest established profit rate. We cannot say that this method of approximating the damage amount was clearly erroneous.

B. Punitive Damages

[3] Paul Robi presented evidence at trial which adequately supported the district court's finding of malice and ill-will toward Robi, and which justified an award of punitive damages. The evidence included (a)testimony by two music producers that former manager Buck Ram and FPI President Jean Bennett threatened to put Robi out of business; (b) a twenty-year correspondence campaign by FPI management which painted Robi as a trademark infringer and threatened parties hiring or promoting Robi with litigation; and (c) FPI defendants' knowing violation of the district court's preliminary injunction by sending the type of letters specifically forbidden by the court.

III. CANCELLATION OF FIVE PLATTERS, INC.'S

TRADEMARKS

A. Cancellation of "The Platters" mark

[4] The district court found that FPI filed a false incontestability affidavit pursuant to 15 U.S.C. § 1065,[6] submitted a false and misleading trademark application exemplar, and had attempted to mislead the public. The court determined that the fraudulent practices provided a basis for canceling FPI's trademark, "The Platters."

A party may seek cancellation of a registered trademark on the basis of fraud under 15 U.S.C. § 1064(c) by proving a false representation regarding a material fact, the registrant's knowledge or belief that the representation is false, the intent to induce reliance upon the misrepresentation and reasonable reliance thereon, and damages proximately resulting from the reliance. *San Juan Products, Inc. v. San Juan Pools of Kansas, Inc.*, 849 F.2d 468, 473 (10th Cir. 1988).

Any false statements made in an incontestability affidavit may jeopardize not only the incontestability claim, but also the underlying registration. *See Crown Wallcovering Corp. v. Wallpapers Manufacturers Limited*, 188 U.S.P.Q. 141, 143-44 (1975); *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095 (C.C.P.A. 1970). In particular,

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[6] Under 15 U.S.C. § 1065, an applicant may establish an incontestable right to use a mark by averring, among other things, that "there has been no final decision adverse to registrant's claim of ownership" or right to register the mark.

filing a fraudulent incontestability affidavit provides a basis for canceling the registration itself. *Crown Wallcovering*, 188 U.S.P.Q. at 144.

Although the burden of proving that a party fraudulently procured a trademark registration is heavy, *Beer Nuts, Inc. v. Clover Cub Foods Co.*, 711 F.2d 934, 942 (10th Cir. 1983), this court reviews a district court's factual conclusions in trademark registration cases under the "clearly erroneous" standard. *See Wells Fargo & Co. v. Stagecoach Properties, Inc.*, 685 F.2d 302, 306 (9th Cir. 1982).

FPI President Jean Bennett submitted an incontestability affidavit to the United States Patent and Trademark Office stating that "there has been no final decision adverse to Registrant's claim of ownership of said mark nor to its right to register the same or maintain it on the register." Given the adverse 1974 decision, which denied FPI's claim that it was the only entity entitled to use the name "The Platters" and contained numerous findings adverse to FPI's ownership interest, the affidavit was, as the district court properly concluded, clearly false. *See, e.g. Rosco and Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 1266 (Fed. Cir. 1983) (senior user makes false oath in trademark registration application where he fails to acknowledge conflicting rights of junior user which are clearly established by the court decree); *Skippy, Inc. v. CPC Int'l, Inc.*, 674 F.2d 209, 216 (1982), *cert. denied*, 459 U.S. 969, 103 S.Ct. 298, 74 L.Ed.2d 280 (1982) (incontestability affidavit stating there had been no final decision adverse to affiant's registration rights was false where a final decision against registration had been made 21 years earlier). Moreover, given Bennett's admitted knowledge of that decision at the time she signed the

affidavit, the district court did not err in concluding that the affidavit was not only false, but also fraudulent.

The district court also found that FPI filed a misleading exemplar with its original application; that FPI made no attempt to change the way its group presented itself despite the 1974 Decision finding that it had intentionally misled the public; and that FPI group members purposely misrepresented themselves as the original Platters in their performances. Thus, there is ample support for the district court's cancellation of FPI's "Platters" trademark on the basis of fraud.

B. The Corrected Judgment Under Fed R. Civ. P. 60(a)

In the amended judgment from which FPI appeals, the district court ordered, among other things, that FPI's trademark "The Platters" be canceled. However, the court failed to identify the particular trademark to be canceled or to include any trademark registration numbers or dates of issuance. As a result, the Trademark Office was unable to cancel the trademark.

The Trademark Office indicated that three registrations had been issued to FPI: one for "The Platters" trademark issued in 1986; one for "The Platters" service mark issued in 1973; and one for "The Buck Ram Platters" service mark issued in 1987. The office sought clarification as to which trademarks should be canceled.

To clarify the judgment, appellee Martha Robi requested and was granted by this court leave to file a motion before the district court to correct clerical error pursuant to

Fed.R.Civ.P.60(a).[7] In her motion, Martha Robi asked the district court to correct the judgment by specifying that all three of FPI's trade or service marks, identified by number, should be canceled. The court granted the motion and amended the judgment, ordering cancellation of all three FPI marks. FPI contends that the district court erred in granting the 60(a) motion, and that FPI has the right to use the "Buck Ram Platters" mark because it contains Buck Ram's own name. We reject both of FPI's contentions.

We review the district court's granting of a Rule 60(a) motion for abuse of discretion. *Blanton v. Anzalone*, 813 F.2d 1574, 1517 (9th Cir. 1987). A district court judge may properly invoke Rule 60(a) to make a judgment reflect the actual intentions and necessary implications of the court's decision. *Id., citing Jones & Guerrero Co. v. Sealift Pacific*, 650 F.2d 1072, 1074 (9th Cir. 1981). In reviewing the corrected judgment, we must afford the court wide latitude and focus on what the court originally intended to do. *Id.*

[5] Although the district court did not explain in this case why it amended the judgment to include all three marks, *see In re Jee*, 799 F.2d 532, 535 (9th Cir. 1986), *cert. denied* 481 U.S. 1015, 107 S.Ct. 1892 (1987), there is no evidence that the court ever intended to exclude any of FPI's marks

---

[7] Rule 60(a) provides in part:

> Clerical mistakes in judgments, orders or other parts of the record and errors therein arising from oversight or omission may be corrected by the court at any time on its own initiative or on the motion of any party and after such notice, if any, as the court orders.

from the original judgment. In fact, while exhibits bearing "The Buck Ram Platters" mark were introduced at trial, there is no indication that the district court distinguished that mark from the other "Platters" marks in any way.

We therefore conclude that the district court intended in its original judgment to cancel any and all trade and service marks held by FPI which included "The Platters" name, and that the court amended the judgment only to the extent necessary to clarify that intention.

[6] We also find FPI's argument that canceling "The Buck Ram Platters" mark was improper due to the special nature of trademarks that contain an individual's name unpersuasive, for two reasons. First, courts do not hesitate to forbid an individual from using his own name in connection with a business when he has deliberately attempted to confuse the public. *See H.A. Friend & Co., Inc.*, 416 F.2d 526, 531 (9th Cir. 1969), *cert. denied* 397 U.S. 914, 90 S.Ct. 916, 25 L.Ed.2d 94 (1969). Here, as in *Friend*, where evidence suggests the trademark user "has deliberately, vigorously, and successfully confused purchasers," courts may properly issue injunctions to prohibit or restrict the use of an individual's name. *Id.*

Second, cases dealing with a person's right to use his name in business focus on the use of the *individual's own name*. *See, e.g., Friend*, 416 F.2d at 526; *Sardi's Restaurant Corp. v. Sardie*, 735 F.2d 719 (9th Cir. 1985); *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 569 F.2d 731 (2d Cir. 1978). Here, the district court canceled "The Buck Ram Platters" mark not because Buck Ram's own name was confusing or misleading, but because it included the term

"The Platters." Presumably, FPI would be free to apply for a new mark which featured Buck Ram's name if it chose to do so.

Thus, it was not an abuse of discretion for the district court to clarify its original intention to cancel all marks held by FPI featuring the term "The Platters" by amending the judgment pursuant to Rule 60(a).

AFFIRMED.

APPENDIX J

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

[Filed: May 30, 1990]

No. CV 84-3326 (CBM)

Appeal from the United States District Court
for the Central District of California

MARTHA ROBI,
Plaintiff,

v.

FIVE PLATTERS, INC., JEAN BENNETT AND BUCK RAM,
Defendants.

SECOND AMENDED JUDGMENT

The above-entitled case came on regularly for trial before the Honorable Consuelo B. Marshall, United States District Judge, sitting without a jury. Allen Hyman, of the law office of Nagler & Schneider, Los Angeles, California, appeared on behalf of plaintiff; and Cheri S. O'Laverty, Los Angeles, California, appeared as counsel for defendants. The Court, having heard the testimony, having examined the

evidence presented and the case having been submitted for decision, has made and caused to be filed its written Findings of Fact and Conclusions of Law, and hereby issues the following order:

IT IS ORDERED, ADJUDGED AND DECREED that judgment be entered on all causes of action for the plaintiff against the defendants in the following amounts:

Compensatory Damages	$1,510,000
Punitive Damages	$2,000,000

IT IS ALSO ORDERED, ADJUDGED AND DECREED THAT defendant THE FIVE PLATTERS, INC.'s trademarks: (1) "THE BUCK RAM PLATTERS", Registration No. 1,469, 448, issued December 15, 1987; (2) "THE PLATTERS", Registration No. 1,401,286, issued July 15, 1986; and (3) "THE PLATTERS", Registration No. 959,115, issued May 15, 1973, be canceled and the Commissioner of the United States Patent and Trademark Office is hereby ordered to cancel the trademarks presently in the name of the defendant corporation THE FIVE PLATTERS, INC.

IT IS ALSO ORDERED, ADJUDGED AND DECREED that defendants THE FIVE PLATTERS, INC., JEAN BENNETT, and SAMUEL RAM a.k.a. BUCK RAM, and each of them and their attorneys, agents, and their employees and agents; and all those acting on their behalf are hereby permanently enjoined from initiating any litigation against plaintiff pertaining to plaintiff's rights to utilize the

name of "The Platters", and are permanently enjoined from communicating to any party that plaintiff ROBI has no rights to utilize the trade name "The Platters", and are permanently enjoined from directly or indirectly indicating to any person, party or buyer that plaintiff does not have the right to utilize the trade name "The Platters".

IT IS ALSO ORDERED, ADJUDGED AND DECREED that Plaintiff's bond in the amount of $5000.00 filed as security with regard to the Preliminary Injunction is hereby ordered and released.

DATED: May 29, 1990

/s/_____
CONSUELO B. MARSHALL
JUDGE UNITED STATES
DISTRICT COURT

STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

I am a citizen of the United States and a resident of the county aforesaid; I am over the age of eighteen and not a party to the within action; my business address is 9460 Wilshire Boulevard, Suite 410, Beverly Hills, California 90212.

On May 25, 1990 I served the within (PROPOSED) SECOND AMENDED JUDGMENT on the interested parties in said action, by placing a true copy thereof enclosed in sealed envelopes addressed as follows:

Cheri S. O'Laverty
LAW OFFICES OF CHERI S. O'LAVERTY
12121 Wilshire Boulevard
Suite 200
Los Angeles, CA 90025

Richard A. Rosen, Esq.
ROSEN & BROIDY
8439 Sunset Blvd., Suite 306
Los Angeles, CA 90069

I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with U.S. postal service on that same day with postage thereon fully prepaid at Beverly Hills, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed

invalid if postal cancellator date or postage meter date is more than one day after date of deposit for mailing in affidavit.

Executed on May 25, 1990 at Beverly Hills, California.

I declare that I am employed in the office of a member of the bar of this Court at whose direction this service was made.

/s/_____
Allen Hyman, Esq.

APPENDIX K

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

[Filed: December 10,1987]

No. 84-8324-CIV-ARONOVITZ

THE FIVE PLATTERS, INC.,
Plaintiff,

v.

HERBERT REED, BILLIE COX, ROBYNE HARRIS, ROBERT MOORE, STEFFAN FISHER, RUDY GUARINO, RHETT BUTLER'S, a Florida Corporation, JOSEPH R. O'BRIAN, JIM O'BRIAN, and DONALD NEWTON,
Defendants.

STIPULATION OF SETTLEMENT

1. The instant action and all other actions between the parties in this and any other court shall be dismissed with prejudice.

2. Herbert Reed shall, for as long as he lives and so long as he complies with the terms of this Settlement, without interference from the Plaintiff, have the right to perform or entertain in any place and with any medium other than commercial recordings (phonographic recordings, audio or video recordings of any kind, commercials, etc.) as Herb Reed and the Platters and in any form or in any medium as Herb or Herbert Reed of the Original Platters or as Herb or Herbert Reed. Herbert Reed agrees that the nature and quality of all services rendered in connection with the name Herb Reed and the Platters shall conform with the reasonable standards used and set by Plaintiff.

3. Herbert Reed shall not, other than as set forth above, use the name "The Platters." Herbert Reed agrees that he is responsible for any claims or obligations of any kind that arise out of his use of the name "Herb Reed and the Platters."

4. Herbert Reed will sell, set over and assign any and all rights he may have in the common stock of The Five Platters, Inc. to the Five Platters, Inc. by signing the transfer agreement attached hereto as Exhibit "A".

5. Herbert Reed will, at the cost of The Five Platters, Inc., make himself available for testifying or deposition upon reasonable notice at trial or otherwise upon the request of The Five Platters, Inc.

6. Herbert Reed and The Five Platters, Inc. agree that neither shall, without reasonable prior written notice with an opportunity to cure any alleged violation, file an infringement suit against any venue or medium at which the

other party is or will be performing. Such notice shall also be sent, when to Herbert Reed, to Gerald Lesher, Esq., Cooney, Ward & Lesher, Suite 1000, 1555 Palm Beach Lakes Boulevard, West Palm Beach, Florida 33401, or to such other person as Herbert Reed designates hereafter in writing and when to The Five Platters, Inc., to Eric D. Isicof, Esq., Mershon, Sawyer, Johnston, Dunwody & Cole, Suite 4500, 200 South Biscayne Boulevard, Miami, Florida 33131-2387, or to such other person as The Five Platters, Inc. designates hereafter.

7. In the event that a court of competent jurisdiction enters a final order with all appeals being exhausted that provides that The Five Platters, Inc. has no right in the name "The Platters," then nothing contained herein shall be construed to limit Herbert Reed's rights in the name "The Platters" and this agreement shall not inure to any party other than The Five Platters, Inc., and its successors and assigns or Herbert Reed.

8. This Stipulation of Settlement shall be enforceable and shall be interpreted under the laws of the State of Florida.

9. The United States District Court for the Southern District of Florida, or its successor shall retain jurisdiction to enforce this stipulation.

/s/_____
Sidney M. Aronovitz
UNITED STATES DISTRICT COURT

Acknowledged and Accepted by:

The Five Platters, Inc.

By:/s/_____ Date: Dec. 2, 1987
Jean Bennett
President

/s/_____ Date: Nov. 25, 1987
Herbert Reed

Cooney, Ward & Lesher
Attorney for Defendant
Herbert Reed
1555 Palm Beach Lakes Blvd. #1000
West Palm Beach, Florida 33401
(305) 689-8111

By:/s/_____ Date: Nov. 30, 1987
Gerald S. Lesher

Mershon, Sawyer, Johnston,
Dunwody & Cole
Attorneys for Plaintiff
The Five Platters, Inc.
4500 Southeast Financial Center
200 South Biscayne Boulevard
Miami, Florida 33131
(305) 358-5100

By:/s/_____ Date: 12-10-87
Eric Isicoff

APPENDIX L

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

[Filed: May 5,1987]

No. 84-8324-Civ-ARONOVITZ

THE FIVE PLATTERS, INC.,
Plaintiff,

v.

HERBERT REED, et al.,
Defendants.

ORDER ON DEFENDANT REED'S MOTION FOR SUMMARY JUDGMENT

THIS CAUSE having come before the Court on Defendant Herbert Reed's Motion for Summary Judgment, and the Court having considered said Motion and responses thereto, and being otherwise fully advised on the premises, it is

ORDERED AND ADJUDGED that Defendant Reed's Motion for Summary Judgment be and the same is hereby DENIED. Defendant Reed seeks res judicata effect of a state

court decision in The Five Platters, Inc. v. 12319 Corporation, et al.; Case No. C43926 and a federal court decision in Robi v. The Five Platters, Inc., Case No. 84-3326, Central District of California, as Judge Consuelo B. Marshall ordered in the case of Williams v. The Five Platters, Inc., Case No. 86-4294, Central District of California. Despite Judge Marshall's reasoned opinion, the Court deems that the Defendant's allegations that Plaintiff's right to use the mark "Platters" was procured by fraud must be adjudicated on an individual basis and may not properly be the subject of collateral estoppel in suits by other persons. In Re Cenco, Inc. Securities Litigation, 529 F.Supp.411 (N.D.Ill.1982). For example, one party may rely on misrepresentations to his detriment while another party may not. However, this denial is without prejudice to the Defendant renewing his Motion for Summary Judgment should Judge Marshall's decision be upheld by the Ninth Circuit prior to trial. The Court could at that time be inclined to revisit the issue.

DONE AND ORDERED in Chambers at Miami, Florida, this 5 day of May, 1987.

/s/_____
Sidney M. Aronovitz
UNITED STATES DISTRICT COURT

Copy furnished:

Mershon, Sawyer, Johnson, Dunwody & Cole
Gerald S. Lesher, Esquire

APPENDIX M

RECORDING AGREEMENT
MERCURY RECORD CORPORATION

DATE OF EXECUTION: March 21, 1955

NAME OF ARTIST: HERBERT REED, DAVID LYNCH
TONY WILLIAMS, PAUL ROBI,
ZOLA TAYLOR

We hereby employ you for the purpose of making phonograph records.

You do hereby agree to record solely and exclusively for MERCURY RECORD CORPORATION, in accordance with the provisions of this agreement. It is agreed that you will record a minimum of eight phonograph record sides during each year in which this agreement is in effect, with additional sides to be recorded at MERCURY's election. In the event that more than eight sides are recorded, during any year in which this agreement is in effect, MERCURY shall have the option of applying the excess of eight sides recorded in any one (1) year towards the requirements for subsequent year or years.

Royalties due under this agreement will be computed upon the basis of three (3%) per cent of ninety (90%) per cent of the retail selling price, exclusive of Federal Excise Tax and less the retail cost of album covers, of all records sold in the United States and Canada, embodying performances hereunder

on both sides thereof, and one-half (½) the amount of such royalty for ninety (90%) per cent of the retail selling price, exclusive of Federal Excise Tax, and less the retail cost of album covers, of all records sold in the United States and Canada embodying performances hereunder only one (1) side thereof, and, in the event long-play records are sold in the United States and Canada embodying performances hereunder, which performances are less than the musical content on one side thereof, the royalty paid hereunder shall be in the same proportion to ninety (90%) per cent of the retail selling price, exclusive of Federal Excise Tax, and less the retail cost of album covers, of all such records sold in the United States and Canada, as the performance hereunder bears to the entire musical content of said records. For all records sold hereunder outside of the United States and Canada, the royalties therefor shall be one-half (½) of the royalty rates above set forth. For all records sold hereunder outside of the United States, either by MERCURY or any of its licensees, MERCURY may, from time to time, at its sole election, base their percentages either upon the retail list prices in the country of sale, the country of manufacture, or the retail list prices of England. Royalties aforesaid for all records sold outside of the United States are to be computed in the national currency of the country where the retail prices above listed apply and are to be paid only when such royalties are received by MERCURY in the United States, and in the dollar equivalent at the rate of exchange at the time MERCURY receives payment. The royalty due on account of the sale of any record produced hereunder shall be at the rate of the royalty in effect hereunder at the time of the recording session for said record. MERCURY will make a non-returnable advance to the Artist of $75.00 for each side recorded hereunder, payable within fourteen days after each recording

session.

3. It is agreed that the services of the ARTIST are unique and extraordinary. Therefore, the ARTIST agrees that for five (5) years after the expiration date of this contract, or any extension or renewal thereof, the ARTIST will not perform any of the material recorded hereunder for any person, firm or corporation other than MERCURY RECORD CORPORATION for the purpose of making phonograph records.

4. All recordings, records and reproductions made therefrom, together with the performances embodied therein, shall be and remain entirely the property of MERCURY RECORD CORPORATION, free of any claims by the ARTIST or any person deriving any rights or interest from the ARTIST. In addition, MERCURY RECORD CORPORATION shall have the right to make records or other productions of the performances embodied in such recordings by any method now or hereafter know, and to sell and deal in the same under any trade-marks or trade-names, or labels designated by MERCURY RECORD CORPORATION or, MERCURY RECORD CORPORATION may, at its own election, refrain therefrom.

5. MERCURY RECORD CORPORATION is granted the right to use and to allow others to use the name and likenesses of the ARTIST and biographical matter concerning the ARTIST for advertising, trade purposes, and otherwise, without restriction in connection with phonograph records made pursuant to this contract. MERCURY RECORD CORPORATION will not use or authorize any direct endorsement of any record or performance without

prior written consent of the ARTIST.

6. MERCURY RECORD CORPORATION agrees that it will advance the necessary cost of orchestral accompaniment and arrangements; these items to be treated as an advance against such royalties as may become due in accordance with this agreement. An accounting is to be made of royalties due, and the net amounts will be paid within forty-five (45) days after June 30th and December 31st of each year during which records made hereunder are sold.

7. The Artist hereby warrants that they do not have any oral or written obligations, contracts or agreements of whatever nature entered into prior to the signing of this agreement which are now in force and binding and which would in any manner interfere with the Artist from carrying out this agreement to its full intent and purpose.

8. MERCURY shall have the right to call upon the Artist to repeat to a reasonable extent any work without further payment until a satisfactory master recording has in the opinion of the company been made.

9. MERCURY shall have the right to give, lend, lease or sell to any person, firm or corporation, matrices, stampers or master recordings from which records reproducing all or any of the Artists' services hereunder may be manufactured or sold, and shall have the right to grant permission to any such person, firm or corporation to use such matrices, stampers or master recordings to manufacture and sell records therefrom.

10. In the event of the Artist by illness or absence

or any other cause, not being able to fulfill the provisions herein to the reasonable satisfaction of MERCURY, MERCURY shall have the option to terminate this agreement forthwith.

11. If the fulfilling of this agreement shall become impossible by reason of "force Majcuro" or any other cause outside the control of the parties hereto, then either party shall be entitled (by giving notice in writing to the other party hereto and without incurring any liability for damages or compensation) to suspend the operation of this agreement until such time as such fulfillment shall again become possible provided always that if the operation of the agreement shall be suspended as aforesaid, then MERCURY shall during the period of such suspension continue to pay to the artist the royalties due to him or her under this agreement so long as any such royalties shall be payable by reason of the manufacture and sale of records under the provisions of this agreement. In the event that this agreement has become suspended, as provided for in this paragraph, the term of this agreement shall be extended, for a period equivalent to the period of said suspension, providing that fulfillment of said agreement again becomes possible. Artist does further agree that in the event that this agreement shall become suspended, in accordance with the provisions of this paragraph, that said Artist will not, during the period that said contract may be so suspended, record for any other person, firm or corporation, for the purpose of making phonograph records. In the event that any monthly or other advances are required to be made by MERCURY to the Artist, in accordance with the provisions of this agreement, MERCURY shall be excused from making payment of said advances during any period that this agreement may become suspended in accordance with the

provisions of this agreement.

12. The services to be performed by the Artist herein means the performance by the Artist of literary or musical works for the purpose of making master recordings from which may be manufactured contrivance (herein called "records") whereby the performance of the Artist is produced. Performance hereunder includes singing, speaking, or playing an instrument, alone or with others, and also includes conducting. "Artist" means the party or parties hereby contracting with MERCURY, whether male or female singular or plural.

13. The period of this contract shall be one (1) year commencing with the date hereof.

14. MERCURY is hereby granted three (3) several options of extending this agreement for three (3) separate terms of one (1) year each. Each and all of said options may be exercised by MERCURY by means of written notice sent to the Artist, at the address hereinafter set forth, by Registered Mail, at least thirty (30) days prior to any expiration date. In the event that said options are exercised, this contract shall be deemed extended for the additional period of said options with all terms and conditions set forth, except that the royalty rate for the first option year shall be four (4%) percent of ninety (90) percent, and the royalty rate for the second and third option years shall be five (5%) percent of ninety (90%).

It is further agreed that 15% of the act royalties due to the Artists hereunder, over and above advances and other charges provided to be charged against said royalties, shall be

paid by MERCURY to Buck Ram, 2546 Westwood Blvd., Los Angeles 64, California.

15. The individuals signing this contract comprise the vocal group known as "The Platters", and do hereby warrant to Mercury that they are the true and lawful owners of the right to the use of the name "The Platters" in connection with the performances hereunder, and that no other persons have any right or claim in or to said name, and do hereby grant to MERCURY full and complete right to the use of the name "The Platters" in connection with phonograph records to be produced and sold in accordance herewith. The artists herein do further warrant that they are the owners of the copyright issued in connection with the name "THE PLATTERS".

16. In the event that any recordings made hereunder are participated in by any other artists who are then under the exclusive recording agreements with MERCURY the royalties due hereunder, for said recordings shall be the royalties above provided for divided by the number of artists participating therein, including artists herein.

17. For all purposes hereunder, the addresses of the parties hereto shall be as follows:

MERCURY RECORD CORPORATION
35 E. Wacker Drive
Chicago, Illinois

THE PLATTERS
c/o Buck Ram
2546 Westwood Blvd.
Los Angeles 64, California

IN WITNESS WHEREOF the parties hereto have affixed their hands and seals the day and year first above written.

MERCURY RECORD CORPORATION

BY /s/_____
FREIN

/s/_____ (SEAL)
TONY WILLIAMS

/s/_____ (SEAL)
DAVID LYNCH

/s/_____ (SEAL)
ZOLA TAYLOR

/s/_____ (SEAL)
PAUL ROBI,

/s/_____ (SEAL)
HERBERT REED

APPENDIX N

(PHOTOGRAPH)

PRESENTS

THE PLATTERS

~~+00894~~

EXHIBIT 8

Associated Booking Corp.

APPENDIX O

(PHOTOGRAPH)

BEST AVAILABLE COPY

APPENDIX P

SUPERIOR COURT OF THE STATE OF CALIFORNIA
FOR THE COUNTY OF LOS ANGELES

No. 918 695

THE FIVE PLATTERS, INC.,
a California Corporation,
Plaintiff,

v.

ZOLA MAE TAYLOR, PAUL ROBI,
JOHNNY BARNES, WARREN CROSBY,
and GERALD GARRETT,
Defendants.

DECLARATION OF HERBERT REED

I, HERBERT REED, hereby declare and state:

I am over eighteen (18) years of age and I am president of Plaintiff Corporation, The Five Platters, Inc.

I am presently and have been a member of the singing group known as The Platters since its creation in 1953.

The Platters were formed as an unknown group of singers in 1953. I was the individual responsible for the creation of the group and it was I who gave it the name The Platters. The group at that time was composed of the following individuals: Cornelius Gunter, Alex Hodge, Joe Jefferson and Herbert Reed. Between the time of our organization and 1956, we had grown from an unknown group to a group of major importance in the music industry. In order to properly coordinate our efforts and to provide ourselves with a means of internal discipline, the corporation, The Five Platters, Inc. (hereinafter referred to as the "corporation"), was formed. Like all groups, we anticipated that ours would last throughout our respective careers, as then constituted.

Between 1956 and the early 1960's, the Platters became one of the most prominent singing groups in the world. Our records and albums were played throughout the world and several of our recordings and albums achieved the magical status of "Gold Records". We appeared in many of the major concert halls, theaters and clubs throughout the world and our popularity was as great in Europe and South America as in the United States.

Although we were five individual members of the singing group, we were known as a singing group and not five individual singers. The continuity of the Platters and the continued success which it has enjoyed as a group is largely due to that fact. Although at various times certain individuals, noteably Tony Williams, have been identified as "lead singers", it is The Platters as a group which has continued fro some thirteen years to be one of the leading performing acts in the world, notwithstanding various changes

in its membership, including the replacement of Tony Williams.

At the time our corporation was formed, we each signed employment agreements by which we became employees of the corporation; as part of those agreements and in order to provide for the continuity of the Platters as a group, we acknowledged that the corporation was the owner of the name "The Platters".

For many years, we recorded as a group with Mercury Records with whom we had great success and with which we recorded several million selling albums and some of our more famous single records. During the period we were with Mercury, the membership of the group changed twice. The first change occurred when Tony Williams was replaced by Sonny Turner; the second when Zola Taylor was replaced by Barbara Randolph.

To indicate the continuity of The Platters, notwithstanding various changes in its members, I have attached hereto as Exhibit "A" a reprint of an article dated November 5, 1965, appearing in a college newspaper, "The East Carolinian". The article is entitled "The Platters Celebrate 10th Anniversary". The article contains three pictures of the group. One, prominently located in the middle of the page, contains the Platters which then included Paul Robi, one of the defendants herein, Barbara Randolph, David Lynch, Sony Turner and myself. The other two, unlike the aforementioned picture, contains the picture of Paul Robi's replacement, Nate Nelson. In none of the three pictures in the article does Zola Taylor appear.

The article clearly shows that the public's identification of the Platters has been of a group and not of its individual members. It further shows that the public recognizes the continuity of The Platters and is aware of its ten year history.

As Exhibit "B" to this declaration, I have annexed a reprint of an article from Record World dated October 16, 196, entitled "Gold Disks for Platters". Record World is one of the more prominent and widely distributed publications in the music industry. The picture in Record World was in connection with the Platters' album "More Encores of Golden Hits" and identifies The Platters as Sonny Turner, Betty Jackson, Nate Nelson, David Lynch and myself. At the time the picture was taken Barbara Randolph, who had replaced Zola Taylor as the female voice of the Platters, had herself been replaced by Betty Jackson. Notwithstanding the various changes in the personnel of the group which the enclosed picture indicates, the identity of the group as The Platters by a knowledgeable trade publication is unequivocal.

The Platters today are enjoying a re-emergence as one of the more prominent recording groups in the industry. In 1965 when our association with Mercury Records terminated, we signed a new recording agreement, which was signed by the Five Platters, Inc. with Musicor Records, a division of Talmadge Productions, Inc. Since recording for Musicor, we have released several records, three of which particularly have had great success and one of which has just been released. As an indication of our recent success, I have attached hereto as Exhibit "C" a copy of Cashbox Magazine's Rhythm and Blues ("R&B") Chart dated July 16, 1966, on which "I Love You 1,000 Times", one of our recordings for Musicor, was shown

as Number 1 on the Cashbox Charts, which together with the Bill Board and Record World Charts comprise a national rating of phonograph records, their commercial success and their public reception.

I have attached the three Exhibits to this Declaration only to point out that The Platters, as a group, have a reputation as a continuing single entity notwithstanding changes in membership. The Platters today are much in demand throughout the country and the world as a performing group by virtue of their reputation as performing artists and recording artists. We are presently on tour throughout the United States, doing concerts at various colleges and auditoriums. We have appeared and our future itinerary is such that we will be appearing in many of the more prominent concert halls, auditoriums and supper clubs throughout the country in the near future. The existence of a second group falsely calling itself The Platters is extremely damaging to both our ability to obtain future bookings at our customary salary and to our professional reputation.

By virtue of the foregoing, I submit this Declaration to show the continuity of The Platters for well over ten years, the continued success and public recognition of the singing group owned by Plaintiff Corporation as "The Platters", notwithstanding changes in its membership and further to show that the continuation of defendant group's holding itself out as The Platters will cause great public confusion and resulting irreparable injury to Plaintiff.

I reside in the County of Los Angeles, State of California.

I declare under penalty of perjury that the foregoing is true and correct.

Executed at Fayetteville, N.C., this 27 day of October, 1967.

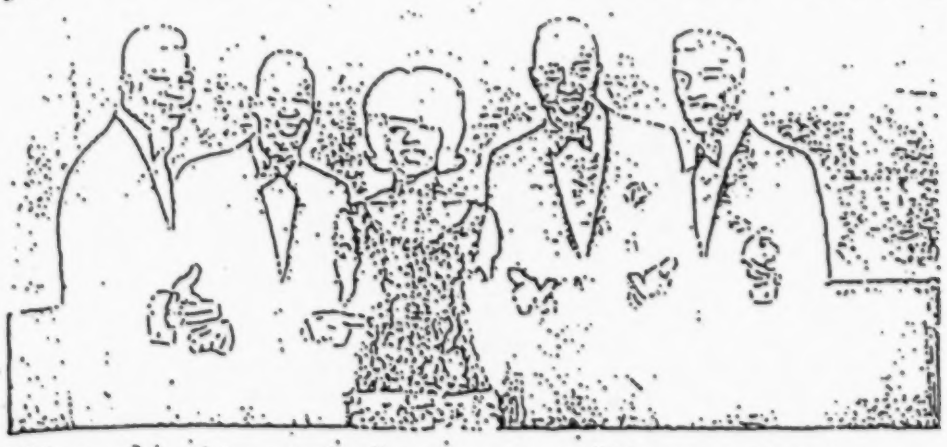
/s/_____
HERBERT REED

Declaration of Herbert Reed - 10/31/67

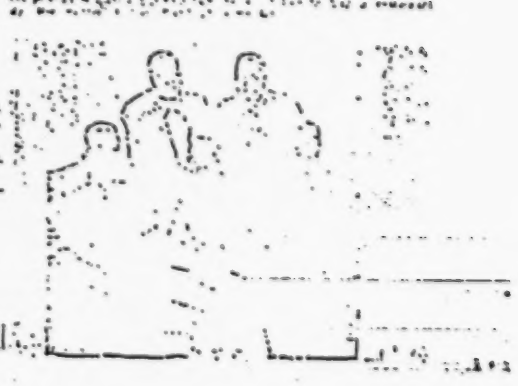
EXHIBIT A

Article reprint

The Platters Give Double Treat



Platters Celebrate Tenth Anniversary



BEST AVAILABLE COPY

Declaration of Herbert Reed - 10/31/67

EXHIBIT B

Record World article reprint

Victor Opens
Art Offices

Honored Into Fame Jubilee

HOLLYWOOD—Fats Domino has been a good bet on authentic records of composers with Hollywood Records. Fred Foster, president of the diversity to mount the entertainment, stalled for an extension hookup via both single and a long product ground out only for the U.S.A. but for the "spinning through market" as well. Foster says so we state, "We see in Fats Domino, a very exciting personality as we feel she has not yet been properly presented on records and with our special recording plans combined with merchandising has domestically and internationally, we are very confident of her impact as solos." The pact calls for her to be recorded in Italian, French, German, Portuguese, Greek, and Japanese, so as to "penetrate more fully the markets where these languages predominate." The last is versatile in the global language aspects of recording as was endorsed with her featured performance in "The Fat Fanatics" duet where she was spotlighted singing "Mexico Blossom," the Italian version of the Johnny Mercer/Henry Mancini tune, "It Had Better Be Tonight."

Fats Domino is also under contract to Colpix Records and recently filmed two more for the Showtime Rock Movement plans to be in U.S.A. and foreign promotion with Colpix Records so as to eventually make the same songs available on records.

TOP 50 IN R&B LOCATIONS

Cash Box

1	I LOVE YOU 1000 TIMES	1	26	TEARS AND SMILES AND PLANES	31
2	LET'S GO GET STONED	9	27	ACTING LIKE LOVERS	34
3	AIN'T TOO PROUD TO BEG	1	28	SHADOW OF YOUR SMILE	37
4	GOOD TIME CHARLIE	3	29	I NEED LOVE	31
5	NANCY FANCY	11	30	WADE IN THE WATER	34
6	MIDNIGHT, MIDNIGHT	8	31	I'M A PRACTICAL GUY	43
7	TAKE THAT HEART OF MINE	9	32	GO GO TRAIN	39
8	LET ME BE GOOD TO YOU	11	33	I COULD'VE ALWAYS LOVED YOU	41
9	HOLD ON I'M COMING	4	34	UNITED	41
10	TIJUANA'S PEATES	10	35	BLOWIN' IN THE WIND	—
11	MISTY	17	36	DESTINATION	33
12	WHEN A MAN LOVES A WOMAN	6	37		44
13		6	38		35
14		12	39		—
15		11	40		41
16		10	41		—
17		11	42		—
18		11	43		44
19		1	44		—
20		11	45		—
21		11	46		—
22		11	47		49
23		11	48		39
24		11	49		—
25		11	50		—

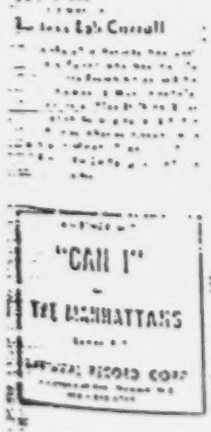
CORRECTIONS & ADDITIONS TO DIRECTORY

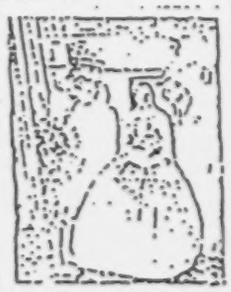
PUBLICITY

PUBLISHERS—BMI

PUBLISHERS—ASCAP

RECORD MANUFACTURERS





BEST AVAILABLE COPY

APPENDIX Q

AGREEMENT

This Agreement is entered into as of April 1, 1975, by and between BUCK RAM ("Ram"), JEAN BENNETT ("Bennett"), THE FIVE PLATTERS, INC. ("FPI"), a California corporation, PERSONALITY PRODUCTIONS, INC. ("PP"), a Nevada corporation, and HERBERT REED ("Reed"), and is made with reference to the following facts:

A. In 1953, a singing group was formed known as The Platters, of which group Reed was a member. Between 1953 and the early 1960's, such group achieved international stardom and recorded numerous million-seller records. Beginning in the mid-1960's, a large number of musical groups having no connection whatever with the original Platters have attempted by performing under the name "The Platters" and singing the songs and mimicking the style made famous by the original group of which Reed was a member. Such imitators continue to exist and continue improperly to utilize the name "The Platters." It is the intention of the parties hereto jointly to take all such steps as may be necessary to bring such activities to an end.

B. FPI was formed in 1956. At the time of its formation it was contemplated that FPI would be jointly owned by the members of the original Platters, and its stock was attempted to be issued to such members. In or about 1964, it

was discovered that such stock issue was defective, in that the permit for the issuance of such stock had not been complied with. Nevertheless, all of the parties receiving such stock, and in particular the parties hereto, have at all times treated it as validly issued and validly transferable, and such stock has at times been transferred among various of the original members of the Platters and some of the parties hereto. Pursuant to such transfers, the current record owners of FPI are Reed, PP, and Ram, who hold the following percentage interests in FPI:

Reed	20%
PP	20%
Ram	60%

It is the desire of the parties hereto to take such steps as may be necessary to cure the invalid issuance of the stock of FPI and/or to cause stock to be validly issued, so as to remove any doubt as to the valid existence of any ownership interests in FPI. Notwithstanding the foregoing, Reed contends that, by reason of an oral agreement made at the time of FPI's incorporation, he has an equitable claim against or interest in the 80% of the shares of FPI that do not stand in his name (which contention is denied by the other parties hereto), and nothing in this Agreement shall be deemed a waiver by Reed of such contention.

NOW, THEREFORE, in consideration of the promises herein contained and for other good and valuable consideration, the parties hereto agree as follows:

1. Matters Regarding FPI:

(a) The parties hereto acknowledge and agree that FPI was and is a validly formed and existing corporation, which is owned by certain of the parties hereto in the percentages set forth in paragraph B hereinabove. For the purpose of curing any possible defect in the corporate existence of FPI or in such parties' respective ownership interests, the parties agree that they shall forthwith undertake to do any and all acts and to execute any and all documents necessary to cause there to be a valid issuance of stock in FPI in the percentage interests set forth in paragraph B hereinabove, whether through application for a curative permit, by the way of the issuance of new shares, or otherwise.

(b) FPI shall at the earliest practicable date, render to Reed a full and complete accounting of all of its activities for each fiscal year ending in 1969 through 1974, inclusive. The accounting for the years 1969 through 1973 shall be rendered within 30 days, and the accounting for the 1974 year shall be rendered no later than October 31, 1975. Such accounting shall be prepared by, or under the direct supervision of, Elmer, Fox & Co. In addition, FPI shall make available to Reed or his representative, at FPI's office in Las Vegas, all of the books and records of FPI from which such an accounting would be prepared.

(c) At a time and place to be agreed upon among the parties hereto, and in any event no later than June 1, 1975, a joint meeting of all shareholders, directors and officers of FPI shall be held at the principal office of FPI at 1450 Comstock Drive, Las Vegas, Nevada. Such meeting shall be in lieu of the annual shareholders' meeting scheduled, pursuant to the by-laws of FPI, for March 1, 1975, and shall

be duly noticed in accordance with the by-laws of FPI. After such joint meeting, regular shareholders' and directors' meetings shall be held in accordance with the by-laws of FPI, and notice of such meetings shall be given in accordance with such by-laws. For purposes of giving notice, and for all other purposes relating to the activities of FPI, the parties' addresses shall be as set forth hereinbelow until notice of change of address is given in writing to the secretary of FPI:

Herbert Reed: c/o Leo Branton, Jr.
3450 Wilshire Blvd.
Suite 1107
Los Angeles, California 90010

Buck Ram: P.O. Box 194,
Encino, California 91316

Jean Benett: P.O. Box 39
Las Vegas, Nevada 89101

FPI: P.O. Box 39
Las Vegas, Nevada 89101

PP: P.O. Box 39
Las Vegas, Nevada 89101

2. It is expressly acknowledged and understood that, except to the extent necessary to give effect to paragraph 1(a) hereof, nothing contained herein shall in any way be deemed a waiver by FPI or Reed of any ownership interests they have or claim to have in or to the name "The Platters." In this regard, FPI and Reed both retain the right at any time to seek a judicial determination regarding such ownership,

and agree that in the event any such litigation is commenced, neither party will be entitled to urge any claims or defenses pertaining to such ownership based on any delay by either party in commencing such litigation, or on the fact that any litigation pending between the parties as of April 1, 1975, has been dismissed. It is the specific intent of such parties that neither party shall in any way be prejudiced in his claim of ownership of the name "The Platters" by reason of having entered into this Agreement.

3. This Agreement shall remain in effect until terminated by mutual agreement of the parties hereto or until the commencement of such litigation as is described in paragraph 2 hereof, whichever first occurs.

4. Without limiting, the generality of paragraph 2 hereof, and solely for the purpose of defining the respective rights and duties of FPI and Reed during the term of this Agreement, FPI and Reed agree as follows:

(a) Neither Reed nor any of his agents, employees, or representatives shall utilize the name "The Platters" or any variation thereof or any name confusingly similar thereto, and Reed shall not advertise or hold himself out as "The Platters" or any variation thereof or any name confusingly similar thereto in connection with any employment undertaken by him.

(b) Notwithstanding the provisions of paragraph 4(a) hereof, Reed may advertise and present himself and his group as "Herb Reed, formerly of the Platters, and his group," "Herb Reed of the original Platters and his group," or any similar billing which denotes that Reed was one of the

original Platters; provided, however, that in any newspaper or magazine advertisement or on any theatre, billboard or marquee, the "type" or "print" shall all be of the same size and boldness, except that "Herb Reed" may be larger than the letters in the rest of the words. Reed agrees to insert the following clause in each and every one of his contracts to entertain, or to deliver a copy of the following clause to his employer if there is no written contract:

> "Any and all publicity for any entertainment provided by Herbert Reed containing the word 'Platters' must read as follows:
> 'Herb Reed, formerly of the Platters, and his group,' 'Herb Reed of the original Platters and his group,' or any similar billing which denotes that Reed was one of the original Platters. The 'type' or 'print' shall all be of the same size and boldness, except that 'Herb Reed' may be larger than the letters in the rest of the words."

Reed further agrees that as soon as he discovers that any advertising in connection with any employment undertaken by him is not in conformance with this paragraph 4(b) he will use his best efforts to cause such advertising to be changed to conform with the provisions of this paragraph 4(b). In the event Reed is unable to cause, such advertising to be so changed, he will forthwith notify an officer or director of FPI (other than himself) of such non-conforming advertising.

5. Subject to his availability (which availability shall not be unreasonably denied) and upon payment of his reasonable expenses, Reed shall assist FPI in all of its

litigation and other proceedings undertaken against persons utilizing the name "The Platters." Such assistance shall take whatever form is deemed necessary by FPI or its attorneys, and may include, without limitation, the giving of sworn testimony in court, in deposition, or by affidavit. In accordance with the intent of this paragraph 5, and notwithstanding the provisions of paragraph 2 hereof, except as between the parties hereto Reed shall not hold himself out as or represent himself to be the owner or an owner of the name "The Platters."

6. To the extent permitted by law, Ram, Bennett, FPI and PP shall use their best efforts to assist Reed in obtaining advantageous employment for musical groups with which he performs. It is understood, however, that none of said parties shall be deemed to be acting as a booking agent, and that they make no guarantee of any such employment. In order to enable Ram, Bennett, FPI and PP so to assist Reed, Reed agrees to furnish Ram, Bennett, FPI and PP with appropriate publicity pictures of himself and his group, together with current publicity and biographical material.

7. Upon execution of this agreement by all of the parties hereto, such parties agree to take all steps necessary to cause the following two actions to be dismissed without prejudice, as that term is defined under California law:

1. Herbert Reed v. Buck Ram, et al., pending in the Superior Court of the State of California for the County of Los Angeles, docket number C-960429; and

2. The Five Platters, Inc. v. Herbert

Reed, et al., pending in the Circuit Court of the Eleventh Judicial Circuit in and for the County of Dad, State of Florida, docket number 69-13784.

8. This Agreement shall be governed by and construed according to the laws of the State of California.

9. This Agreement may be executed in any number of counterparts, each of which shall be deemed an original.

/s/_____
HERBERT REED

STATE OF)
)
COUNTY OF)

On 4-29-75 before me, the undersigned a Notary Public in and for said State, personally appeared HERBERT REED, known to me to be the person whose name is subscribed to the within instrument, and acknowledged that he executed the same.

WITNESS my hand and official seal.

/s/_____
Notary Public

/s/_____
JEAN BENNETT

STATE OF NEVADA)
)
COUNTY OF CLARK)

On April 4th, 1975 before me, the undersigned a Notary Public in and for said State, personally appeared JEAN BENNETT, known to me to be the PRESIDENT of Personality Productions and known to me to be the person who executed the within instrument on behalf of said corporation, and acknowledged to me that such corporation executed the within instrument pursuant to its by-laws or a resolution of its board of directors.

WITNESS my hand and official seal.

/s/_____
Notary Public in and for said County and State

THE FIVE PLATTERS, INC.
By /s/_____
Buck Ram

Its President

STATE OF NEVADA)
)
COUNTY OF CLARK)

On April 4th, 1975 before me, the undersigned a Notary Public in and for said State, personally appeared BUCK RAM, known to me to be the PRESIDENT of The Five Platters, Inc. and known to me to be the person who executed the within instrument on behalf of said corporation,

and acknowledged to me that such corporation executed the within instrument pursuant to its by-laws or a resolution of its board of directors.

WITNESS my hand and official seal.

/s/_____
Notary Public in and for said County and State

APPROVED AS TO FORM AND CONTENT:

_____
Leo Branton, Jr.
Attorney for Herbert Reed

LOEB AND LOEB

_____
Robin Meadow
Attorneys for Buck Ram,
Jean Bennett, The Five Platters, Inc. and
Personality Productions

APPENDIX R

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed February 24, 1997]

CASE NO. CV-S-95-01029-LDG (LRL)

MARTHA ROBI, an individual,
Plaintiff,

v.

HERB REED, an individual dba HERB REED AND THE PLATTERS, an entity unknown; JOHN VILLANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS CORP., a New York corporation; THE FIVE PLATTERS, INC., a California corporation,
Defendants.

AND RELATED CROSS-ACTIONS.

REQUEST TO TAKE JUDICIAL NOTICE OF PETITION FILED IN THE BANKRUPTCY COURT FOR THE DISTRICT OF NEVADA WHICH PERTAINS TO MATTERS BEFORE THIS COURT

FEDERAL RULES OF EVIDENCE (RULE 201)

CAM FERENBACH, ESQ.
LIONEL SAWYER AND COLLINS
300 South Fourth Street
Las Vegas, Nevada 89101
(702) 383-8888

ALLEN HYMAN, ESQ.
DANIEL J. QUISENBERRY, ESQ.
LAW OFFICES OF ALLEN HYMAN
12001 Ventura Place, Suite 501
Studio City, California 91604-2626
(818) 763-6289 or (213) 877-3405

Attorneys for Plaintiff, Counter-Claimant, and Counter-Defendant, MARTHA ROBI

Pursuant to Federal Rules of Evidence, Rule 201, Plaintiff and Counter-Defendant Martha Robi ("ROBI") respectfully requests that this Court take Judicial Notice of the following petition and accompanying schedules filed in the Bankruptcy Court of the District of Nevada, In Re: The Five Platters, Inc., Case No. BK-S 96-27437 (RCJ), File Date December 17, 1996, which contain certain schedules which pertain to matters presently pending before this Court, that being the contested claims of both Defendant Herb Reed

("REED") and Plaintiff, ROBI with regard, to the tradename' "The Platters" as follows:

1. Attached as Exhibit No. 1 is the Notice of Commencement of case for the District of Nevada of the Bankruptcy.

2. The California corporation known as "The Five Platters, Inc." filed Bankruptcy in the U.S. District Court, District of Nevada, on December 18, 1996.

3. Attached as Exhibit No. 2 are the initial Bankruptcy Schedules of The Five Platters, Inc., an amendment to the Bankruptcy Petition and numerous schedules. These documents are Bates stamp Nos. 000001 to 000035.

4. The following representations are set forth in certain of the Bankruptcy Schedules:

(a) In Exhibit A to the Voluntary Petition, the Debtor states in Paragraph No. 4 ". . . Brief Description of Debtor's Business: The Five Platters, Inc., owns the vocal group, THE BUCK RAM PLATTERS, which has entertained audiences internationally for over 40 years . . ." (Bates stamp No. 000006).

(b) ". . . This statement is set forth under penalty of perjury on December 16, 1996. . ." (Bates Stamp No. 000007).

(c) Debtor The Five Platters, Inc., filed an Amendment to the Bankruptcy Petition, Bates stamp No.

000011 where the Debtor attaches numerous schedules as to property owned by the Debtor.

(d) The "Summary Of Schedules," attached to the Amended Petition, is attached as Bates stamp No. 000012.

(e) The Debtor, The Five Platters, Inc., identifies as its assets $1,454,734.00, in Personal Property Schedule B in the "Summary of Schedules," as the only assets of The Five Platters, Inc. (Bates stamp No. 000012).

(f) On the Schedule B of Personal Property, Bates stamp No. 000015, the Debtor, The Five Platters, Inc., identifies "personal property" as including:

(1) "Platter's trademarks: Australia, France, Spain and Italy. Common Law rights to the name. The Five Platters, Inc., has valued these assets at $300,000.00 (App) . . . (Bates stamp No. 000015).

(2) The Five Platters, Inc., on the same schedule of personal property, has valued: ". . . FPI has licensed Herbert Reed and Larry Marshak, which is valued at $50,000.00 (App). . ." (Bates stamp No. 000015).

(3) Jean L. Bennett declared, under penalty of perjury, that the Debtor had title to these assets. (Bates stamp No. 000025).

5. These bankruptcy schedules, and personal property, and listing of assets, of The Five Platters, Inc., in the District Court, directly pertain to matters presently before

this Court in the ROBI/REED dispute as follows:

(a) REED, in his Motion for Summary Judgment, has both testified and presented to this Court arguments to the effect that:

(1) REED's rights in "The Platters" were revived once it was determined that The Five Platters, Inc., had to no rights to utilize the name "The Platters." (REED Motion at 5:23-28; 6:1-3; .7:9-12; 16:24-28).

(2) REED has also testified and asserted that he entered into an agreement with The Five Platters, Inc., under which he was enjoined from performing as "The Platters" by agreement with The Five Platters, Inc. (REED Motion at 16:7-9, 24-28) REED would not produce the agreement or provide information concerning its terms.

(3) REED contends that "all evidence" is contrary to ROBI'S claim that REEDS rights derive from The Five Platters, Inc. (REED Motion at 16:2-3; 17:14-25) REED further contends that he and The Five Platters, Inc. were "adversaries." (REED Motion at 16:5-7; 17:14-25)

(b) The Five Platters, Inc., in its bankruptcy schedules, filed in the District Court in Nevada, lists, as its assets, rights to the trademark "The Platters." To the extent that REED's claims to a "revival" of his exclusive rights to the trademark "The Platters," is based upon the loss of rights of The Five Platters, Inc. The filing of these asset schedules in the Bankruptcy Court is evidence under oath that The Five Platters, Inc., still claim and assert rights in the trademark

"The Platters." This declaration of the Debtor as to its assets in the trademark is inconsistent with REED's assertion as an "Undisputed Fact" comprising the basis for his Motion for Summary Judgment that The Five Platters, Inc., have no rights, and his exclusive rights are therefore revived. The Bankruptcy Schedule is admissible evidence and raises an inference as to facts contrary to REED's fundamental position on Summary Judgment. (REED Motion at 5:23-28; 6:1-3; 7:9-12; 16.24-28).

(c) As well, the Bankruptcy schedule of The Five Platters, Inc., lists as an asset the license of The Five Platters, Inc., to REED and Marshak, valuing that asset as $50,000.00. This claim of assets to the Bankruptcy Court raises the inference that REED is a licensee of The Five Platters, Inc., and derives his rights to "The Platters" trademark from The Five Platters, Inc.'s right, which is an asset of the Bankruptcy estate.

(d) ROBI had requested discovery, requesting disclosure of this FIVE/PLATTER/REED license, its nature, and additional discovery into the history of association between REED and The Five Platters, Inc., as part of its discovery to oppose the Motion for Summary Judgment. REED objected to this discovery, did not produce any documentation, and discovery was precluded by Order of the Magistrate in granting REED a Protective Order.

Respectfully submitted,

DATED: February 24, 1997
LIONEL, SAWYER & COLLINS

By: /s/_____
CAM FERENBACH, ESQ.
Attorneys for Plaintiff,
Counter-Claimant, and
Counter-Defendant
MARTHA ROBI
300 South Fourth Street
Las Vegas, Nevada 89101
Phone: (702) 383-8888
Fax: (702) 383-8845

DATED: February 21, 1997
LAW OFFICES OF ALLEN HYMAN

By: /s/_____
ALLEN HYMAN
Attorneys for Plaintiff,
Counter-Claimant, and counter-Defendant
MARTHA ROBI
12001 Ventura Place, Suite 201
Studio City, CA 91604-2626
Phone: (818) 763-6289
Fax: (818) 763-4676

APPENDIX S

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed November 19, 1998]

No. 97-16909
CV-S-95-1029-LDG(LRL)

MARTHA ROBI,
Plaintiff/Appellant

v.

HERB REED, et al.
Defendant/Appellee.

REQUEST TO TAKE JUDICIAL NOTICE
(FED. RULE EVID. 201)

Pursuant to Federal Rules of Evidence 201, Appellant Martha Robi (ROBI) respectfully requests that the Ninth Circuit Court of Appeals Merits Panel take judicial notice of the following:

1. Pages 1, 2, 3, 12 and 13 (five (5) pages) of the Docket Sheet in Civil Docket for Case No. 96-CV-2292 (NG) (dated as of November 2, 1998), "LARRY MARSHAK, HELEN WILLIAMS, RICKY WILLIAMS AND FIVE

PLATTERS INC. V. JOHN VILLANO AND JP PRODUCTIONS AND HERB REED for the U.S. District Court of 'New York Eastern District (Uniondale), concerning conflict in claims to the trademark "The Platters', which indicate on page 13 of the Docket Sheet that cross-motions for summary judgment are pending at this time.

2. Docket No. 96-CV-2292 (NG) is presently before the Honorable Nina Gershon, United States District Judge.

3. ROBI also presents a forty-seven (47) page transcript of a discovery hearing before the Honorable Michael L. Orenstein, U.S. Magistrate Judge, of August 28, 1998 in this New York District Court Case No. CV-96-2292 which is attached as Exhibit No. 2.

4. Attached as Exhibit No. 3 is an Agreement dated April 5, 1975, which is the subject in part of the hearing in New York and is included in the excerpt of the Record in this Appeal Case No. 97-16909 (ER 126-2).

5. ROBI had requested that the District Court of Nevada take judicial notice of Exhibit ER 126-2, the Agreement of April 5, 1975 (from the Court files of the Southern District of Florida).

6. The transcript of the August 28, 1998 discovery hearing (Ex. No. 2) before Magistrate Orenstein of the Eastern District of New York in Case No. 96-CV-2292 (ND) pertains to, among other matters, the discovery request of Five Platters, Inc., Intervenor Plaintiff in that case, that

Herbert Reed (REED) admit that he is a signatory to the April 5, 1975 Agreement (ER 162-2, Ex. No. 2). Portions of the transcript (Ex. No. 2) are stated as follows:

Commencing at 6:15-23 (Ex. No. 2):

> ATTORNEY DAVIS: "The need for the notice to admit arose in the first 'instance when Mr. Donnelly, on behalf of Reed, moved for summary judgment in the Nevada action against the Robie (ph.) Platters. In the decision granting summary judgment, the Court had made it clear that the Robie Platters had failed to rebut certain allegations by competent evidence. The competent evidence were certain agreements which Reed had failed -- we'll take the position that Reed had failed to disclose in that action. (Transcript 6:15-23)

* * *

Commencing at 7:9-8:7:

> "One of the agreements that I sought admissions on was a 1975 agreement. It has always been the position of Reed and other original members of the Platters that the transfer of the rights and the name of the corporation was fraudulent, and this was adjudicated as to Robie only in a California district court. It was adjudicated -- and in Robie's favor. It was adjudicated in the New

York State Supreme Court against Tony Williams, but in favor of the Five Platters, Inc., so we had inconsistent decisions, not necessarily inconsistent because the transactions were not necessarily identical.

"Now, Reed was the last of the so-called original Platters to leave the employ of the Five Platters, Inc., so clearly whatever transfers, that these artists were alleging were fraudulent is individual to each of the artists.

"In 1975 Reed and the Five Platters, Inc. enter into an agreement, which agreement clear on its face says that it's intended to correct any deficiencies of the Original 1956 transaction between the artists and the corporation; Five Platters, Inc., so my notice to admit sought admissions with regard to that agreement.

"In response, Reed refused to answer those questions, alleging that because the signature of Buck Ram was not on the copy of the agreement that I had, that he didn't have to answer that." (Transcript 7: 9-8:7.)

* * *

Commencing at 8:22-9:12:

"Next he will argue, which was also

the subject of the notice to admit, because there was a subsequent stipulation between Reed and the Five Platters, Inc. that said that so long as Five Platters, Inc. had rights and so long as in that Reed could not perform as the Platters, and that was so long as no court of competent jurisdiction, including an appeal, had adjudicated that the Five Platters, Inc. had no rights.

"Of course we have California district court decisions from April of '97 which confirm that no California district court had ever made such an adjudication, and lastly, they will probably rely -- well, so in the response notice to admit, Mr. Reed takes the position that in 1987 the New York State Supreme Court refused to enforce an order brought as a contempt attempting to enforce a 1982 decision which enjoins Tony Williams from performing as the Platters." (Transcript 8:22-9:12.)

* * *

Commencing at 11:5-19:

"THE COURT: Well, let me just ask a question. The 1976 agreement that you -- the 1975 agreement that allegedly Mr. Reed was a party to, have you acknowledged and admitted that he was a party to that agreement, and that

that agreement is authentic?

"MR. DONNELLY: Your Honor, here's the --

"THE COURT: It's yes or no, Mr. Donnelly, please.

"MR. DONNELLY: What I --

"THE COURT: Forget what he asked. I'm asking the question now. Is the 1976 agreement authentic that you were asked to admit to?

"MR. DONNELLY: The 1975 agreement that I've been asked to assess is not signed by one of the parties, Buck Ram, and the request that I was asked to wasn't asked -- I was not asked. Mr. Reed was not asked." (Transcript 11:5-19.)

* * *

Commencing at 12:1-6:

"THE COURT: Mr. Donnelly, is that Mr. Reed's signature on it?

"MR. DONNELLY: It is.

"THE COURT: There's no question

that --.

"MR. DONNELLY: Judge, we're not denying that.

"THE COURT: Fine." (Transcript 12: 1-6.)

* * *

Commencing at 13:8-17:

"THE COURT: Is there a copy of the agreement where Mr. Ram has signed it?

"MR. DAVIS: I -- my copy does not have it, but the agreement --

"THE COURT: Has anyone produced a copy with his signature?

"MR. DAVIS: Your Honor, there's a number of signators to it.

"MR. DONNELLY: So far as we know, Judge, there is no such copy." (Transcript 13:8-17.)

* * *

Commencing at 13:22-25:

"MR. DONNELLY: You asked me to admit or deny whether he possesses a copy, and I denied that he has a copy. That's not saying I won't tell you. If he doesn't have a copy, he doesn't have it, and I denied it." (Transcript 13:22-25.)

* * *

Commencing at 16:17-17:11:

"THE COURT: He already said he does not have it with Ram's signature.

"MR, DAVIS: He admits to having every other copy of the agreement. 'All the other agreements he has. This one he doesn't have?

"THE COURT: That's his answer.

"MR. DAVIS: In addition, your Honor --

"THE COURT: He will be subject -- if the case goes to trial or it goes further in discovery, and he later has it, then he's going to be chargeable with all the costs, the sanction under Rule 36.

"Mr. DAVIS: Your Honor, I appreciate that he will be charged with the costs, but it's my position that the same conduct of Mr. Reed in failing to disclose these agreements in the first instance to Allen Heyman (ph.), the attorney for Paul Robie in the Nevada District Court resulted in a judgment in favor of Reed, and now because of that we have, you know, this appeal process." (Transcript 16:1[illegible] 17:11.)

7. Exhibit No. 3 (ER 126-2) was not disclosed by Reed in Nevada Court, was obtained from the District Court in Florida after summary judgment. Mr. Donnelly now admits, under, question of the Court, Reed signed:

Commencing at 12:1-6:

"THE COURT: Mr. Donnelly, is that Mr. Reed's signature on it?

"MR. DONNELLY: It is.

"THE COURT: There's no question that --

"MR. DONNELLY: Judge, we're not denying that.

"THE COURT: Fine." (Transcript 12: 1-6.)

8. Though REED's attorney asserts in this hearing that he (or his client) does not have a copy with Buck Ram's (RAM) signature, the copy attached as Exhibit No. 3 (ER 126-2, in this case) has RAM's notarized signature and has been served upon REED's counsel five (5) times in this action, both before the District Court of Nevada and the Court of Appeals of the Ninth Circuit, prior to August 28, 1998.

9. As set forth, this evidence was brought to Appellant's attention during the week of November 16, 1998.

DATED: November 18, 1998

Respectfully Submitted,

LAW OFFICES OF ALLEN HYMAN

By /s/_____
Allen Hyman
Attorney for Plaintiff/
Appellant MARTHA ROBI

Ninth Circuit Court of Appeals - 11/19/98
Request To Take Judicial Notice

EXHIBIT 1

U.S. District Court
New York Eastern (Uniondale)

[Filed May 7, 1996]

CIVIL DOCKET FOR CASE #: 96-CV-2292
Docket as of November 12, 1998 2:48 pm

Marshak, et al v. Vilano, et al
Assigned to: Judge Nina Gershon
Referred to: Magistrate Michael L. Orenstein

Jury demand: Defendant
Demand: $0,000
Nature of Suit: 840
Lead Docket: None
Dkt: in other court: None
Jurisdiction: Federal Question

Cause: 28:1338 Trademark Infringement

LARRY MARSHAK Plaintiff	Lowell B. Davis [COR LD NTC ret] One Old Country Road Carle Place, NY 11514 (516) 746-7474
HELEN WILLIAMS Plaintiff	Lowell B. Davis (See above) [COR LD NTC ret]

Ninth Circuit Court of Appeals - 11/19/98
Request To Take Judicial Notice

RICKY WILLIAMS Plaintiff	Lowell B. Davis (See above) [COR LD NTC ret]
v.	
JOHN VILANO defendant	Stanley K. Shapiro [term 09/01/98] [COR LD NTC ret] 299 Broadway, Suite 1200 New York, NY 10007 (212) 693-1076
	Gerard P. Dunne [COR LD NTC] Law Offices of Gerard F. Dunne, P.C. 156 Fifth Avenue Suite 1223 New York, NY 10010-2007 (212) 645-2410
	T. Christopher Donnelly, Esq. [term 09/01/98] [COR LD NTC] Donnelly, Conroy & Gelharr One Post Office Square Boston, MA 02109 (617) 542-7400

JP PRODUCTIONS, INC. defendant	Stanley K. Shapiro (See above) [COR LD NTC ret]
	Gerard F. Dunne (See above) [COR LD NTC]
	T. Christopher Donnelly, Esq. (See above) [COR LD NTC]
HERB REED defendant	Stanley K. Shapiro (See above) [COR LD NTC ret]
	T. Christopher Donnelly, Esq. (See above) [COR LD NTC]

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JOHN VILANO counter-claimant	Stanley K. Shapiro [COR LD NTC ret] 299 Broadway, Suite 1200 New York, NY 10007 (212) 693-1076
	T. Christopher Donnelly, Esq. [COR LD NTC] Donnelly, Conroy & Gelharr One Post Office Square

	Boston, MA 02109 (617) 542-7400
JP PRODUCTIONS, INC. counter-claimant	Stanley K. Shapiro (See above) [COR LD NTC ret]
	T. Christopher Donnelly, Esq. (See above)
HERB REED counter-claimant	Stanley K. Shapiro (See above) [COR LD NTC ret]
	T. Christopher Donnelly, Esq. (See above)
v.	
LARRY MARSHAK counter-defendant	Lowell B. Davis [COR LD NTC ret] One Old Country Road Carle Place, NY 11514 (516) 746-7474
HELEN WILLIAMS counter-defendant	Lowell B. Davis (See above) [COR LD NTC ret]
RICKY WILLIAMS counter-defendant	Lowell B. Davis (See above) [COR LD NTC ret]

= = = = = = = =

FIVE PLATTERS, INC. plaintiff	Lowell B. Davis [COR LD NTC] One Old Country Road Carle Place, NY 11514 (516) 746-7474

7/17/98 63 AMENDED COMPLAINT by Ricky Williams, Helen Williams, Larry Marshak, (Answer due 7/27/98 for John Vilano, for JP Productions, Inc., for Herb Reed) amending [1-1] complaint adding The Five Platters as a plaintiff. (Rg) (Entry date 07/20/98)

8/7/98 66 ANSWER by Herb Reed to amended complaint, counterclaim; jury demand (rg) [Entry date 08/10/98]

8/10/98 67 LETTER dated 7/17/98 from Lowell Davis to Orenstein, M.; re: pltf's amended complaint (cmc) [Entry date 08/11/98]

8/12/98 68 MOTION by T. Christopher Donnelly and Stanley K. Shapiro move to withdraw as counsel for defendants and counterclaim plaintiffs John Villano and John P. Productions, Inc. And further move that Gerard F. Dunne be substituted as attorney for Villano and John P. Productions, Inc. No Motion hearing set for [68-1] motion or [68-2] motion. (See attached Exhibits A-C) (sg)

Ninth Circuit Court of Appeals - 11/19/98
Request To Take Judicial Notice

[Entry date 08/13/98]

8/12/98	69	ANSWER by JP Productions, Inc., and John Villano to amended complaint, jury demand. (Sg) [Entry date 08/13/98]
8/14/98	70	LETTER dated 8/10/98 from Gerard Dunne to Orenstein, M.; re: to inform you that I will be substituting as counsel for Villano and JP Productions; T. Christopher Donnelly and Stanley Shapiro will continue as counsel for Herb Reed (cmc)
8/24/98	71	Pltff's REPLY to deft. Reed's counterclaim. (lg) [Entry date 08/26/98]
8/26/98	72	Letter MOTION by Herb Reed requesting permission to appear telephonically at the status conf scheduled for 8/28/98, Motion hearing (cmc)
8/26/98	--	ORDER, granting (72-1) motion requesting permission to appear telephonically at the status conf scheduled for 8/28/98 (signed by Magistrate Michael L. Orenstein) (doc# 72) c/m (cmc)
8/28/98	--	Status conference held (cmc) [Entry date 08/31/98]

8/28/98 73 Calendar entry: before Orenstein, M. On 8/28/98 at 10:30; status conf; Tape# 98-125 (3218-7005), 98-127 (0-1080); set status conference for 11:30 11/20/98 before Magistrate Michael L. Orenstein; Court directed parties to proceed with dispositive motions in accordance with Judge Gershon's practices; pltf shall serve the cross-motion & opposition to Reed's motion for summary judgment w/i 30 days, Reed shall respond w/opposition & a reply w/i 2 weeks; pltf shall reply 2 weeks thereafter c/m to C. Donnelly (cmc) (Entry date 08/31/98) (Edit date 08/31/98)

9/1/98 -- Endorsed order granting (68-1) motion to withdraw as counsel for defendants and counterclaim plaintiffs John Villano and John P. Productions, Inc. (Terminated attorney Stanley K. Shapiro for John Vilano, attorney T. Christopher Donnelly for John Vilano. Gerard F. Dunne is substituted as attorney for Villano and John P. Productions. (Signed by Nina Gershon, dtd. 8/31/1998). (The endorsed order is located on the front of document #68.) (Dm)

9/4/98 74 LETTER dtd. 8/28/1998 from T. CHRISTOPHER DONNELLY TO LOWELL DAVIS enclosing copies of the motion for summary judgment and supporting documents. (No attachments were received with the ltr.)

(dm)

9/29/98 75 TRANSCRIPT of status conf before Orenstein, M. Filed for dates of 8/28/98; Transcriber: Compu-Scribe, Inc. (Cmc) [Entry date 09/30/98]

10/1/98 76 ORDER, granting plaintiffs' request to extend time from 9/28/98 by one week to oppose defendant Reed's summary judgment motion and file a cross-motion. (Signed by Mudge Nina Gershon, dated 9/28/98). See letter dated 9/25/98 from Lowell B. Davis to Judge Gershon. C/M by Chambers. (Lr)

10/13/98 77 LETTER dated 10/1/98 from Lowell B. Davis, Esq. To Judge Gershon on behalf of plaintiffs requesting an adjournment to file our opposition to defendant Herb Reed's motion for summary judgment as well as to file our cross motion for summary judgment until 10/12/98. (rg)

10/13/98 -- Endorsed order dated 10/6/98 on document #77 granting plaintiff an extension to 10/12/98 to file opposition to motion. (Signed by Judge Nina Gershon) (rg)

APPENDIX T

NOT FOR PUBLICATION
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

[Filed December 9, 1998]

NO. 97-16909
D.C. No. CV 95-01029-LDG

MARTHA ROBI,	)
Plaintiff-Appellant,	)
	)
v.	)
	)
HERB REED, an individual, dba/	)
Herb Reed and The Platters, an entity	)
unknown; THE FIVE PLATTERS INC.;	)
JOHN VALANO, an individual; JP	)
PRODUCTIONS, an entity unknown;	)
TONY CEE ASSOCIATES, an entity	)
unknown; CUZIN RICHARD	)
ENTERTAINMENT ASSOCIATES, an	)
entity unknown; UNITED CONCERT	)
PRODUCTIONS, a New York Corporation,)	
Defendants-Appellees.	)
	)

ORDER

Before: CANBY and KLEINFELD, Circuit Judges, and KEEP, District Judge.*

KEEP, District Judge:

On November 18, 1998, plaintiff/appellant Martha Robi filed a motion to take judicial notice pursuant to Federal Rule of Evidence 201. Appellant's request concerns a number of items from a case involving the trademark "The Platters" pending in the U.S. District Court of New York, Eastern District, and an agreement from 1975 from the court files of the Southern District of Florida.

We deny appellant's motion. As we stated in U.S. ex rel. Robinson Rancheria Citizens Council v. Borneo, Inc., 971 F.2d 244 (9th Cir. 1992), we will generally not consider facts developed outside the record that was developed before the district court. Id. at 248. Though we may take notice of proceedings in other courts "if those proceedings have a direct relation to the matters at issue," id., we find that the materials at issue in this motion are not pertinent to this court's opinion.

Hence, appellant's request to take judicial notice is denied.

---

* The Honorable Judith N. Keep, District Judge, United States District Court for the Southern District of California, sitting by designation.

APPENDIX U

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

[Filed June 28, 1996]

No. CV 93-4546 CBM

MARTHA ROBI,	)
Plaintiff,	)
	)
v.	)
	)
JEAN BENNETT, et al.,	)
Defendants.	)
	)

ORDER RE: DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

This matter is before the Court, the Honorable Consuelo E. Marshall, United States District Judge, presiding, on Defendants' Motion for Summary Judgment. Upon consideration of the papers, record, and oral argument, the Court hereby DENIES Defendants' motion.

FACTUAL & PROCEDURAL BACKGROUND

In 1984, Paul Robi filed Paul Robi v. The Five Platter, Inc et al., CV 84-3326(CBM), against defendants The Five

Platters, Inc., Jean Bennett and Buck Ram. On January 9, 1989, this Court entered its Findings of Fact and Conclusions of Law. These findings incorporated the findings of fact made by Judge Levit in an earlier case filed by Plaintiff in Court. Essentially, this Court's judgment in the prior case enjoined the Defendants from: (1) initiating any litigation against Plaintiff pertaining the rights to "The Platters" and (2) communicating or indicating to any third party that Plaintiff has no rights to the name "The Platters."

The present action was filed by Plaintiff Martha Robi on July 30, 1993 seeking damages for federal unfair competition, state unfair competition, violations of the California Anti-Dilution statute, constructive trust, and accounting. Plaintiff also seeks this Court to enjoin Defendants from using the trademark "The Platters." Defendants presently move for summary judgment on the grounds that this action is barred by the principles of res judicata and collateral estoppel as a consequence of the earlier action in this Court.

DISCUSSION

Under Rule 56(c) of the Federal Rules of Civil Procedure, summary judgment shall be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). T.W. Elec. Serv. Inc. V. Pacific Elec. Contractors Ass' n, 809 F.2d 626, 630 (9th Cir. 1987). The party requesting summary judgment has the initial burden to

show that there are no genuine issues of material fact. Bhan v. NME Hospitals, Inc., 929 F.2d 1404, 1409 (9th Cir. 1991), cert denied

The principles of "res judicata" encompass two separate legal doctrines -- claim preclusion and issue preclusion. Robi v. The Five Platters, Inc., 838 F.2d 318, 321 (9th Cir. 1988). The principle of issue preclusion, by definition, precludes "relitigation of the issues actually litigated and determined in the prior suit, regardless of whether it was based on the same cause of action as the second suit." Lawlor v. National Screen Service Corp., 349 U.S. 322, 326 (1955) (emphasis added). This principle requires that the issue have been "necessarily decided" in the prior judgment, after a "full and fair opportunity" to litigate. Robi, 838 F.2d at 322. It also requires that the same party have lost on the issue in the earlier action. Id. The burden of proof rests with the party asserting preclusion to show actual decision of the specific issues involved. Hernandez v. City of Los Angeles, 624 F.2d 935, 937 (9th Cir. 1980).

Upon review of this Court's January 9, 1989 Findings of Fact in the earlier action, it is clear that the Court did not make a determination of whether Defendants are entitled to use the name "The Platters. The only statement made by the Court with respect to this issue was the following:

> "The 1974 decision rendered by Judge Levit was adverse to defendants' claim of ownership of their trademark in that the court determined that defendants were not the only parties entitled to use the registered name and

> accordingly, denied injunctions prohibiting such use by others, including of Fact and Conclusions of Law, p.9.)

Although the Court did adopt Judge Levit's findings canceling Defendants' exclusive rights to the name, the Court did not make any findings either approving or disapproving of Defendants' use of the name. Consequently, since this issue was not determined in the prior action, Plaintiff's claim is not barred by the principle of issue preclusion.

The doctrine of claim preclusion requires that a plaintiff advance every claim for relief "arising out of the same transaction or occurrence." C.D. Anderson & Co. V. Lemos, 832 F.2d 1097 (9th Cir. 1987). Claim preclusion "bars litigation of all matters which could have been raised in support of a cause of action previously litigated." Sidney v. Shah, 718 F.2d 1453, 1458 (9th Cir. 1983).[1] If the conduct at issue constitutes a substantially single course of conduct continuing throughout the first suit, a new cause of action is created. See Wright, Miller & Cooper, Federal Practice and Procedure, Jurisdiction § 4409 (West 1981). In the present action, Plaintiff seeks redress for continuous conduct that extended beyond this Court's Order in 1989. Since this conduct could not have been previously litigated in the prior action, claim preclusion does not bar Plaintiff's claims.

---

[1] Claim preclusion also commonly requires identity of parties. There is no dispute that Paul Robi and Martha Robi are in privity with each other

BASED ON THE FOREGOING, Defendants' motion for summary judgment is hereby DENIED.

IT IS SO ORDERED.

Dated: 6/28/96 /s/_____
CONSUELO B. MARSHALL
UNITED STATES DISTRICT JUDGE

APPENDIX V

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed March 5, 1999]

No. 97-16909
CV-S-95-1029-LDG (LRL)

MARTHA ROBI,
Plaintiff/Appellant

v.

HERB REED, et al. –
Defendant/Appellee.

REQUEST TO TAKE JUDICIAL NOTICE
[FED. RULE EVID. 201]

Appellant Martha Robi (ROBI) respectfully requests the United States Court of Appeals for The Ninth Circuit to take judicial notice of certain proceedings in Docket No. 98 CV 3712, Five Platters, Inc., et al v. Monroe Powell, et al. (Complaint filed on May 13, 1998, attached as Exhibit No. 3), presently pending before the United States District Court for the Central District of California (Western Div.).

1. An unofficial copy of the Docket Sheet

(obtained by Internet access) of Civil Docket Case No. 98 CV 3712, as of January 6, 1999, is attached as Exhibit No. 1 to this Request to Take Judicial Notice.

2. In presenting this Request To Take Judicial Notice, Appellant ROBI is mindful of this Circuit Court's December 9, 1998 Order, a copy of which is attached as Exhibit No. 2 to this Request to Take Judicial Notice.

3. As stated by this Appellate Court in its December 4, 1998 Order in response to ROBI's prior (November 18, 1998) Request to Take Judicial Notice, pertaining to ". . . a case involving the trademark 'The Platters' pending in the U.S. District Court of New York, Eastern District . . .," this Court of Appeals held:

> "We deny appellant's motion. As we stated in U.S. ex rel. Robinson Rancheria Citizens Council v. Borneo., Inc., 971 F.2d 244 (9th Cir. 1992), we will generally not consider facts developed outside the record that was developed before the district court. Id. at 248. Though we may take notice of proceedings in other courts 'if those proceedings have a direct relation to the matters at issue,' id., we find that the materials at issue in this motion are not pertinent to this court's opinion."
>
> "Hence, appellant's request to take judicial notice is denied." (Page 2, of Exhibit No. 2, December 9, 1998 Order of the Circuit Court

of Appeals.[1]

4. Appellant ROBI suggests to the Court of Appeals, that the matters set forth in Civil Docket No. 98 CV 3712 which portions are tabbed, and attached as Exhibits Nos. 3, 4, 5, and 6, are: ". . . proceedings (which) have a direct relation to matters at issue" before this Court. United States ex rel. Robinson, supra, at 248.

5. The specific ". . . matter (which Appellant ROBI contends is) at issue. . ." (in this appeal) is identified with specificity in the Brief of Appellees at 19, where Appellees state:

> "Earlier, in 1987, PPI and Reed had settled a suit in the Southern District of Florida by agreement under which Reed retained the right to perform as 'Herb Reed and The Platters' and conditionally agreed not to use the name 'The Platters' by itself unless FPI were found to have no rights in the name. (HR Aff., ¶ 62.) That condition in fact occurred when the California federal (sic) court confirmed that FPI was a sham and canceled its marks (Tab 52)--a decision affirmed by this Court. Robi, 918 F.2d at 144." (Brief of Appellees at 19.)

---

[1] As indicated in the citations in Robinson Rancheria Citizens, supra Id. at 248, (court took judicial notice of proceedings and filing in other courts, including a decision of the California Supreme Court issued while the parties' appeal in the federal case was pending)."

(Emphasis added.)

6. Appellees in their Brief admit 'that Appellee REED entered into an agreement:

> "...not to use the name The Platters by itself unless FPI were found to have no rights in the name."

Appellee B then assert in their Brief:

> "...that condition in fact occurred . . . and REED's future interest then 'sprung forth' as a result, of the prior District Court decision in favor of ROBI which cancelled FPI trademark registrations upheld by this Court at Robi 918 F.2d 144.
> (Appellees' Brief at 19.)

If "that condition in fact" had not occurred and had not lost all rights, REED by his own admission is' restricted to what rights he has, as licensee under FPI. (Appellees' Brief at 19.)[2]

7. As this Request to Take Judicial Notice indicates, contrary to the assertion of Appellees, as a basis for their motion for summary Judgment that FPI and Bennett

---

[2] Concessions and admissions of a party does have binding effect. Fisher v. I.N.S. 79 F.3d 955, 965 (9th Cir. 1996) (en banc) (Canby J. concurs).

"were found to have no rights in the name. . ." (Appellees' Brief at 19), the following indicates a question of fact to the contrary:

a. The civil case 98 CV 3712 filed by The Five Platters, Inc., May 13, 1998, nine (9) months after summary judgment was entered in this case (Exhibit No. 3, Complaint, page 1, filed-stamped May 13, 1998), indicates that:

(1) FPI, in Case 98-3712 R (Exhibit No. 3), have sued Monroe Powell and Rowil Entertainment. Paragraph No. 7 alleges, among other matters:

> "Although FPI's federal trademark registration of The Platters mark has been cancelled (Ex. No. 32:26-27) . . . no Court has ever ruled (in perhaps as many as 45 lawsuits involving FPI and the Platters mark), that FPI has no rights to the mark. In fact, the same court that ordered the registration be canceled, ruled that it never made any findings either approving or disapproving FPI's use of the Platters mark." (Ex. No. 3, Complaint at 3:1-6.)

(2) FPI in Case 98-3712 R (Exhibit No. 3) allege violation of Lanham Act 15 U.S.C. Section 1125. (Exhibit No. 3 at 3:27.)

(3) FPI in case 98-3712 R (at paragraph No. 18, Ex. No. 3 at 5:3-5) alleges that:

> "...the defendants acted with the unlawful purpose of: a) Improperly taking advantage of the valuable goodwill belonging to the plaintiffs and the trade name and service mark 'the Platters.'"

(4) FPI also alleges unfair competition by infringement of common law rights. (Ex. No. 3 at 6: 17.)

b. The Notice of Motion and Motion for Preliminary Injunction filed May 21, 1998, the Declaration of Jean Bennett indicates (Ex. No. 4, at page 12):

(1) "The Five Platters Inc. and Personality Productions Inc. have been continuously using the Mark, 'The Platters' since the 1950's engaging the services of various performers to sing under the company's direction." (Ex. No. 4, Decl. of Bennett at 12:5-8.)

(2) In Bennett's Declaration, she refers to an Order of the Untied States District Court of June 28, 1996, as Exhibit C, where the District Court in the case of Robi v. Five Platters, Inc. rules in 1996 in interpreting the Court's own prior ruling (Order in Martha Robi v. Jean Bennett, CV 93-4546 CBM, Ex. C to Ex. 4, also included as Exhibit No. 5) as follows:

> "Upon review of the Court's January 9, 1989 Findings of Fact in the earlier action, it is clear that the Court did not make a

determination of whether Defendants are entitled to use the name 'The Platters.' The only statement made by the Court with respect to this issue was the following:

> 'The 1974 decision rendered by Judge Levit was adverse to defendants' claim of ownership of their trademark in that the court determined that defendants were not the only parties entitled to use the registered name and accordingly, denied injunctions prohibiting such use by others, including the plaintiff herein.' (See January 9, 1989 Findings of Fact and Conclusions of Law, p. 9.)

"Although the Court did adopt Judge Levit's findings canceling Defendants' exclusive rights to the name, the Court did not make any findings either approving or disapproving of Defendants' use of the name. Consequently, since this issue was not determined in the prior action, Plaintiff's claim is not barred by the principle of issue preclusion." (Order 3:17 to 4:8.) (Emphasis added.)

(Order of the United States District Court Case 93-4546, attached as Exhibit C to Exhibit No. 4 Request to Take Judicial Notice (attached in full as Exhibit No. 5).)

c. Attached as Exhibit No. 6 are the face page and

selected pages from the deposition of Jean Bennett, testifying on behalf of FPI in the 98 CV 3712 case on January 26, 1999, where Jean Bennett testifies, among other matters, as follows:

> "Q. Has either The Five Platters, Inc., or Personality Productions, Inc., licensed to anybody else the right to use the name 'The Platters' or 'The Buck Ram Platters' over the last five years?
>
> A. Yes.
>
> Q. And to whom?
>
> A. One is a group in Branson, Missouri.
>
> Q. And when was this license entered into?
>
> A. I can't recall the exact date. It must have been two years ago or something like that...
>
> Q. Does the license agreement restrict them from performing under the name of 'The Platters' or 'The Buck Ram Platters' in the Branson area?
>
> A. They don't perform under 'The Buck Ram Platters.' They perform as 'The Platters.'

Q. And their right to use the name 'The Platters' stems from this license agreement--

A. Yes . . . .

Q. And is that a license agreement with Five Platters, Inc.?

A. Yes . . . ."

(Deposition testimony of Jean Bennett at Pages 21:10-19, 23:5-17, attached as Exhibit No. 6.)

Q. Other than The Buck Ram Platters and the Branson Platters, are there any other groups using the name 'The Platters' or any variation of 'The Platters' that have been licensed by either you, Five Platters, Inc., or Personality Productions?

A. The Larry Marshak.

Q. And Larry Marshak acquired a license from Five Platters, Inc.

A. Five Platters, Inc., yes.

Q. And to use the name 'The Platters'?

A. Yes.

Q. And when did that occur, if you can

recall?

A. I imagine, approximately two years ago or something like that, maybe longer . . . .

Q. And that was to use the name 'The Platters' in connection with the group that Mr. Marshak was handling; would that be accurate?

A. Yes . . . ."

(Deposition testimony at Pages 25:14-26:2, 26:9-12, attached as Exhibit No. 6.)

"Q. And at that same time, 1970, when Mr. Powell had entered into the first employment contract with Five Platters, Inc., who owned the shares of Five Platters, Inc.?

A. Probably Buck Ram and me.

Q. Anybody else that you can recall?

A. Probably Personality owned 20, Herbert Reed owned 20, and Buck Ram owned 60.

Q At the 'time Mr. Powell was first employed by The Five Platters, was Mr. Reed still singing with The Platters?

A. No. No.

Q. But he was still a member of the corporation, to the best of your recollection?

A. In 1969 he left the corporation. Me resigned, but he kept his stock for a while.

Q. Do you recall when he relinquished or sold his stock?

A. Relinquished in 1987 when we made a settlement with Mr. Reed to license him -- that's another license I forgot about. We licensed him to let him perform as long as he was able.

Q. And is that license still in effect?

A. Yes. . ."

(Deposition testimony at Pages 110:21-111:19, attached as Exhibit No. 6.)

DATED: March 3, 1999

Respectfully Submitted,

LAW OFFICES OF ALLEN HYMAN

By /s/_____
Allen Hyman
Attorney for Plaintiff/
Appellant MARTHA ROBI

Ninth Circuit Court of Appeals - 3/5/99
Request To Take Judicial Notice

EXHIBIT 1

PACER session date: Wednesday February 10, 1999 07:45:20 PM EST
Case docket was last updated on: 01/06/99.

Docket as of January 6, 1999 6:23 pm Page 1

Proceedings include all events.
2:98cv3712 Five Platters Inc, et al v. Monroe Powell, et al (BQRx)

U.S. District Court
Central District of California (Western Div.)

CIVIL DOCKET FOR CASE #: 98-cv-3712

Five Platters Inc, et al v. Monroe Powell, et al
Filed: 05/13/98
Assigned to: Judge Manuel L. Real Jury demand: Both
Referred to: Discovery Brian Q. Robbins
Demand: $0,000 Nature of Suit: 840
Lead Docket: None Jurisdiction: Federal Question
Dkt# in other court: None

Cause: 15:1125 Trademark Infringement (Lanham Act)

FIVE PLATTERS INC, a California corporation Plaintiff	Michael Machat [COR LD NTC] Michael Machat Law Offices 1875 Century Park E Suite 600

	Los Angeles, CA 90067 310-551-3030
PERSONALITY PRODUCTIONS, INC, a Nevada Corporation plaintiff	Michael Machat (See above) [COR LD NTC]
v.	
MONROE POWELL defendant	Richard M Fannan [COR LD NTC] Leland Parachini Steinberg Matzger & Melnick 500 S Grand Ave. 11th Floor Los Angeles, CA 90071-2609 213-623-7505
ROWIL ENTERTAINMENT defendant	Richard M Fannan (see above) [COR LD NTC]

Docket as of January 6, 1999 6:23 pm Page 2

Proceedings include all events.
2:98cv3712 Five Platters Inc, et al v. Monroe Powell, et al (BQRx)

5/13/98	1	COMPLAINT filed Summons(es) issd referred to Discovery Brian Q. Robbins; Jury demand
(jp)		[Entry date 05/18/98]

5/21/98 2 NOTICE OF MOTION AND MOTION by plaintiff Five Platters Inc, plaintiff Personality Prod Inc for preliminary injunction; Memo of p/a; Decl of Jean Bennett; motion hearing set for 10:00 65/15/98 (kh) [Entry date 05/22/98]

5/22/98 3 OPPOSITION by defendant Monroe Powell, defendant Rowil Entertainment to motion for preliminary injunction [2-1] and req for sanctions; Decl of Richard Fannan (kh) [Entry date 05/27/98]

5/22/98 4 REQUEST by defendant Monroe Powell, defendant Rowil Entertainment for judicial notice re motion for preliminary injunction [2-1] (kh) [Entry date 05/27/98]

5/29/98 5 NOTICE by defendant Monroe Powell, defendant Rowil Entertainment of related case(s) CV97-8433 CBM, CV93-4546 CBM (jc) [Entry date 06/01/98]

6/5/98 6 MINUTES: resetting hearing on motion for preliminary injunction [2-1] 10:00 6/29/98 by Judge Manuel L. Real CR: none (lc) [Entry date 06/09/98]

6/8/98 7 REPLY by plaintiff Five Platters Inc, plaintiff Personality Prod Inc to response to motion for preliminary injunction [2-1] (lc) [Entry date 06/09/98]

6/8/98 8 Request for judicial notice by plaintiff Five Platters Inc, plaintiff Personality Prod Inc to motion for preliminary injunction [2-1] (lc) [Entry date 06/09/98]

6/11/98 10 SUR REPLY by defendant Monroe Powell, defendant Rowil Entertainment to rply to to motion for preliminary injunction [2-1] (pj) [Entry date 06/12/98]

6/23/98 11 DECLARATION of Monroe Powell by defendant Monroe Powell, defendant Rowil Entertainment re motion for preliminary injunction [2-1] (lc) [Entry date 06/29/98]

6/25/98 12 DECLARATION of Jean Bennett by defendant Monroe Powell, defendant Rowil Entertainment re motion for preliminary injunction [2-1] (lc) [Entry date 06/29/98]

6/25/98 13 NOTICE OF OBJECTION to late filing of decl of Monroe Powell by plaintiff Five Platters Inc, plaintiff Personality Prod Inc to motion for preliminary injunction [2-1] (lc) [Entry date 06/29/98]

Docket as of January 6, 1999 6:23 pm Page 3

Proceedings include all events.
2:98cv3712 Five Platters Inc, et al v. Monroe Powell, et al (BQRx)

6/25/98 14 NTC OF REQUEST TO CROSS EXAM declarant Monroe Powell by plaintiff Five Platters Inc, plaintiff Personality Prod Inc to motion for preliminary injunction [2-1] (lc) [Entry date 06/29/98]

6/29/98 15 MINUTES: Hrg on plf motion for preliminary injunction hld and mot denied; deft to subm prop ord [2-1] by Judge Manuel L. Real CR; Leonore LeBlanc (lc) [Entry date 07/07/98]

7/31/98 16 ORDER RE TRANSFER PURSUANT TO GENERAL ORDER 224 (Related Case) filed. [Related Case mo.: CV84-3326 CBM (Anx)] Transfer of case declined for the reasons set forth on order by Judge Consuelo B. Marshall. (cc: all counsel) (jc)

10/9/98 17 JOINT REPORT OF EARLY MEETING OF COUNSEL filed. Estimated length of trail 5 to 10 dys (tw) [Entry date 10/15/98]

12/28/98 18 COURT'S NOTICE of hearing; pretrial conference on 11:00 3/22/99 (lc) [Entry date 01/04/99]

1/4/99 19 ORDER by Judge Manuel L. Real denying motion for preliminary injuction [2-1] (ENT 1/6/99), mld cpys & ntcs. (tw) [Entry date 01/06/99]

[END OF DOCKET: 2:98cv3712]

EXHIBIT 3

Michael Machat
Attorney at Law
1875 Century Park East, Suite 600
Los Angeles, CA 90067
(310) 551-3030

Attorney for Plaintiffs
the Five Platters Inc. and Personality Productions, Inc.

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

[Filed May 13, 1998]

Case No. 98-3712

THE FIVE PLATTERS, INC., a California Corporation, PERSONALITY PRODUCTIONS, Inc., a Nevada Corporation,
Plaintiffs,

v.

MONROE POWELL and ROWIL ENTERTAINMENT,
Defendants.

Ninth Circuit Court of Appeals - 3/5/99
Request To Take Judicial Notice

COMPLAINT

Plaintiffs demand Jury Trial

JURISDICTION AND VENUE

1. Plaintiffs Five Platters, Inc., and Personality Productions, Inc. bring this action for injunctive relief and damages arising out of the unauthorized, unfair, and deceptive competitive practices of Defendants, and each of them, in connection with the commercial use and exploitation of the trademark/tradename "The Platters", contrary to Section 43 (a) of the Lanham Act, and to the common law of the state of California and of the Untied States of America.

2. This action arises under the trademark laws of the United . . . .

APPENDIX W

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed September 18, 1994]

CV-S-95-01029-LDG (LRL)

MARTHA ROBI, an individual
Plaintiff,

vs.

HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; JP PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation,
Defendants.

MOTION OF DEFENDANTS AND COUNTERCLAIM PLAINTIFFS HERB REED, JOHN VILLANO AND JOHN P. PRODUCTIONS,

District Court of Nevada - 9/18/94
Motion for Summary Judgment

INC. FOR SUMMARY JUDGMENT, WITH POINTS AND AUTHORITIES

Kristina Pickering
Elayna J. Youchah
Morris Brignone & Pickering
1203 Bank of America Plaza
300 South Fourth Street
Las Vegas, NV 89101
(702) 474-9400

T. Christopher Donnelly
Donnelly, Conroy & Gelhaar, LLR
One Post Office Square
Boston, MA 02109-2105
(617) 542-7400

Attorneys for Defendants and Counterclaim Plaintiffs
Herb Reed, John Villano and John P. Productions, Inc.

Pursuant to Fed. R. Civ. P. 56, defendants and counterclaim plaintiffs Herb Reed, John Villano ("Villano") and John P. Productions, Inc. ("JPPI") move for summary judgment in their favor and against plaintiff and counterclaim defendant Martha Robi:

- Dismissing with prejudice plaintiff's complaint;

- Entering a permanent injunction:

Restraining Martha Robi, her agents, servants, employees, attorneys, and persons in active, concert or participation with them,

from using in any manner the mark "The Platters", alone or in conjunction with any other names or words; and

Directing Martha Robi, her agents, servants, employees, and attorneys, and persons in active concert or participation with them, to deliver to this Court (or officer appointed by the Court) for destruction all goods, articles, or other matters bearing the mark "The Platters", including goods, articles, and other matters bearing the mark "The Platters" alone or in conjunction with any other names or words.

- Ordering cancellation of Martha Robi's Nevada registration and all other state registrations of the service mark "The Platters".

- Awarding Herb Reed, Villano, and JPPI money damages in an amount to be determined at a damages hearing, plus costs and attorneys' fees.

This motion is supported by the Affidavit of Herb Reed, sworn to May 7, 1996, the exhibits attached thereto and applicable case law (including two unpublished opinions previously submitted at the injunction hearing as Plaintiff's Exhibits 70 and 74).

As shown in the following points and authorships, Herb Reed is entitled as a matter of law to exclusive rights to the mark "The Platters" because it is undisputed that he was

the first to create the mark, he was the first to use the mark, and Martha Robi's use of the mark did not begin until 1988. Given Herb Reed's priority, Martha Robi's claims fail as a matter of law and he is entitled to summary judgment in his favor. West Corp. v. NYM Co. of Cal., Inc., 595 F. 2d 1194, 1198-1201 (9th Cir. 1979).

MORRIS, BRIGNONE & PICKERING

By: /s/_____

Kristina Pickering
Elayna J. Youchah
Morris Brignone & Pickering
1203 Bank of America Plaza
300 South Fourth Street
Las Vegas, NV 89101
(702) 474-9400

T. Christopher Donnelly
Donnelly, Conroy & Gelhaar, LLR
One Post Office Square
Boston, MA 02109-2105
(617) 542-7400

Attorneys for Defendants
Herb Reed, John Villano and
John P. Productions, Inc.

APPENDIX X

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed October 4, 1996]

Case No. CV-S-95-01029-LDG (LRL)

MARTHA ROBI, an individual *Plaintiff,* vs. HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; JP PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a California Corporation, *Defendants.*	)

STATEMENT OF FACTS EITHER NOT AT ISSUE IN FAVOR OF ROBI OR AT ISSUE IN

District Court of Nevada - 10/4/96
Statement of Facts

OPPOSITION TO REED'S MOTION

ALLEN HYMAN, ESQ.
LAW OFFICES OF ALLEN
12001 Ventura Place, Suite 501
Studio City, California 91604-2626
(818) 763-6289 or (213) 877-3405

AVIVA Y. GORDON, ESQ.
MAHAN AND ELLIS CHARTERED
510 South Ninth Street
Las Vegas, Nevada 89101
(702) 385-3727

Attorneys for Plaintiff
MARTHA ROBI

A. Plaintiff Martha Robi respectfully sets forth her Statement of Facts which are not entirely at issue in her favor or which are at issue. REED did not set forth a separate statement of facts as required LR 56-1.

1. Since he formed the group in 1952, Herd Reed has earned his living solely by singing and performing as The Platters the group he created.

Disputed. REED stipulated to an injunction against himself from using The Platters during 1959 to 1974 and entered into an Agreement with The Five Platters Inc. not to perform as The Platters from 1974 and thereafter. (Affidavit of REED filed in support of a Preliminary Injunction).

(REED has not produced that document).

2. Herbert Reed is the only original member of The Platters who is still personally performing musical entertainment. (Memo at 4:22-23).

Disputed no foundation. Zola Taylor is still alive and may from time to time perform as The Platters.

3. Paul Robi was arrested and severed his relationship with Herb Reed and ceased any musical performance with Herb Reed and The Platters. (Memo at 5:11-14).

Disputed as inconsistent with the findings of the U.S. District Court. The District Court found that Robi and Taylor and Williams left The Five Platters, Inc., and commenced performing as The Platters.

Disputed. The Five Platters, Inc., not the partnership The Platters, sued Robi and Zola May Taylor in 1967 (Exhibit No. 15). In this lawsuit REED asserted as president of The Five Platters, Inc. that The Five Platters Inc. owned all of the rights. Declaration of Herbert REED against Zola Taylor and Paul Robi (Exhibit No. 48).

Exhibit No. 22 shows Robi, Zola Taylor and Williams performing as The Platters independent of The Five Platters Inc.

4. REED asserts that since 1969 Herb Reed discontinued his relationship with REED and The Five

Platters Inc., and he has continuously provided entertainment using the mark "The Platters." Disputed. August 18, 1969 Injunction Order against Herbert Reed. (Exhibit No. 66) [Dissolved 1976 (Exhibit No. 64) . REED was enjoined by the State Court from utilizing the 'name "The Platters" from 1969 to 1976. Thereafter REED asserts in his affidavit that he entered into an agreement with The Five Platters Inc. to not perform as "The Platters."

". . . Long after REED disassociated himself from RAM and The Five Platters in that corporation to prevent Paul Robi from using the mark The Platters. . ." (REED's Motion at 7: 7-9).

Disputed. This is a misrepresentation to the Court the Declaration of Herbert Reed Exhibit No. 48 in Case No. 918 659 in support of Complaint Exhibit No. 15 shows REED as the president of The Five Platters, Inc., actively involved in attempting to stop Robi and Zola Taylor his two partners from performing as The Platters.

5. REED has never assisted the other partners in their efforts against The Five Platters Inc.

Testimony of Robi at the Preliminary Injunction Hearing.

6. REED has never assisted Paul Robi in his activities as asserting the rights against The Five Platters Inc.

Testimony of Robi at the Preliminary Injunction hearing.

7. REED undertook acts inconsistent with that of his Partnership interest in the trademark The Platters.

DECLARATION of REED in support Five Platters Inc Injunction against Robi in 1967, Exhibit Nos. 15 and 48,

8. REED undertook to enter into recordings agreements adverse to those of his partners

Declaration of REED (entering into the Musicor agreement) Exhibit No. 48).

9. REED was the President of the Five Platters Inc. and assisted The Five Platters Inc.

Declaration of REED Exhibit No. 48.

DATED: October 4. 1996

Respectfully submitted,

MAHAN AND ELLIS CHARTERED

By: /s/_____
AVIVA Y. GORDON
Attorneys for Plaintiff
MARTHA ROBI

APPENDIX Y

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed May 6, 1996]

Case No. CV-S-95-01029-LDG (LRL)

MARTHA ROBI, an individual
Plaintiff,

vs.

HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; JP PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a California Corporation,
Defendants.

AFFIDAVIT OF HERB REED
(Partial)

District Court of Nevada - 5/6/96
Affidavit of Herb Reed (Partial)

Kristina Pickering
Joseph R. Ganley
Morris Brignone & Pickering
1203 Bank of America Plaza
300 South Fourth Street
Las Vegas, NV 89101
(702) 474-9400

T. Christopher Donnelly
Donnelly, Conroy & Gelhaar, LLR
One Post Office Square
Boston, MA 02109-2105
(617) 542-7400

Attorneys for Defendants
Herb Reed, John Villano and JP Productions, Inc.

1. My name is Herb Reed. I reside in Arlington, Massachusetts. I am a musical entertainer and performer.

2. I began singing in the 1940's, when I was around 14 years old. I sang in a church choir and other groups.

3. Around 1950, I enlisted in the United States Army. I was in a tank battalion. I learned discipline and organization. Eventually, I was in charge of twelve men. As a young man from a broken home, my Army duty was an excellent experience for me.

4. During my military service, I sang in the Army

choir. My military service ended in late 1952, around November 1952, I believe.

5. In 1953, I organized, founded and named the musical group The Platters. The circumstances were as follows: In early 1953, around February or March 1953, I was living in Los Angeles. A man named Alex Hodge came over to meet a young lady who was living in the same house I was in at the time. As he was waiting for her, Alex Hodge and I began talking about what we did, what we liked to do. I mentioned singing. Alex Hodge said he was interested in singing also. I told Alex Hodge that I particularly enjoyed singing harmonies, that I had been in the Army choir, and was looking for some fellows to sing with. A little later, Alex Hodge and I got together with Joe Jefferson and Cornell Gunther, who also enjoyed singing harmonies. We sang together informally, harmonizing songs I liked. I decided' to name the group, and I chose the name "The Platters." A copy of promotional material issued by Mercury Records in the 1950s describing my role as originator of The Platters is attached hereto as Exhibit 1.

6. I have been providing musical entertainment using the mark "The Platters" from 1953 through the present. The history of my continuous use of the mark "The Platters" follows in this affidavit.

. . .

and supposed relinquishment of ownership of such rights were fraudulently obtained, not understood and ineffective.

44. I have been informed and believe that Federal courts in California have determined that Mr. Ram (who is now deceased) and The Five Platters, Inc. have no rights to the mark "The Platters. "

45. In 1969, I discontinued my relationship with Mr. Ram and The Five Platters, Inc. A copy of my resignation letter dated July 28, 1969, is attached hereto as Exhibit 25. Certainly since that time, my performances as The Platters, and as Herb Reed and The Platters, were not under the authority of the Five Platters, Inc. The Five Platters, Inc. has no authority over me and has been found to have no rights whatsoever in the mark "The Platters."

46. From 1969 to the present, I have personally performed using the mark "The Platters" and "Herb Reed and The Platters."

47. Throughout the 1970's I performed using the name and mark "The Platters."

48. In 1971 I appeared with The Platters at The Peppermint Lounge in New York City. Attached as Exhibit 26 is a photograph that was taken at that time. I appear second from the left in the photograph.

49. In December 1970 I performed, using the name "The Platters" at a club in Boston known as Lucifer's. Attached hereto as Exhibit 27 is a portion of an article that appeared in have as a souvenir of the performance, is attached hereto as Exhibit 37.

. . .

62. In 1984, The Five Platters, Inc. sued me in Federal court in Florida. Under a settlement agreement between the parties reached in November 1987, I was permitted to perform using the name "Herb Reed and The Platters." I conditionally agreed not to use the name "The Platters by itself unless the Five Platters, Inc. were found to have no rights in such name. In fact, as stated above, such condition has occurred -- Federal courts in California have determined that The Five Platters, Inc. has no rights in the name "The Platters."

63. In October 1985, I performed using the mark "The Platters" in Swansea, Massachusetts. Attached hereto as Exhibit 38 is a letter dated October 23, 1985 confirming the appearance. I received a copy of the letter around October 23, 1985.

64. On August 15, 1986, I performed in Middletown, Rhode Island at the Strike Zone under the name "Herb Reed and The Platters." A copy of a ticket to the performance, confirming my appearance, is attached hereto as Exhibit 39.

65. On December 22, 1986, I performed under the name "The Platters" at Cortina's Astrodome in Canada. A copy of an article regarding the performance is attached hereto as Exhibit 40. The article appeared in the December 23, 1986 edition of The Nugget. I appear on the far left of the photograph in the article.

66. On August 19, 1987, I performed at Boston City Hall Plaza under the name "Herb Reed & The Platters". A copy of the

. . .

93. Without authority from me, Martha Robi has organized, promoted and sold performances by at least three separate musical groups named "The Platters." None of these groups include any members of The Platters formed by me in 1953. Robi's actions have occurred nationwide, including in New York.

94. I learned in 1995 that on June 28, 1989, Martha Robi filed with the United States Commissioner of Patents and Trademarks an application to register the mark "The Platters" for musical entertainment services and phonograph records, compact disks, and tapes. Martha Robi's application was based on her false declaration in which she falsely swore that she had exclusive rights to use the mark "The Platters" and that she first used the mark in 1954. A copy of Martha Robi's Declaration is attached hereto as Exhibit 66. Martha Robi subsequently abandoned her registration application.

95. Earlier this year, I learned that on February 18, 1994, Martha Robi again filed with the Commission of Patents and Trademarks an application to register the mark "The Platters" for musical entertainment services and related goods. Her application was again based on the same false declarations including her swearing that she first used the mark in 1953-1954. A copy of Martha Robi's application was

published in the Patent and Trademark Office Official Gazette on June 13, 1995. Thereafter, on July 7, 1995, I filed a timely opposition to the mark. I have been informed that opposition proceedings have been stayed pending the outcome of this case.

. . .

a position to cancel this appearance. I have spent substantial sums for attorneys' fees and costs necessary to protect my right to "The Platters" mark including with respect to this lawsuit, the New York suit and the PTO proceedings. I must perform at every opportunity to generate income to pay my lawyers and my other expenses. I apologize to the Court for my inability to appear at the hearing on May 14, 1996, but to do so would cause me extreme financial hardship.

102. An order prohibiting me from using the name or mark "The Platters" would destroy my ability to earn a living. For more than 42 years, I have used "The Platters" mark to sell my services as a musical entertainer. Without the use of that mark, I would be unable to obtain any substantial work as an entertainer. Consequently, I would be financially ruined.

SIGNED UNDER PAINS AND PENALTIES OF PERJURY THIS 7 DAY OF MAY, 1996.

/s/_____
Herb Reed

APPENDIX Z

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed September 27, 1999]

Case No. CV-S-95-01029-LDG (LRL)

MARTHA ROBI, an individual *Plaintiff,* vs. HERB REED, an individual, dba/ Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; JP PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a California Corporation, *Defendants.*	)

AFFIDAVIT OF ALLEN HYMAN
IN OPPOSITION TO THE MOTION
FOR THE PROTECTIVE ORDER

District Court of Nevada - 9/27/99
Affidavit of Allen Hyman (Partial)

TO BE SUBMITTED TO THE HONORABLE UNITED STATES MAGISTRATE JUDGE LAWRENCE R. LEAVITT
(Partial)

ALLEN HYMAN, ESQ.
LAW OFFICES OF ALLEN HYMAN
12001 Ventura Place, Suite 501
Studio City, California 91604-2626
(818) 763-6289 or (213) 877-3405

AVIVA Y. GORDON, ESQ.
MAHAN AND ELLIS CHARTERED
510 South Ninth Street
Las Vegas, Nevada 89101
(702) 385-3727

Attorneys for Plaintiff and Counter-Defendant
MARTHA ROBI

I, Allen Hyman, hereby declare as follows:

1. I have personal knowledge of the facts set forth in this affidavit and could and would competently testify if called upon to do so.

2. I am one of the attorneys for Plaintiff' and Counsel

. . .

Nos. 3, 4, 5, and 6, in which Plaintiff misquotes a portion of the Counter-Claims. With regard to all of the remaining first eight-six (86) requests, Defendants' only response to the first eighty-six (86) requests was that ". . . Defendants will produce the documents with Donnelly, Conroy & Gelhaar at Suite 3350, Boston, Massachusetts, that are non-privileged documents subject to the Requests."

18. Yet Defendants have not produced any of the documents they asserted they would produce or indicated when they would make the production available.

19. As well, Defendants have not provided a listing of privileged documents.

20. With regard to Request Nos. 87 to 102, these requests also go to and request documentation pertaining to Herbert Reed's activities as "The Platters."

21. Apparently Herbert Reed agreed to an Injunction prohibiting him from performing as "The Platters" in 1969, and they entered into a Settlement Agreement with "The Five Platters, Inc." where he agreed not to use the name of "The Platters," and from 1974 to 1990 apparently did not utilize the name. REED has not produced his Agreement with The Five Platters, Inc., or documents pertaining to activities with The Five Platters, Inc.

22. Plaintiffs have requested documentation in Request Nos. 84, 95, 101 and 102 pertaining to there matters, REED has not produced this documentation.

23. As well I have set froth in Plaintiff's discovery plan the matters and items and witnesses to be called of those who have knowledge pertaining to REED. These individuals include Zol

. . .

Recording Contracts and jointly owned and acted as partners, share alike all income and expenses, and acted as joint owners of the Trademark, "The Platters." This information will be obtained through the documents of "The Five Platters, Inc.," the deposition of Zola Taylor, Herbert Reed, A1 Fraizure, Helen Williams and the wife of the road manager, the deposition of Herbert Reed, and the deposition of The Five Platters, Inc.

29. Plaintiff will then demonstrate that there was no dissolution of the partnership or winding up the partnership affairs.

30. Plaintiff will then demonstrate that REED undertook for a period of six (6) years during the period of 1963 to 1969, acts inconsistent with his duties as a partner. Plaintiffs will demonstrate that REED undertook to assist others to attempt to stop his partners from performing as "The Platters," that REED engaged in unlawful conduct with regard to assisting "The Five Platters, Inc." to support improper performances as "The Platters," that REED undertook to enter into recording agreements with Muscior and other companies where by he earned income from recordings of purported "Platters" records, which in fact were not records of "The Platters" and which competed with his partners

recordings and those of the other four (4) original Platters. Plaintiff will demonstrate that REED under legal actions assisting others in attempts to stop and deny his partners their rights in the trade name "The Platters."

a) To undertake and gather this information, Plaintiff requires the Deposition of REED, the documents requested from REED the Deposition and Documents requested from "The Five Platters, Inc.," the Deposition of Jean Bennett, Helen Williams, Zola Taylor, and possibly others. Plaintiff also may require a Deposition of Mercury recordings, and a search of archival records in Chicago which will demonstrate Herb Reed's participation in activities against his partners.

31. Plaintiff will then demonstrate that REED undertook to enter into stipulations where he agreed not to utilize the name "The Platters" for a period of twenty (20) years.

a) This inquiry will required the REED to produce' the documents requested, and the depositions of those identified.

32. Plaintiff will then demonstrate that REED has been undertaking to sponsor and promote "low level" group, that does not provide quality performances, that has undertaken to harm the name of "The Platters" and their goodwill.

a) This inquiry will require REED to produce his documents, and then to undertake depositions of certain

promoters and bookers, and to undertake the depositions of REED and the other Defendants.

33. Plaintiff then will establish that if REED's rights have been revived, those were the rights he had as a partner with the other Platters, to which he attempted to harm and inhibit, and that he must pay contribution to Martha Robi, the wife of Paul Rob who inherited his partnership interest for all of her expenses and costs and ROBI's expenses and costs with regard to the enforcement of the partnership rights.

a) This evidence required will be that of the Deposition of REED and the documents requested and the other discovery set forth in this affidavit.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Affidavit was executed this 26th day of September, 1996, at Studio City, California.

/s/_____
Allen Eyman

State of California)
) SS:
County of Los Angeles)

On 9/26/96, before me Kimberly A. Monti, a notary public in and said State, personally appeared Allen Hyman, personally known to me to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity(ies), and

that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

/s/_____
Kimberly A. Monti

APPENDIX AA

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed October 10, 1996]

CV-S-95-1029-LDG- (LRL)

MARTHA ROBI,
Plaintiff(s),

vs.

HERB REED, ET AL,
Defendant(s).

MINUTES OF COURT

PRESENT: THE HONORABLE LAWRENCE R. LEAVITT, UNITED STATES MAGISTRATE JUDGE

DEPUTY CLERK: ANITA F. MOORE RECORDER/TAPE#: 96-1-120.121

COUNSEL FOR PLAINTIFF: AVIVA Y. GORDON, ALLEN HYMAN

COUNSEL FOR DEFENDANT: ELAYNA J. YOUCHA, T. CHRISTOPHER DONNELLY (by phone)

Court convenes: 3:00 p.m.

PROCEEDINGS: SCHEDULING CONFERENCE

Attorney Hyman, counsel for plaintiff, presents his arguments regarding the Motion for Summary Judgment, to the Court, with rebuttal statements presented by attorney Youchah.

IT IS ORDERED that defendant's Motion for Protective Order is GRANTED and discovery is STAYED pending resolution of the Motion for Summary Judgment.

IT IS FURTHER ORDERED that plaintiff's Motion for Continuance of the Discovery Period (#91) is DENIED.

Court adjourned: 4:15 p.m.

LANCE S. WILSON, CLERK
U.S. DISTRICT COURT

By: /s/_____
DEPUTY CLERK

APPENDIX BB

ASSIGNMENT OF TRADEMARK

WHEREAS PAUL ROBI of 13135 Mindanao Way, No. 2, Marina Del Rey, California, has for the past thirty-three years (33) adopted, used, and is using a trademarks known as "the Platters" of "The World Famous Platters" or "Paul Robi's World Famous Platters" or "Paul Robi's Platters", and WHEREAS these trademarks are the subject of litigation in US District Court in which PAUL ROBI has requested Federal Court ordered assignment in the US Trademark office of these trademark The Platters and WHEREAS MARTHA ROBI of 13135 Mindanao Way, No. 2, Marina Del Rey, California, is desirous of acquiring these trademarks, and all common law and statutory rights that PAUL ROBI may have, now therefore, for good and valuable consideration, receipt which is hereby acknowledged, PAUL ROBI does hereby assign to Martha Robi all his right, title, and interests in and to the trademarks "The Platters", "The World Famous Platters", "Paul Robi's Platters", and "Paul Robi's World Famous Platters", together with the goodwill and the business symbolized by these trademarks.

Dated: November 9, 1988 /s/_____

PAUL ROBI

Dated: November 9, 1988 /s/_____

MARTHA ROBI

STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

On this 9th day of November, 1988, before me the undersigned, a Notary Public in and for said County and State, personally appeared Paul Robi, personally known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to the within instrument and acknowledge that he executed the same.

/s/_____
Betty Hawkins

APPENDIX CC

DRAFT

July 12, 1968

American Guild of Variety Artists
National Headquarters
110 West 57th Street
New York, New York

Gentlemen:

We must again protest against your allowing numerous groups (representing themselves as The Platters) to work and profit on the prestige of our name.

On several occasions in the past we have written you requesting the protection, which is rightfully ours under the bi-laws and rules governing A.G.Y.A., but you have refused to become involved.

The group headed by Zola Taylor and Paul Robi, who have been billing themselves as The Platters or the Original Platters, have been listed the past two years on A.F.O.M.'s unfair list because they refused to pay a musician who accompanied them to Japan. Listed on the unfair list as The Platters we are suffering unfair and unwarranted damage and embarrassment to our name and its personnel. We feel you

should assist us in getting the individuals listed on The Platters name removed from this list by verifying that Herbert Reed is the only original Platter and his membership dates back to 1955-56, and so long as there is one original member with the group that originally joined that group retains rights to the name and no other group can be registered as such.

I am enclosing a picture and publicity write up which gives the correct membership of The Platters, and we would appreciate your making the necessary changes in your membership records.

Please give us your support.

Sincerely,

THE FIVE PLATTERS, INC.

Herbert Reed
President

Jean Bennett
Resident Agent

JB/dr

cc: A.G.V.A. - Los Angeles office

Supreme Court, U.S.
FILED
SEP 15 1999
OFFICE OF THE CLERK

No. 99-363

In The

Supreme Court of the United States

MARTHA ROBI,

Petitioner,

v.

HERBERT REED, JOHN VILLANO, J.P. PRODUCTIONS,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

T. CHRISTOPHER DONNELLY
Counsel of Record
DONNELLY, CONROY & GELHAAR, LLP
One Post Office Square
Boston, MA 02109-2105
(617) 542-7400
Counsel for Respondents

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

PARTIES TO THE PROCEEDING

Petitioner has accurately identified Martha Robi ("Robi") as petitioner and Herb Reed ("Reed") and John Villano ("Villano") as respondents. The third respondent identified by petitioner, "J.P. Productions" is not a juridical entity. In the lower courts and herein, the third respondent (defendant and counterclaim plaintiff) was and is John P. Productions, Inc. ("JPPI"), a corporation that has no parent companies or subsidiaries.

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CONSTITUTIONAL PROVISIONS AND STATUTES

Petitioner has presented the text of the Supremacy Clause and Commerce Clause, but nowhere argues that the Ninth Circuit decision conflicts with or even implicates those provisions.

The pertinent text of the California partnership statute, Cal. Corp. Code §§ 15029, 15038 and § 15043, is set forth at page 20 below.

STATEMENT OF THE CASE

The petition for a writ of certiorari filed by Robi – who has been represented by counsel throughout, but now purports to appear "in pro se"[1] – concedes by its

[1] In the district court and court of appeals Robi has been and still is represented by Allen Hyman. On July 14, 1999, in support of Robi's motion in the Ninth Circuit to stay issuance of the mandate, Attorney Hyman declared under penalty of perjury: "Our office has completed a draft of the Petition for a Writ of Certiorari to the United States Supreme Court for Martha Robi." He further reported that Robi had "associated the law firm of Pepper & Corazzini [in Washington, DC] to consult and assist with the preparation of [the petition]" and that firm was undertaking a review of and providing their input into the initial draft. On August 11, 1999, in support of a further stay of the mandate, Attorney Hyman said Robi's petition was complete but "Allen Hyman, counsel for Appellant Robi, has been required to be away from his offices on unanticipated mandatory legal matters, and has been unable to proofread, finalize, and duplicate the Petition for a Writ of Certiorari to the United States Supreme Court for filing and service." On August 26, 1999, Attorney Hyman, as counsel to Robi, notified the Ninth Circuit that the petition for a writ of certiorari had been filed.

silence the absence of any reasons identified in Rule 10(a) for granting the writ. The ruling does not conflict with a decision of another United States court of appeals, it does not involve an important federal question that conflicts with a decision by a state court of last resort, and there is no call for this Court to exercise its supervisory powers. At most, Robi is claiming the circuit court misapplied settled rules of law concerning issue preclusion and partnership. There is no basis for granting Robi's petition and, as shown below, the lower court's decision was correct.

Robi's statement of the case (Pet., at 3-15) is replete with misstatements and, in addition, relies extensively on matters that were not properly before the district court or the court of appeals and, thus, cannot be considered by this Court. As detailed below, items F, K, L, M, N, O, Q, R, U, BB and CC in Robi's Appendix ("App.") were not part of the summary judgment record and, therefore, are not properly before this Court. In light of the admonition in Sup. Ct. R. 15.2 regarding possible waiver of misstatements not identified in opposition to a petition for a writ of certiorari, respondents present the following accurate statement of the case:

On September 7, 1999, Attorney Hyman forwarded to respondents the notice required by Sup. Ct. Rule 12.3. Obviously, Robi is not without counsel and, therefore, should not receive any of the indulgences sometimes accorded *pro se* litigants. *See O'Reilly v. New York Times Co.*, 692 F.2d 863, 868 (2d Cir. 1982); *Ellis v. State of Maine*, 448 F.2d 1325, 1328 (1st Cir. 1971); *Johnson v. Bd. Of County Com'rs*, 868 F.Supp. 1226, 1231 (D. Colo. 1994), *aff'd*, 85 F.3d 489 (10th Cir. 1996).

Nature of the Case

This case is a contest between Reed and Robi for exclusive rights to perform under the service mark "The Platters". Reed is a musical performer who, in 1953, named and founded The Platters singing group and first performed under "The Platters" mark. Reed used the mark extensively in public performances and, by early 1954, had further used and commercialized the mark to the point of recording songs. Reed is the only original member of The Platters who is still providing musical entertainment services. Robi, who did not enter the United States until 1958, has *never* personally performed using the mark "The Platters." She had nothing to do with Herb Reed's origination and use of the mark, and she did not use the mark in any respect until 1988. She claims exclusive rights to "The Platters" service mark through her status as widow of Paul Robi, who joined The Platters approximately a year after Reed formed and named the group, who left the group in 1965 after his arrest and who died in 1989.

Course of Proceedings

The pleadings

In late 1995, Robi filed suit against Reed, Villano, JPPI and others.[2] Claiming to have exclusive rights to the mark "The Platters", Robi proceeded on theories of

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[2] Robi never served defendant The Five Platters, Inc. ("FPI"), and she settled with the three other defendants (Tony Cee Associates, Cuzin Richard Entertainment Associates, and United Concert Productions Corp.).

declaratory relief, unfair competition under 15 U.S.C. § 1125(a) and a Nevada statute, slander of title and interference with economic relations. (CR 1[3]). Reed, Villano and JPPI denied Robi's allegations and filed a six count counterclaim against her. (CR 69). Reed alleged that he has exclusive rights to "The Platters" mark and, accordingly, Robi is liable to him, Villano and JPPI for violations of 15 U.S.C. § 1125(a), interference with contractual and prospective relations, fraudulent application for and receipt of state service mark registrations, and unfair competition, deceptive trade practices and false advertising in violation of Nevada statutes and the common law.

The summary judgment proceedings

In April 1996, the district court denied Martha Robi's motion for a temporary restraining order (CR 37) and in August 1996 it denied Robi's preliminary injunction motion, concluding in a seven page order that "plaintiff has not demonstrated a likelihood of success on the merits." (CR 83).

On September 17, 1996, Reed and the other respondents moved for summary judgment. (CR 87). They expressly relied on the affidavit of Reed and exhibits thereto (App. Y (partial); *see* CR 56). On October 4, 1996, Robi filed her opposition to the summary judgment motion (CR 97). Robi elected not to submit any opposing affidavits, instead relying exclusively on legal arguments. She cited no cases other than *Robi v. Five Platters, Inc.*, 838

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[3] "CR" refers to the district court clerk's record, i.e., the number from the docket sheet.

F.2d 318 (9th Cir. 1988) and 918 F.2d 1439 (9th Cir. 1990). In addition, in her counter-statement of facts that she contended were in dispute, Robi attempted to dispute only four facts asserted in Reed's summary judgment motion. (CR 98A). Thus, she effectively conceded all other facts in Reed's summary judgment motion.[4]

Later, weeks after the deadline for opposing the motion had passed, Robi filed additional papers, purportedly in further opposition to appellees' summary judgment motion. Reed opposed the supplemental filings. (CR 123). Well within its discretion, the district court denied Robi leave to file her out-of-time supplemental papers. (CR 140).

Along with their motion for summary judgment, Reed, Villano and JPPI filed on September 17, 1996 a motion for protective order, seeking a stay of all discovery pending decision on summary judgment. (CR 86). Robi opposed the protective order motion (CR 90) and moved to continue her summary judgment opposition in order to obtain discovery (CR 91). The magistrate judge to whom all discovery matters had been referred pursuant to 28 U.S.C. § 636(b)(1)(A) granted Reed's protective order motion and denied Robi's motion for discovery. (CR 101). Robi subsequently filed with the

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[4] Local Rule 56.1 of the Nevada district court provided: "Motions for summary judgment *and responses thereto shall* include a concise statement setting forth each fact material to the disposition of the motion which the party claims is or is not genuinely in issue, citing the particular portions of any pleading, affidavit, deposition, interrogatory, answer, admission, or other evidence on which the party relies." (Emphasis added).

district judge objections to the discovery rulings, pursuant to 28 U.S.C. § 636(b)(1)(A). (CR 107). The district court denied Robi's objections. (CR 140).

While the summary judgment motion was under advisement, on February 24, 1997, Robi requested the district court to take judicial notice of FPI's bankruptcy filing. (CR 137). Reed, Villano and JPPI opposed. (CR 138). The district court denied Robi's request. (CR 140).

By Order dated September 29, 1997 (App. C; CR 140), the district court granted summary judgment. It ruled that (1) all original members of a musical group who created its goodwill have collective ownership of the service mark rights in the group's name, (2) such members do not take such rights with them when they leave the group and (3) the last remaining original member who carries on the group continues ownership of the service mark rights. The court concluded that "[s]ince Reed was the original member who remained with The Platters as the others left, it is Reed who now owns the exclusive right to the mark The Platters." The court also ruled that even if Paul Robi had retained some individual right to "The Platters" mark when he left in 1965, that right would have been personal to him and therefore could not be assigned to Martha Robi and ceased upon his death in 1989. In accordance with 15 U.S.C. § 1116(a) and well-settled case law, e.g., *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1180 (9th Cir. 1988), the district court entered a judgment permanently enjoining Robi, her agents, servants, employees, attorneys, and persons in active concert or participation from using in any manner the mark "The Platters" alone or in conjunction with any other names or words. (CR 141). The court also

ordered cancellation of Robi's state registrations, destruction of all goods bearing "The Platters" mark, and an assessment of damages. (*Id.*).

On October 1, 1997, Robi filed a notice of appeal. (CR 142).

Robi's post-judgment motions

Although none of Robi's post-judgment motions were properly before the court of appeals for review, Robi has attempted to supplement the summary judgment record by relying on post-judgment materials in her brief to this Court. Thus, the following summary is provided, but without waiver of Reed's contention that the court of appeals lacked and this Court lacks jurisdiction over the post-judgment matters.

On October 8, 1997, the district court denied Robi's motion for a temporary stay of the injunction against her use of "The Platters" mark, ordered her not to book any future engagements, and stayed only the destruction and cancellation of state registrations portions of the injunction. (CR 148).

On October 14, 1997, Robi moved pursuant to Fed. R. Civ. P. 59(e) to vacate, alter or amend the judgment and order, (CR 154). The district court denied the motion, reiterating its ruling that Robi's reliance on prior decisions adverse to FPI to show Paul Robi's right precludes her from avoiding those same rulings when it comes to Reed. (Tr. 10/27/97, pp. 28-32).

Later, Robi requested the district court to take judicial notice of certain documents from a case between

Reed and FPI in the Southern District of Florida. (CR 162). Although Reed had identified that case at the outset of the present action (in December 1995) (CR 8B), Robi made no effort to present the Florida papers until *after* judgment was entered by the district court. Well within its discretion, the district court denied the request for judicial review. (Tr. 10/27/97, pp. 32-33). Robi did not appeal from that denial.

The court of appeals rulings

In December 1997, Robi filed with the court of appeals various motions to stay, for an injunction and for expedited briefing and a request for judicial notice. By Order dated January 26, 1998, the Ninth Circuit denied the motions and granted the request for judicial notice. (App. B).

On April 2, 1999, the Ninth Circuit affirmed the district court's permanent injunction, holding that Reed "retains the right to use of the service mark ['The Platters'] to the exclusion of Robi." *Robi v. Reed*, 173 F.3d 736, 740 (9th Cir. 1999); App. A, 8a.

Ongoing proceedings in the lower courts

In the district court, Robi objected to production of damages documents and information, requiring Reed, Villano and JPPI to file a motion to compel, which the district court granted. After Robi's non-compliance, in June 1999 the district court found Robi in contempt. A hearing to assess damages is scheduled for October 4, 1999.

Under advisement in the court of appeals is Reed's application for attorney's fees pursuant to 15 U.S.C. § 1117(a) and Nevada Revised Statutes 598A.210. Also pending is the Ninth Circuit's order directing Robi's counsel to show cause why he should not be responsible for a portion of Reed's appellate counsel fees, pursuant to 28 U.S.C. § 1927, for unreasonably and vexatiously multiplying those proceedings.

Statement of Facts

Set forth below are the essential facts that were properly before the district court when it ruled on summary judgment. Many of the factual assertions included in Robi's petition appeared in affidavits and exhibits that were filed late, in violation of court rule. The district court properly refused consideration of those pleadings. (CR 140). Robi did not challenge that ruling in the court of appeals. The alleged facts that are based on those stricken materials (CR 109-120) cannot be considered by this Court. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157-58, n.16 (1970); *Harkins Amusement Enterprises, Inc. v. General Cinema Corp.*, 850 F.2d 477, 482 (9th Cir. 1988), *cert. denied*, 488 U.S. 1019 (1989). Other factual assertions were presented only in Robi's post-judgment papers (CR 154, 157, 158, 159, 162, 164, 165, 169) and, again, are not properly before this Court. *Adickes*, 398 U.S. at n.16; *Columbia Pictures Industries, Inc. v. Professional Real Estate Investors, Inc.*, 944 F.2d 1525, 1527 & n.3 (9th Cir. 1991), *aff'd*, 508 U.S. 49 (1993). Still others are drawn from testimony and exhibits presented by Robi at the preliminary injunction hearing. Because that testimony and all but a few of the exhibits were not referenced in Robi's

summary judgment opposition, those materials and the factual assertions founded on those materials are also not properly before this Court on review of the district court's summary judgment grant. *Id.*; *Harkins*, 850 F.2d at 482; *National Industries, Inc. v. Republic Nat. Life Ins. Co.*, 677 F.2d 1258, 1270 (9th Cir. 1982).

In sum, the only materials Robi properly placed before the district court in opposition to summary judgment are an opposition brief that cited only two cases (CR 97), a statement challenging only four of Reed's undisputed facts (CR 98A), and five exhibits referenced in Robi's opposition (only two of which are included in Robi's Appendix – App. G&P).

Since Reed organized and named the musical group "The Platters" in 1953, he has earned his living by singing and performing under that name. (HR Aff.,[5] ¶¶ 5-92; DX 1-65). When Reed formed the group in 1953, The Platters were himself, Joe Jefferson, Alex Hodge and Cornell Gunther. In 1954, Jefferson and Gunther ceased performing with Reed, and David Lynch and Tony Williams began performing with Reed and Hodge as The Platters. After they recorded several songs together as The Platters, Zola Taylor joined them as part of the ensemble. (HR Aff., ¶¶ 5-19; DX 1-5).

Paul Robi began performing with Reed as a member of The Platters in August or September 1954, when he

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[5] "HR. Aff." refers to the Affidavit of Herb Reed, sworn to May 7, 1996, submitted in support of Reed's summary judgment motion. "DX" refers to Defendants' Exhibits attached thereto. A portion of Reed's affidavit, without the exhibits, appears at App Y.

replaced Hodge. Around 1957, Martha Robi (then using a different surname) and Paul Robi met one another. (HR Aff. ¶¶ 18-22).

Martha Robi, who is not a musical entertainer, *never* performed with The Platters. (*Id.* ¶ 23). Her use of the mark began in 1988, as a promoter and producer, around the time of Paul Robi's death and 35 years after Herb Reed's first use. (Tr. 5/14/96 (afternoon session), at 54).[6]

Reed is the only original member of The Platters who is still personally performing musical entertainment. (HR Aff., ¶ 21). Gunther, Hodge, Lynch, Williams, and Paul Robi are all deceased. (*Id.* ¶¶ 11, 20).

In the 1950s, Buck Ram became the manager of The Platters, and wrongfully induced Reed, Williams, Lynch, Taylor and Paul Robi to purportedly assign to a supposed corporation called The Five Platters, Inc. ("FPI") all of their rights to the mark "The Platters." (*Id.* ¶¶ 43-44). Those assignments were subsequently deemed ineffective. *See Robi*, 918 F.2d at n.2, in which the Ninth Circuit affirmed the trial court's adoption of findings that FPI "was a sham used by Ram to obtain 'The Platters' name"; that "the FPI stock was issued to the group members illegally"; and that "the members received nothing for their interest in 'The Platters' name".

In 1965, Paul Robi was arrested for possession of illegal narcotics; the charges resulted in a felony conviction. (HR Aff. ¶ 36; DX 19). He severed his relationship with Reed, and he ceased any musical performances with

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[6] Robi's testimony at the preliminary injunction hearing was referenced in Reed's summary judgment motion (CR 87).

Reed and The Platters group which had comprised Reed, Paul Robi, Williams, Lynch and Taylor. (*Id.*). Thereafter, without authority from Reed, Paul Robi performed with others under various names, including "Paul Robi's Platters", "The World Famous Platters", and "Paul Robi's World Famous Platters". (*Id.*).

In 1969, Reed discontinued his relationship with Ram and Ram's sham corporation, FPI. Reed continued performing under "The Platters" mark and, later, under that mark joined with his name. Reed has continuously provided musical entertainment using the mark "The Platters" and "Herb Reed and The Platters." None of those performances have been under the authority of FPI. (HR Aff. ¶¶ 45-46; DX 25).

After Reed disassociated himself from Ram and FPI, that sham corporation sought to prevent Paul Robi from using the mark "The Platters." A California state court ultimately determined that FPI had no right to stop Paul Robi from using "The Platters" mark, as the purported "assignments" from the performers were fraudulently obtained by FPI and, therefore, invalid. (App. G). A federal district court in California reached the same conclusion. *Robi*, 918 F.2d at 1441. While on appeal, Paul Robi died and Martha Robi was substituted by agreement as a party. *Robi*, 918 F.2d at n.1. At the time of the substitution, however, no court adjudicated or even considered whether Paul Robi's personal service rights, if any, in "The Platters" mark could be assigned to a non-performer or anyone else. The Ninth Circuit ultimately affirmed the money judgment against FPI and affirmed cancellation of all "The Platters" marks held by FPI. *Robi*, 918 F.2d at 1441. The Ninth Circuit did not, however, rule

that *Martha Robi* had any performance rights (or any other rights) to "The Platters" mark.

Earlier, in 1987, FPI and Reed had settled a suit in the Southern District of Florida by agreement under which Reed retained the right to perform as "Herb Reed and The Platters" and conditionally agreed not to use the name "The Platters" by itself unless FPI were found to have no rights in the name. (HR Aff., ¶ 62).[7] That condition in fact occurred when the California federal court confirmed that FPI was a sham and canceled its marks – a decision affirmed by the Ninth Circuit. *Robi*, 918 F.2d at 1441.[8]

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[7] The settlement agreement itself (App. K) was not in the record at the time of the district court's ruling. Only after entry of judgment did Robi seek to present that document (CR 162). The district court properly declined consideration of the document, denying Robi's judicial notice request. Robi never appealed that denial. Therefore, the document is not part of the record that should be considered in assessing the lower court's injunction ruling. *E.g.*, *Adickes*, 398 U.S. at n.16; *Columbia Pictures*, 944 F.2d at 1527, n.3; *Harkins*, 850 F.2d at 482.

[8] The April 1, 1975 "Agreement" on which Robi now attempts to rely (App. Q) is not signed by all the purported parties and, in any event, expires by its own terms when litigation commenced – which in fact occurred in Florida federal court. The document also provides that Reed was not waiving or prejudicing his ownership of "The Platters" name. In addition, Robi did not bring the document to the district court's attention until after judgment was entered against her. (CR 162). The district court refused to take judicial notice of it. Thus, the document is among those with which Robi improperly attempted to supplement the record, and the document may not be considered. *Adickes*, 398 U.S. at n.16; *USA Petroleum Co. v. Atlantic Richfield Co.*, 13 F.3d 1276, 1279 (9th Cir. 1994); *Columbia Pictures*, 944 F.2d at 1527, n.3.

Since Paul Robi's death in 1989, Robi has waged an unlawful campaign to misappropriate Reed's mark "The Platters" and to dilute the economic value of that mark to Reed. Without authorization from Reed, Robi has promoted, produced and sold performances of singers she bills as "The Platters." These counterfeit groups do not include any former members of the original group The Platters. Robi has operated as many as three of these groups simultaneously around the country. (HR Aff. ¶ 93).

In furtherance of her unlawful scheme, Robi and her agents have falsely informed customers and potential customers of Reed that he has no right to use the name "The Platters" or "Herb Reed and The Platters", and that she has the rights to the mark "The Platters." (DX 67-68; HR Aff. ¶ 96). Robi has falsely asserted to Reed's customers and potential customers that she has a federal registration for "The Platters" mark. (*Id.*). In addition, she fraudulently obtained several state registrations. Robi's actions have severely damaged Reed, reducing the number of his performances and the prices he can charge. (HR Aff. ¶ 97).

Robi also filed two applications in the United States Patent and Trademark Office ("PTO") seeking registration of the mark "The Platters," falsely declaring in both that she was the owner of the mark and that no other person has the right to use the mark. (DX 66; HR Aff. ¶¶ 94-95). Robi also falsely claimed that she first used the mark in 1956 (later changed to 1953-1954), before she had even met Paul Robi. (*Id.*). Robi ultimately abandoned her first application, and her second application is the subject of a pending PTO opposition proceeding commenced by

Reed. (*Id.*). (The PTO has stayed the opposition proceedings pending resolution of this case.)

None of the above facts concerning Robi's false statements to the PTO, to Reed's potential customers and to the consuming public were refuted by Robi in her summary judgment opposition. (CR 97, 98A).

Reed was never a party to any of the litigation between Paul Robi and FPI, and prior to the Nevada district court's ruling no court had ever adjudicated Paul Robi's rights vis-a-vis Reed to the mark "The Platters." From the time Paul Robi left The Platters in 1965 until his death in 1989, he never claimed that Reed was barred from using "The Platters" mark or that Reed had cheated him as a partner.

ARGUMENT – REASONS FOR DENYING THE WRIT

I. THE DECISION DOES NOT CONFLICT WITH A DECISION OF ANOTHER CIRCUIT COURT OR STATE COURT OF LAST RESORT

Robi's petition does not satisfy any of the criteria (guiding but not wholly controlling) set forth in Sup. Ct. R. 10(a). Robi does not contend the Ninth Circuit decision conflicts with the decision of another circuit court or conflicts with the decision by a state court of last resort concerning an important federal question.

Although far from clear, insofar as Robi may be claiming the Ninth Circuit decision conflicts with other decisions of the *same* circuit court, discretionary review by this Court is not appropriate. *See, e.g., Davis v. United*

States, 417 U.S. 333, 340 (1974). Notably, the Ninth Circuit denied Robi's petition for rehearing en banc.

II. THE PRECLUSION ISSUE NOW RAISED IN QUESTION 1 WAS NOT RAISED IN ROBI'S OPENING BRIEF IN THE COURT OF APPEALS AND RELIES ON MATTERS NOT BEFORE THE LOWER COURT

In her first "question presented", Robi contends the court of appeals misapplied claim and issue preclusion principles in failing to give effect to a conditional 1987 settlement agreement between Reed and FPI. Robi never raised this issue in her opening brief in the court of appeals. Robi's failure to raise the issue is confirmed by the fact that her opening brief never cited *Parklane Hosiery Co., Inc. v. Shore*, 439 U.S. 322 (1979); *Brown v. Felsen*, 442 U.S. 127 (1979); or *Erie R. Co. v. Tompkins*, 304 U.S. 64 (1938), the three Supreme Court cases on which she relies in her petition. Not surprisingly, the Ninth Circuit decision did not undertake any lengthy preclusion analysis, merely ruling *sub silentio* that Robi was bound by the findings favorable to Paul Robi (petitioner's assignor) made in a 1974 lawsuit with FPI and in subsequent federal cases, *see Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988) and 918 F.2d 1439 (9th Cir.1990) – including the fact that the purported assignments by Reed, Paul Robi and other performers were ineffective.

It is well settled that this Court will not grant certiorari or otherwise consider issues that were not pressed before or considered by the court of appeals. *Pa. Dept. of Corrections v. Yeskey*, 524 U.S. 206 (1998); *United States v.*

Williams, 504 U.S. 36, 41-44 (1992); *Adickes*, 398 U.S. at 147 n.2.

An additional reason for not considering petitioner's first question is its central reliance on a document not before the district court on summary judgment and not properly before the court of appeals. Robi did not submit the 1987 Florida settlement document in opposition to Reed's summary judgment motion. Instead, Robi first attempted to get it before the district court after entry of the permanent injunction judgment. The district judge denied Robi's request to take judicial notice of the document, a decision that Robi did not appeal. Thus, the document certainly cannot be considered by this Court. *Adickes*, 398 U.S. at n.16.

In any case, the 1987 settlement document does nothing for Robi's case. Reed retained the right to use "The Platters" mark with his own name and, further, the right to use "The Platters" alone if FPI were found to have no rights in the name – a condition which in fact occurred. *See* page 13, *supra*. Thus, the lower court decisions in this case were entirely consistent with the 1987 conditional settlement.

III. THE COURT OF APPEALS DID NOT ESTABLISH A "FEDERAL PARTNERSHIP LAW" AND ITS DECISION WAS IN ANY EVENT CORRECT UNDER CALIFORNIA LAW

The heart of the Ninth Circuit's ruling is its conclusion that "The Platters" mark was owned collectively by the musical group's original five performers, and that Reed – "the one who founded and named the group and

as the person who has maintained continuity with the group and has been in a position to control the quality of its services" – retained the right to use the mark because the others left the group or passed away. The ruling follows general partnership principles enunciated by this Court more than 100 years ago and is correct under the California partnership statute, even assuming *arguendo* it is applicable.[9]

First, it is well established that a departing partner does not take with him a right to use the partnership's name or mark. *Menendez v. Holt*, 128 U.S. 514 (1888). There, a partnership sold flour under the mark "La Favorita." One of the partners, Ryder, resigned and began selling flour under the same mark. This Court affirmed an injunction prohibiting Ryder from using the mark. It expressly rejected the former partner's contention that he should be allowed "his share" in the goodwill by using the mark. *Id.* at 522. So long as the partnership remains in business, it retains ownership of the mark. *Id.* While not a music group case, Robi has offered no reason why the rationale and holding of *Menendez* should not be applied here.

The cases cited by the court of appeals and district court are all in accord. *Kingsmen v. K-Tel Int'l, Ltd*, 557

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[9] Reed has argued, and still contends, that he is entitled to exclusive rights as the undisputed first user of "The Platters" mark. *Columbia Mill Co. v. Alcorn*, 150 U.S. 460, 463-64 (1893); *Sengoku Works Ltd. v. RMC Intern., Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996), *cert. denied*, 521 U.S. 1103 (1997); *LaSociete Anonyme Des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974). The court of appeals did not reach Reed's contention.

F.Supp. 178 (S.D.N.Y. 1983); *HEC Enterprises, Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. 991 (C.D. Cal. 1980); *Albertini v. Giglio*, (E.D.Pa. 1979) (unpublished; discussed in *The Four Aces Litigation: What's In A Name?*, 5 Art & The Law 67 (1980)); *Giammarese v. Delfino*, 197 U.S.P.Q. 162 (N.D.Ill. 1977); *Boogie Kings v. Guillory*, 188 So.2d 445 (La. App. 3 Cir. 1966). Robi's efforts to distinguish those cases are unavailing. Robi has failed to offer any argument or law suggesting how Paul Robi (never mind Martha, who has never performed) could have usurped the group's ownership of the mark when he left the group due to a narcotics arrest. Notably, Robi has not cited a single pertinent case in her petition in support of her claim that the lower court erred.[10]

Second, when the partnership dissolved on Robi's arrest and departure in 1965, California partnership law may have provided for a distribution of partnership property. (None of the partners, however, requested such a distribution. *See* discussion of partnership law, *infra*). In view of the principle that service mark law normally requires an exclusive award to a single user, *Bell v. Streetwise Records, Ltd.*, 761 F.2d 67, 76 (1st Cir. 1985) (Breyer and Coffin, concurring), an award to all five partners would not have been appropriate. *See In re Marriage of Shelton*, 118 Cal. App. 3d 811, 173 Cal. Rptr. 629, 630-31 (3d Dist. 1981), in which the court ruled that a mark

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[10] Robi's likening Reed to someone assisting Serbian soldiers in their purge of Albanian Kosovars (Pet., at n.8) is not only wide of the mark, but grossly offensive and scandalous, warranting sanctions against Robi and her ghost writing counsel. *See* note 1, *supra*.

owned jointly by a married couple doing business together should be awarded in divorce to only one spouse. Principles of equity would have compelled such an award be made to Reed, the person who brought the name to the partnership and originated the group.

Third, an alternative analysis of rights under the California partnership statute – which Robi contends is applicable – also results in an award of exclusive rights to Reed. Under the statute, Paul Robi's departure from The Platters group in 1965 because of his arrest operated as a "dissolution" of the partnership, defined as "the change in the relation of the partners caused by any partner ceasing to be associated in the carrying on as distinguished from the winding up of the business." Cal. Corp. Code § 15029. As that dissolution was caused wrongfully by Paul Robi, and the business continued on, then Paul Robi (not Martha) had a claim against his co-partners "to have the value of his interest in the partnership, less any damages caused to his co-partners by the dissolution, ascertained and paid to him in cash . . . but in ascertaining the value of the partner's business the good-will of the business shall not be considered." *Id.* § 15038(2)(c)(II). Any such claim by Paul Robi accrued "at the date of dissolution", i.e., in 1965. *Id.* § 15043. Paul Robi never brought any claim against Reed or his other co-partners, and by now any such claim would be time-barred. None of Reed's other partners brought any claim against him after they left the partnership. Thus, as the last partner, Reed owns "The Platters" mark.

IV. THE COURT OF APPEALS DECISION, PLAINLY HOLDING THAT REED HAS THE RIGHT TO EXCLUDE ROBI'S USE OF THE MARK, IS NOT INTERNALLY INCONSISTENT

The Ninth Circuit decision is not "anomalous", as Robi contends. (Pet., at 25). It is entirely clear and internally consistent. The Ninth Circuit correctly recognized:

> [O]ur previous decisions did not address Paul Robi's rights to use the name "The Platters" as compared to Herb Reed's, nor did they address Martha Robi's rights to use that name as compared to Herb Reed's. Rather, they addressed FPI's rights to prevent Paul Robi from using the name "The Platters."

App. A, 4a; 173 F.3d at 738. The court then held "the district court was correct in ruling that Reed had a right to use of the name to the exclusion of [Martha] Robi." App. A, 8a; 173 F.3d at 740. The court's statement in footnote 1 is addressed not to Reed personally – who the court ruled has the right to use "The Platters" mark – but to other members of his present group.

In any event, there is no reason for this Court to review a footnote in this decision or any other court of appeals decision.

CONCLUSION

Reed, Villano and JPPI respectfully request the court to deny Robi's petition for writ of certiorari.

Respectfully submitted,

T. Christopher Donnelly
Counsel of Record
Donnelly, Conroy & Gelhaar, LLP
One Post Office Square
Suite 3350
Boston, MA 02109-2105
Tel. (617) 542-7400

Counsel for Respondents

Supreme Court, U.S.
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IN THE
SUPREME COURT OF THE UNITED STATES

MARTHA ROBI

Petitioner,

v.

HERBERT REED, JOHN VILLANO,
J.P. PRODUCTIONS

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

REPLY TO BRIEF IN OPPOSITION

MARTHA ROBI
IN PRO SE

10737 RIVERSIDE DRIVE
NORTH HOLLYWOOD, CA 91206
(818) 763-6289

BECKER GALLAGHER LEGAL PUBLISHING, INC., CINCINNATI, OHIO 800-890-5001

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INTRODUCTION

A. RESPONDENTS, Herbert Reed ("REED"), John Villano, and J. P. Productions, ("RESPONDENTS"), oppose Martha Robi's ("ROBI or PETITIONER") Petition for a Writ of Certiorari, and present three (3) issues in opposition:

1. RESPONDENTS' first assert that "...Robi's statement of the case ... is replete with misstatements ... (and) relies extensively on matters ... that were not properly before the District Court or the Court of Appeals ... thus cannot be considered by this Court...." (OPP. at 2.) Particularly, RESPONDENTS assert that eleven (11) "...(Appendices) F, K, L, M, N ,O, Q, R, U, BB and CC ... are not properly before this Court..." (OPP. at 2);[1]

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[1] ROBI's initial ten (10) paragraph Statement of the Case (at 3-10), for the most part, consists of specific quoted language of Appellate, District Court and State Court decisions which provides the judicial history of "The Platters" litigation. RESPONDENTS do not contend that ROBI's specific adoption of judicial findings is inaccurate, nor do RESPONDENTS, in their many objections, specifically identify any "misstatements." The essence of RESPONDENTS' objection is that ROBI is precluded from presenting certain factual statements (correct or not), in that certain Appendices which provide the basis of ROBI's Statement are not properly before this Court.

RESPONDENTS repeat their assertion that ROBI improperly references eleven (11) Appendices on thirteen (13) occasions, at pages 2, 4, 5, 7, 8, 9, 10, 11, 12, 13 (note 7 and note 8), 15, 16 and at 17 of the Opposition). "...None of Robi's post-judgment motions were properly before the Court of Appeals ... "Robi requested the District Court to take judicial notice of certain documents.... The District Court denied the Request, Robi did not appeal from that denial.... (OPP. at 8.) Many of the factual assertions appear in ... exhibits that were filed late ... the District Court refused reconsideration. Robi did not challenge that ruling in the Court of Appeals.... (OPP. at 9.) (Emphasis added.) "Robi's opposition to summary judgment cited ... five (5) exhibits, only two are included in Robi's Appendix APP. G and P...." (OPP. at 10.) APP. K was not in the record.... (Note 7 at 13.) The April 1, 1975

2. RESPONDENTS next assert that her "...(claim) Preclusion issue ... was not raised in Robi's opening brief before the Court of Appeals...." (OPP. at 16.)[2]

3. Finally, RESPONDENTS contend that: "...(ROBI's) petition for a writ ... does not involve an important federal question that conflicts with a decision by a state court of last resort ... or requires the Court's exercise of its supervisory power...." (OPP. at 1-2.)

B. In Reply, ROBI demonstrates:

1. First, that all elements of ROBI's "Statement of the Case," and all Appendices, were properly before the Ninth Circuit, and are therefore properly before this Court;

2. Second, ROBI demonstrates that her Opening

Agreement (APP. Q) is not signed by all the purported parties.... (RESPONDENTS' attorney admits otherwise before the District Court of N.Y., APP. J at 142a.) The District Court refused to take Judicial Notice of it. (Note 8 at 13.)

[2] ROBI's "(claim) Preclusion issue" asserts the Nevada District Court as required by the holding in Paul Robi, et al. v. Five Platters, Inc. 838 F.2d 318 (APP. E at 26a., at 47a), must give claim preclusive effect to the Florida D.C. of May 5, 1997 Order (APP. L at 99a), denying REED offensive collateral estoppel of the then-favorable Robi decisions (APP. F at 55a, APP. H at 73a) and thereafter on December 17, 1987 (APP. K at 95a), dismissing REED's claims against FPI with prejudice. That the 1987 Florida District Court decisions (APP. K at 95a, APP. L at 99a) preclude REED ten (10) years later, in 1997, from seeking the benefit of the same prior Robi decisions (APP. F at 55a, APP. H at 73a) before the Nevada District Court, which request the Florida District Court denied to REED in 1987.

ROBI's appears Pro Se (Note 1 at 1 of OPP), in that her attorney was not admitted before this Court as of August 26, 1999, the deadline date for the filing of ROBI's Petition. Subsequently, ROBI's attorney has applied for admission, and PETITIONER will then substitute her attorney upon his admission to this Court.

Brief before the Ninth Circuit (APP. II at 240a, at 241a, para 26, and at 249a) did directly assert issues of "claim preclusion" as to both the May 27, 1987 Florida District Court's Order denying REED's request for collateral estoppel against FPI (APP. L at 99a), and the Florida District Court December 10, 1987 Order of dismissal with prejudice (APP. K at 95a);

3. And finally, ROBI's Petition not only demonstrates that the exercise of this Court's supervisory power is appropriate, but, by its own holding, the Ninth Circuit's decision itself (APP. A at 1a) specifically identifies important federal questions: "Neither the Supreme Court nor the Ninth Circuit has directly discussed the status of a trademark for the name of musical groups ... when one of its members departs..." (APP. A at 6a); "This holding is consistent with the basic purposes of trademark law and the Lanham Act" (APP. A at 9a). By purportedly rendering both state partnership, and state contract law inapplicable to issues involving relationships between members of music performing groups as to ownership of the group's goodwill in its name (subsuming those issues under the Lanham Act), the Circuit Court decision (APP. A at 1a) renders inoperative not just one (1) California State Supreme Court decision, but the entire doctrine of California State Court Partnership Law (and that of the other forty-nine (49) states as well). The Circuit Court decision (APP. A at 1a) therefore does raise issues which are subject to this Court's review under Rule 10(a).

APPENDICES F, K, L, M, N, O, Q, R, U, BB AND CC ARE PROPERLY BEFORE THIS COURT

C. On March 3, 1998, ROBI submitted to the Ninth Circuit both her Opening Brief (APP. II at 240a), and her five (5) volumes of "Excerpts of the Record" (Index of ROBI's Excerpts is presented at APP. MM at 284a to 315a)[3]. At the

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[3] As a result of RESPONDENTS' objection, PETITIONER's Reply augmented her Appendix (now including Appendices DD to MM). APP. MM, commencing at 284a, includes the index of ROBI's Excerpts of the Record, as submitted to the Ninth Circuit, which specifically includes the eleven (11) questioned Appendices. APP. F is found at Tab No. 138 at APP. MM at 315a. APP. K is

time of ROBI's submission, FRAP Rule 10(e)(1) provides RESPONDENTS the opportunity to assert "...any difference ... about whether the record truly discloses what occurred in the District Court..." and FRCP Rule 10(e)(1) also provides RESPONDENTS the opportunity and obligation to have any "...difference(s) ... submitted ... and settled by that (District) Court and the record conformed accordingly."

D. As well, after ROBI's March 3, 1998 submission of her Brief (APP. II at 240a) and Excerpts (APP. MM at 248a to 316a) to the Circuit, then, as provided by FRAP 27 and Ninth Circuit Rules 27-1 and 30-2(a), RESPONDENTS had a second opportunity to object to ROBI's Brief (APP. II at 240a) and/or PETITIONER's Excerpts (Index, APP. MM at 284a to 315a) by filing a motion directing the Circuit Court to strike portions of ROBI's Excerpts of the Record, or her Opening Brief.[4] RESPONDENTS' had available to them a FRAP

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found at Tab No. 126 at APP. MM 312a. APP. L is found at Tab No. 138 at APP. MM at 315a. APP. M, the 3/21/55 Recording Agreement, is found at Tab No. 34 at APP. M at 291a. APP. N, the photograph of "The Platters" is found at Tab No. 8 at APP. MM at 285a. APP. O, the January 1966 "The Platters," Paul Robi, Zola Taylor and Tony Williams (independent of the FPI and REED), is found at Tab No. 18 at APP. MM at 288a. APP. Q is found at Tab No. 128 at APP. MM at 313a. APP. R, FPI bankruptcy which indicates FPI's license of the trademark "The Platters" to REED, is found Tab No. 118 at APP. MM at 310a. APP. U, the California June 28, 1996, District Court Order, indicating a questions remain whether FPI has lost its rights, is found at Tab No. 109 at APP. MM at 308a. APP. BB, the Paul to Martha Robi Assignment, is found at Tab No. 66 at APP. MM at 299a. APP. CC, the July 12, 1968 letter from REED, asserting rights on behalf of the corporation as against Zola Taylor and ROBI, is found at Tab No. 33 at APP. MM at 291a.

[4] If the excerpts of the record contain unauthorized documents or matters that were not part of the District Court record, the remedy is a motion to strike the offending material. Kirshner v. Uniden Corp. of America 842 F2d 1074, 1087 (9th Cir., 1988, Circuit Rule 30-2 (a)). A Motion to Strike a portion of the record or a brief based upon the fact that the matters submitted are not properly within the appellate record must be made by motion separate from the

10(e)(1) motion or a motion to strike. On May 14, 1996, four (4) months prior to RESPONDENTS' September 18, 1996, submission of its Summary Judgment Motion (APP. W at 181a),[5] the District Court had held a one (1) day preliminary injunction evidentiary hearing when the District Court admitted into evidence over one hundred (100) exhibits (Tabs Nos. 8 through 77, Excerpts, APP. MM 285a to 300a), to which evidence REED, ROBI and the District Court itself all made reference at times without specificity to precise exhibit numbers.[6] RESPONDENTS filed no objection to, or request to strike, ROBI's Excerpts of the Record (APP. MM at 285a through 316a) or Opening Brief (APP. II at 240a). Appellant's Opening Brief (selected pages, APP. II at 240a) references each of these eleven (11) Appendices to which RESPONDENTS object.

E. PETITIONER further addresses RESPONDENTS' objections to specific Appendices:

1. RESPONDENTS assert: "...items ... BB ... were not part of the summary judgment record and ... are not properly before this Court." (OPP. at 2.)[7]

2. Yet, the District Court's Summary Judgment

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requesting party's brief. In re Pace, 56 F.3d 1170, 1177 Note 10 (9th Cir., 1995) referencing FRAP 27 (a) and Circuit Rule 27 (1): "...In his brief, Taxel asked us to strike the Special Addenda appended to the Appellants' opening brief and urged us to disregard all assertions contained therein. Taxel's request falls short of the requirements of Fed.R.App.P. 27 and 9th Cir.R. 27-1, and is accordingly denied." (Note 10, In re Pace, supra.)

[5] Appendix W identifies its incorrect date as 9/18/94 as opposed to 9/18/96.

[6] Opposition to this Court at 11, at note 6, provides an example of this practice, "Robi's testimony was referenced by Reed." (OPP. at 11 note 6.)

[7] Appendix BB at 206a is the November 9, 1988 Paul Robi to Martha Robi Assignment of Trademark.

Order (Appendix C at 14a), references (APP. BB at 206a) and finds "...Prior to his death in 1989, Paul assigned his right to the use of the mark to Robi...," and the Ninth Circuit (Decision APP. A at 1a) on two (2) occasions specifically references (APP. BB at 208a): "...Hence the Court held the purported assignment of this right to Martha Robi was invalid...." (APP. A at 2a.) "...In November of 1988, Paul Robi executed a written "assignment of trademark" ostensibly transferring to Martha Robi all of his rights in the Platters mark" (APP. A at 4a).[8]

F. ROBI's Statements of Facts at Issue (APP. X at 185a) and her Opposition to Summary Judgment (selected pages, APP. KK at 265a to 272a) reference sixteen (16) preliminary injunction exhibits, including three (3) to which REED objects.[9]

G. RESPONDENTS' objection to APP. F, the May 22, 1985 California District Court Order dismissing FPI's lawsuit against Paul Robi, (APP. F at 55a) and APP. L, the May 15, 1987 Florida District Court Order denying REED's Motion requesting offensive collateral estoppel based upon the favorable Robi Orders against FPI (APP. L at 99a), ROBI specifically requested the Circuit Court to take judicial notice of Appendices F (APP. F at 55a) and L (APP. L at 99a) on December 9, 1997. RESPONDENTS did not object. By Order of January 26, 1998 (APP. B at 11a), the Ninth Circuit granted ROBI's Request to Take Judicial Notice of APP. F and L.

H. PETITIONER's October 1, 1997 Notice of

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[8] RESPONDENTS' own Summary Judgment Memorandum before the District Court, refers to the Paul-Martha Robi November 9, 1988 Assignment: "...Because Paul Robi is deceased ... Martha Robi cannot rely on the purported Assignment of trademark ... the supposed assignment is invalid." (APP. LL at 282a.)

[9] Among them, Tabs 18 (APP. N at 10a), 34 (APP. M at 101a), 66 (APP. BB at 206a), all admitted into evidence at the Preliminary Injunction hearing, and included in the Appendix on Appeal without objections by REED.

Appeal (APP. EE at 220a (para. ii)) specifically appeals the District Court Order denying ROBI's "Request to Take Judicial Notice" of APP. R. RESPONDENTS' objections to APPS. F, L, M, N, O, R, U, BB and CC (OPP. at 2) are clearly without merit.

I. RESPONDENTS have clearly placed APP. K at issue (APP. K at 95a) before both the District Court, and before the Court of Appeals by reference to this very document in RESPONDENTS' Motion for Summary Judgment (REED's Memorandum, APP. LL at 283a, note 10): "Under the November 1987 Settlement Agreement between the Five Platters, Inc., and Herb Reed, he conditionally agreed not to use the name `The Platters' by itself...." (APP. LL at 284a).[10] Remarkably, RESPONDENTS' own "Statement of the Case" in their Opposition before this Court (OPP. at 13) specifically references APP. K. "Earlier in 1987, FPI and REED had settled a suit in the Southern District of Florida." (OPP at 13.)[11] The entirety of RESPONDENTS' objections to PETITIONER's Appendices are without merit.

PETITIONER PRESENTED THE CLAIM PRECLUSION ISSUE AS TO THE REED-FPI FLORIDA LITIGATION IN PETITIONER'S OPENING BRIEF

Contrary to RESPONDENTS' assertion (OPP. at 16), PETITIONER's Opening Brief (APP. II at 240a, selected pages) asserts: "(The) District Court erred in not granting ROBI summary adjudication of issues and in not dismissing REED's counterclaim based upon the doctrine of claim and issue preclusion as enunciated by this Court in Robi v. The

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[10] ROBI's 56f Affidavit specifically requested this REED's referenced settlement agreement with FPI. (APP. Z at 197a, 199a, para 21.) The District Court granted a protective Order (APP. K at 204a, precluding ROBI from access to APP. K (APP. K at 95a).

[11] ROBI's Brief requested the Circuit Court to consider APP. Q (Opening Brief, APP. II) as to the "Denial" to take judicial notice of the Florida D.C. file which included APP. Q (APP. Q at 110a) was an abuse of discretion." (APP. II at 251a.)

Five Platters, Inc. 838 F2d 318 (9th Cir. 1988) (APP. II at 244a). RESPONDENT's assertion that ROBI did not raise the preclusion issues before the Circuit Court is without merit.[12]

ROBI'S PETITION PRESENTS A SUFFICIENT BASIS FOR CERTIORARI

J. PETITIONER contends that the Ninth Circuit Decision (APP. A at 1a) not only "...conflict(s) with a decision by a state court of last resort," (that being the California Supreme Court rulings on partnership law), but in fact the Ninth Circuit decision (APP. A at 1a) by its very holding explicitly precludes from consideration the entire statutory and California Supreme Court decisional authority with regard to partnership and contract law as applicable to trademark issues of music performing groups.[13]

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[12] FRCP Rule 56 requires that all inferences be inferred in favor of ROBI. The District Court and Ninth Circuit adopted certain prior findings in favor of REED and ignored others. (The prior findings twice affirmed that "from 1965 to the present there have been two performing groups as The Platters. One group is controlled by Buck Ram. The other is Robi's.") (APP. F at 58a, January 9, 1989 Findings in CV 84 3326, APP. HH at 230a, Finding N, APP. HH at 233a.) The District Court decision (APP. C at 15a) acknowledges REED's 1967 Affidavit asserting on behalf of FPI in California State Court that ROBI and Zola Taylor should be enjoined ("as set forth in his 1967 affidavit" (APP. CC at 15a, APP. P at 112a)), but the D.C. infers in its Order (APP. CC at 15a), that REED in 1967 was testifying on behalf of the Partnership not the corporation when he testified that ROBI and Zola Taylor should be enjoined in favor of FPI. (APP. C at 16a.)

[13] The underlying District Court decision did not adopt REED's sole basis for Summary Judgment asserting that he was the first to use the name "The Platters" (Motion of REED, APP. W at 181a). The District Court finds (citing only California State partnership law, Peterson v. Lightfoot 191 P. 48, 49 (Cal. N.Y. (sic) Ct. App. 1920) (APP. C at 15a) "...that REED brought a `valueless' name to a partnership which gained value through joint effort..." and that the partnership owned the name. (APP. C at 15a.)

K. The Ninth Circuit opinion (APP. A at 1a) found that "Neither the Ninth Circuit nor the Supreme Court has ever ruled on the issue of ownership of partnership goodwill in a music performing group when one of its members departs and continues to perform under the group name."[14] (APP. A at 6a.) The Circuit also held: "This holding is consistent with the basic purposes ... of the Lanham Act." (APP. A at 9a.) RESPONDENTS (OPP. at 19) cite to Bell v. Streetwise Records 761 F.2d 67, 76 (1st Cir. 1985) (Breyer and Coffin concurring) as supporting the Ninth Circuit decision. Yet, in Bell, supra, the Appellate Court undertakes particular scrutiny to determine whether federal or state law (or both) are applicable, "we apply Massachusetts law." Id. 761 F.2d at 71. "We now examine the rights of the separate employment contracts." Id. 761 F.2d at 73.[15]

L. The Ninth Circuit decision (APP. A at 1a) first implicitly rejects the District Court's finding that "Paul could not assign to Martha" (APP. CC at 20a), holding that "...a manager rather than a performing member can own the performing trademark..." (APP. A at 7a) (Rich v. Buchansky

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The District Court, sua sponte, then adopts the "Last to physically leave the group rule" based upon Bookie Kings v. Guillory 188 So. 2d 445, 449 (L.A. CT APP 1990) and one (1) Federal Court decision that appears to apply state law, Giammaress v. Delfino 197 U.S.P.Q. (BNA) 163 N.D. Ill. 1997) (APP. C at 15a).

[14] As between strangers, the trademark issues may be only federal (in which the State Court has concurrent jurisdiction under the Lanham Act). As to "The Platters" who were partners, the state law of partnership is also applicable, and when these partners resolved litigation through judgments against others or those in privity with them, the doctrine of claim and issue preclusion, is also applicable.

[15] Appellant ROBI's Brief to the Ninth Circuit references California Supreme Court authority and Calif. Corp. Code § 15038(2) (APP. II at 254a) asserting that the appropriate question is not "who physically left," but "who legally left" as determined under California State law.

609 F.Supp. 1522 (S.D. N.Y. 1985)), and the Circuit Court, then finds that the Lanham Act supersedes or, in some manner, incorporates a federal partnership rule of law that "the last to physically leave owns all of the goodwill" specifically applicable to music group partnerships. (APP. A at 8a.)

CONCLUSION

M. The District Court enunciates a state court partnership law of "last to leave" when the partners control the partnership, and grants RESPONDENTS offensive issue preclusion of the ROBI decisions to defeat Martha Robi. The Circuit then grants judicial notice of the Florida District Court decisions (APP. B at 10a, APP. L at 99a), then upholds the District Court's application of offensive issue preclusion in favor of RESPONDENTS, who had dismissed their prior claims against FPI with prejudice before the Florida District Court in 1987 (APP. K at 95a).

N. The Ninth Circuit's then purports to incorporate into the Lanham Act (APP. A at 9a) a federal rule as to partnership of music performing groups, inconsistent with the law of the fifty (50) states, and the Circuit Court then implicitly rejects its own specific doctrine of claim and issue preclusion applicable to this same partnership, Robi v. FPi, supra, 838F.2d 318.

O. The Ninth Circuit then determines that the ownership of goodwill to the name of a musical partnership is solely a question of Federal Law, when in fact State Law must be considered in mixed questions of federal and state law when assignment issues and res judicata issues are intermixed with trademark issues. The matter raised for the granting a position is within the requirements established by Supreme Court Rule 10(a).

Respectfully submitted,

/s/_____
Martha Robi, Pro Se

APPENDIX DD

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed September 15, 1999]

No. 97-16909

D.C. No. CV95-01029-LDG

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED, an individual, dba/Herb Reed and The Platters, an entity unknown; THE FIVE PLATTERS INC.; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation,
Defendants-Appellees.

ORDER

Before: CANBY and KLEINFELD, Circuit Judges, and KEEP, District Judge.*

Two distinct issues regarding attorney fee requests remain in this matter. First, we must determine whether an award of fees is proper under Nevada Law and the Lanham Act. Second, we must determine whether an award of attorneys fees and costs should be levied pursuant to 28 U.S.C. § 1927. After substantial briefing on the issues by the parties, we issue the following order.

I. Attorney Fees Pursuant to Nevada Law and the Lanham Act

We first turn to Appellee's[1] Motion for Attorney Fees, filed on April 30, 1999. Appellant filed an Opposition on May 17, 1999. Appellee filed a Reply on June 3, 1999. This request is distinct from the request for attorney fees arising from the costs incurred by Appellee in answering counsel for Appellant's Post-Hearing Letter Brief and the November and March Requests to Take Judicial Notice. Those requests will be addressed in Section II of this order.

Appellee first asks for attorney fees pursuant to Nevada Revised Statute 598A.210(1), Nevada's Unfair Trade

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* The Honorable Judith N. Keep, District Judge, United States District Court for the Southern District of California, sitting by designation.

[1] Throughout this order, the court refers to "Appellee" and "Appellant." Those terms also refer to counsel for Appellant and counsel for Appellee.

Practice Act. We find that fees are not mandated under this statute for at least two reasons.

First, the appeal only involved federal law. The district court opinion is also devoid of any Nevada law. It appears that any injunction that was issued by the district court was based solely on federal trademark law, not on Nevada's Unfair Trade Practices Act. Therefore, it is inappropriate to award fees based on a state statute. See Modzelewski v. Resolution Trust Corp., 14 F.3d 1374, 1379 (9th Cir. 1994) ("since we address federal, not state claims, the federal common law of attorney's fees, and not Arizona law, is the relevant authority.).

Second, the proceedings before the district court indicate that the request for attorney fees, if any are due for work done before the District Court, should have been made to the lower court. In the exhibits accompanying the reply, Appellee submits a copy of a district court order which denies the attorney fee request as premature since judgment was only entered on the issue of liability at the time of the request. The court invited defendants to re-file the motion for fees after final judgment. The district court order denying fees was not appealed. In essence, Appellee is asking this court to rule on an issue that the district court deferred, but recognized was properly before it. Appellee provides no support justifying an award of fees under these circumstances.

Appellee also asks for attorney fees pursuant to the Lanham Act. The Lanham Act provides that a court may award reasonable attorney fees to the prevailing party "in exceptional eases." 15 U.S.C. § 1117(a). Exceptional cases include cases where a party's conduct is "malicious, fraudulent, deliberate, or willful." Intel Corp. v. Terabyte Int'l, Inc., 6 F.3d 614, 621 (9th Cir. 1993) (quoting Lindy

Pen Co., Inc. v. BIC Pen Corp., 982 F.2d 1400, 1409 (9th Cir. 1993)).

This court finds that attorney fees are not justified under the Lanham Act because this case does not present the type of exceptional circumstances that justify attorney fees. The issues in the case were novel; the opinion itself notes that neither the Ninth Circuit nor the Supreme Court had addressed those issues before. In addition, the court finds that the record before us does not indicate that Appellant's conduct justifies awarding attorney fees to Appellee. The specific allegations Appellee makes regarding Appellant's lack of candor are disputed and unclear from the record. We cannot make a finding of exceptional circumstances based on these contested allegations.

For the foregoing reasons, Appellee's Request for attorney fees pursuant to Nevada law and the Lanham Act is DENIED.

II. Attorney Fees for Post-Hearing Letter Brief and Requests for Judicial Notice

On April 26, 1999, counsel for Appellant responded to this court's March 26, 1999 Order to Show Cause why Appellees should not be awarded attorney fees and costs pursuant to 28 U.S.C. § 1927 with regard to the costs and fees incurred in opposing Appellant's Post-Hearing Letter Brief and the November and March Requests to Take Judicial Notice. Appellee filed a reply on May 12, 1999. Pursuant to a request by Appellant, this court issued a second Order to Show Cause on July 15, 1999. In that order, we clarified that this court's Order to Show Cause based on § 1927 applies only to counsel for Appellant. In light of this clarification, we permitted counsel for Appellant twenty-one days to file

supplemental papers. We then allowed counsel for Appellant an additional ten days pursuant to a subsequent request. We are now in receipt of counsel for Appellant's reply papers.

Title 28 U.S.C. § 1927 penalizes the multiplication of proceedings. See Zaldivar v. City of Los Angeles, 780 F.2d 823, 831 (9th Cir. 1986). Section 1927 states that any attorney who "so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct." Courts of appeal may impose such sanctions. See T.W. Electrical Service Inc. v. Pacific Electrical Contractors Association, 809 F.2d 626, 638 (9th Cir. 1987). As we stated in our July 15, 1999 Order to Show Cause, the fees and costs associated with § 1927 are assessed against counsel for Appellant, who filed the motions at issue. We will therefore determine whether this court is justified in awarding Appellee fees and costs incurred in responding to counsel for Appellant's Post-Hearing Letter Brief and the two Requests to Take Judicial Notice, served in November and March.

Section 1927 requires bad faith by the attorney. See Soules v. Kauaians for Nukolii Campaign Committee, 849 F.2d 1176, 1185 (9th Cir. 1988); In re Keegan Management Co., Securities Litigation,78 F.3d 431,436 (9th Cir. 1996). Bad faith includes knowingly or recklessly making a frivolous argument. See Estate of Blas Through Chargualaf v. Winkler, 792 F.2d 858, 860 (9th Cir. 1986).

The history of extraordinary requests and filings, including the three specifically cited above, is instructive on the issue of bad faith. Counsel for Appellant has inundated this court since his Notice of Appeal. In December, 1997, counsel for Appellant moved for an injunction although an

injunction had not been requested first in the district court. Counsel filed approximately 30 pages of errata to correct the opening brief and the reply. Counsel filed a Notice of Intent to Use Visual Aid Charts just prior to oral arguments. Without leave, Appellant's counsel filed a five page, single-spaced "post-hearing letter brief." Counsel for Appellant filed a motion to supplement the record in September of 1998. In November, counsel filed its first Request to Take Judicial Notice. A second request was filed in March. Counsel has also filed a request for rehearing and suggestion for rehearing en banc. More recently, this court has received a motion to strike a reply brief filed by Appellee, three "final" motions to stay the mandate, and a request for more time to file an answer to this motion.

The court is aware that there is sometimes a fine line between vigorously defending a client's interest and acting recklessly. For that very reason, this court confines the scope of the sanctions inquiry to costs and fees associated with the post-hearing letter brief and the two requests for judicial notice.

We find that counsel for Appellee is justified in receiving fees and costs associated with answering the letter brief and the judicial notice requests. The single-spaced letter brief, dated four days after the case was deemed submitted at oral argument, was clearly in violation of Fed.R.App.P. 28(c), which provides that "[u]nless the court permits, no further briefs may be filed." Id. Because it was single-spaced, the brief was akin to a ten-page document which raised arguments that opposing counsel was forced to address, even though Appellant's attorney had not received the permission of the court to file the document.

This court further finds that both the November and the March requests for judicial notice meet the standard for fees and costs pursuant to § 1927. Neither the November nor the March requests for judicial notice contain any supporting case law for the attempt to seek judicial notice of unrelated cases involving some of the same parties. Each request included attachments of numerous matters that were never before the district court nor part of the record on appeal. Additionally, neither request provided analysis as to why the material at issue in the requests for judicial notice was relevant to the matter before this court. Despite the fact that this court rejected counsel's November request, counsel again tried to include materials outside of the record in March. The March request also failed to provide any legal basis for counsel's attempt to expand the record, nor did the request provide analysis as to why the documents at issue were relevant. That request was also denied by this court.

The three motions discussed above were the most egregious in the pattern of filings instituted by counsel for Appellant. Despite their lack of merit, however, counsel for Appellant filed these motions, knowing at the very least that counsel for Appellee could not sit by and allow it to appear he was agreeing to the materials and requests.

Counsel for Appellant argues that the Motions Panel granted a judicial notice request in January, 1998. The granting of one motion, however, does not give counsel leave to file motions that have no basis in fact or law, such as the post-hearing brief and two requests to expand the record. On the record before it, this court finds that counsel's filing of the post-hearing letter brief and the November and March Requests to Take Judicial Notice were made in bad faith insofar as counsel either knowingly or recklessly made numerous frivolous arguments. Despite counsel for

Appellant's pattern of filing questionable motions and requests, this court, mindful that only abuses that clearly meet the § 1927 standard should be punished, restricts fees and costs to those associated with answering those three motions.

III. Conclusion

For the foregoing reasons, we deny Appellee's request for attorney fees pursuant to Nevada law and the Lanham Act, but permit fees and costs associated with responding to the post-hearing letter brief and the November and March Requests to Take Judicial Notice. Counsel for Appellee shall file a statement of its fees and costs for those three motions within 14 days of the filing of this disposition. Counsel for Appellant may file any objection to those fees and costs within 14 days thereafter.

APPENDIX EE

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed October 1, 1997]

Case No. CV-S-95-10129-LDG (LRL)

MARTHA ROBI, an individual,
Plaintiff,

v.

HERB REED, an individual, dba HERB REED and THE PLATTERS, an entity unknown; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation; THE FIVE PLATTERS) INC., a California corporation,
Defendants.

HERB REED, an individual dba HERB REED and THE PLATTERS, an entity unknown; JOHN VALANO, entity unknown; JOHN VALANO, an individual; J. P. PRODUCTIONS; and entity unknown; *Counterclaimants*	)
v.	)
MARTHA ROBI, an individual, *Counterdefendant.*	)
MARTHA ROBI, an individual, *Counterclaimant*,	)
v.	)
HERB REED, an individual dba HERB REED and THE PLATTERS, an entity unknown, *Counterdefendants..*	)

NOTICE OF APPEAL

Notice is hereby given that Martha Robi, plaintiff/counterdefendant/counterclaimant in the above-captioned case ("Plaintiff"), hereby appeals to the United States Court of Appeals for the Ninth Circuit from:

(i) the Judgment entered on the 29th day of September 1997, dismissing with prejudice Plaintiff's complaint; permanently enjoining Plaintiff from using in any manner the

mark "The Platters"; ordering Plaintiff to deliver to the Court for destruction all goods, articles, or other matters bearing the mark "The Platters"; canceling Plaintiff's Nevada registration of the service mark "The Platters", and all other state registrations by Plaintiff of that service mark; and granting judgment in favor of counterclaimants and awarding damages to counterclaimants in an amount to be determined at a hearing;

(ii) the Order entered on the 29th day of September 1997, granting summary judgment in favor ofdefendants and counterclaimants Herb Reed, John Villano, and John P. Productions, Inc. ("Defendants/Counterclaimants"); denying Plaintiff's Motion For Summary Of Adjudication Of Issues (#119), Motion To Strike Portions Of Herb Reed's Affidavit (#106), Objection To Minute Order (#107), Application For Court To Consider Supplemental Papers (#108), and Request To Take Judicial Notice (#137); and granting defendants/ counterclaimants' Motion To Strike And Dismiss Counterclaims In Reply (#121); and

(iii) all other orders entered in this action.

LIONEL SAWYER & COLLINS

BY /s/_____

Cam Ferenbach, Esq.
David Shenk, Esq.
1700 Bank of America Plaza
300 South Fourth Street
Las Vegas, NV 89101

and

Allen Hyman, Esq.
LAW OFFICES OF ALLEN HYMAN
12001 Ventura Place, Suite 501
Studio City, CA 91604

Attorneys for Plaintiff, Counter-Claimant, and Counter-Defendant, MARTHA ROBI

APPENDIX FF

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed December 9, 1997]

No. 97-16909

D.C. No. CV95-01029-LDG

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED
Defendant-Appellee.

REQUEST TO TAKE JUDICIAL NOTICE BEFORE THE NINTH CIRCUIT COURT OF APPEALS

Appellant Martha Robi ("ROBI") respectfully requests the Ninth Circuit Court of Appeals to take Judicial Notice of the following matters:

No. 1. Complaint in re The Five Platters, Inc. v. ROBI, et al., 84 C3778 U.S. District Court for the Northern District of Illinois, Eastern Division, filed May 1, 1984.

No. 2. Request to Take Judicial Notice by REED in the U.S. District Court, Southern District of Florida in re The Five Platters v. Herb Reed, et al., Case No. 84-8324-CIV-ARONOVITZ filed October 15, 1987.

No. 3. Order Granting Motion to Dismiss and Request to Take Judicial Notice in The Five Platters, Inc. v. ROBI, et al., CV 84-9873 CBM, U.S. District Court, Central District of California dated May 22, 1985.

No. 4. Order Denying Motion for Sanctions and Denying Motion for Summary Judgment in The Five Platters, Inc. v. REED, et al., 84-8324-CIV, ARONOVITZ, U.S. District Court, Southern District of Florida dated April 30, 1986.

No. 5. Order Denying REED's Motion for Summary Judgment in Case 84-8324-CIV in the U.S. District Court, Southern District of Florida dated May 5, 1987.

Respectfully Submitted,

LAW OFFICES OF ALLEN HYMAN

By: /s/_____
Allen Hyman
Attorney for Plaintiff/Appellant
MARTHA ROBI

DATED: December 8, 1997

APPENDIX GG

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed October 22, 1997]

Case No. CV-S-95-10129-LDG (LRL)

MARTHA ROBI, an individual, *Plaintiff*,	)
v.	)
HERB REED, an individual, HERB REED and THE PLATTERS, an entity unknown; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation; THE FIVE PLATTERS INC., a California corporation *Defendants*.	)
AND ALL COUNTER-ACTIONS.	)

REQUEST TO TAKE JUDICIAL NOTICE

I.

INTRODUCTION

A. On Saturday, October 18, 1997, Plaintiff Martha Robi's ("ROBI") attorneys received from Archives of the U.S. District Court Records in Atlanta, Georgia, a copy of the Court File in The Five Platters, Inc., v. Herbert Reed, et al., U.S.D.C. (So. Dist. of Florida), Case No. 84-8324 CIV (ARONOVITZ).[1]

B. Based, in part, upon This Florida District Court documentation, ROBI will request the Ninth Circuit to immediately vacate this court's Order and Judgment, based upon the doctrine of claim and issue preclusion, asserting that at a minimum, there are questions of fact as to the "privity" of Herbert Reed with The Five Platters, Inc., ("FPI"), based upon this District Court documentation.

II.

THE 1984 DISTRICT COURT LITIGATION AND THE DISCLOSURE OF THE APRIL 1, 1975, AGREEMENT

A. The District Court file of The Five Platters, Inc. v. Herbert Reed, et al., Case No. 84-8324 CIV (U.S.D.C. Southern District of Florida), includes, in part, the following:

---

[1] Plaintiff ROBI's Exhibit No. 18, in support of FRCP Rule 59(e) Motion, or in the alternative, for a Stay, is the Docket Sheet of this case.

1. The June 26, 1984, FPI Complaint against REED, claiming FPI owns rights to "The Platters" (Page Nos. 1, 6, 20, 23, and 24 of the Complaint is attached as Request to Take Judicial Notice ("RJN"), Exhibit No. 1 (at page No. 6, para. no. 13, FPI alleges it owns the trademark to "The Platters").

2. Count VII of the June, FPI 1984 Complaint, at Para. No. 52 (RJN No. 1 at 20) alleges ". . . Defendant Herb Reed has breached the contract he entered into with the Plaintiff on April 29, 1975. . . ." (Emphasis added).

* * *

[8]

to the question of why this Court should hold the assignment of stock to FPI "was ineffective as to Paul but not as to REED?" (order at 5:10-11). REED consistently aligned himself with and ratified the positions of FPI against the Partnership, and is therefore estopped from benefiting from any favorable consequences of the 1974 decision. REED's representations and ratifications in the April 1, 1975 agreement, confirming assignment of stock after the 1974 decision, provide additional factual basis for treating ROBI differently from REED.

I. This Court in its Order also references the case of The Five Platters Inc. v. Purdie, 419 F.Supp. 372 (1976) (Order at 4:24), which this Court ". . . concluded (that) (the Court in Purdie, supra., had found) the assignment was effective. . ." (Order at 4:24). One of the principle elements of evidence relied upon by the District Court in The Five P!atters Inc. v. Purdie in finding the assignment of stock to be effective to the corporation, was the Purdie District Court's

reference and reliance upon the April 1, 1975, FPI/REED Agreement (The Five Platters Inc. v. Purdie, supra. at 383).

J. The FPI/REED Agreement of April 1, 1975, established privity between FPI and REED, and was totally inconsistent with REED's claims to any partnership property of "the group."

III.

THE DETERMINATION OF THE 1984-1987 FEDERAL COURT CASE

A. On July 25, 19S5, REED answered the FPI Complaint and filed a Counter-claim, which is attached as RJN Exhibit No. 4.

1. REED's Counter-claim asserts breach of the April 1, 1975, contract.

2. REED asserts in his Counter-claim that he is twenty percent (20%) legal owner of The Five Platters, Inc., and has an equitable claim to the eighty percent (80%) ownership of The Platters stock (Counter-claim at 8).

B. REED, in support of Partial Summary Judgment, filed an Affidavit dated May 6, 1985, (attached as RJN Exhibit No. 5), that he ". . . (REED) was one of the original shareholders of The Five Platters, Inc. . . . that (REED) owned 20% of the stock. . . that (REED) has never sold his stock . . . that (REED) served as President and a member of the Board . . . and (REED) demands his stock. . . ."

C. RJN Exhibit No. 6 is a Stipulation of Settlement dated December 10, 1987 (not previously disclosed), signed by the District Court Judge, which Settlement provided for the following:

1. That the actions of REED and FPI be dismissed with prejudice (Para. No. 1).

2. That REED, as long as he complies with the terms of the settlement, ". . . can perform as 'Herbert Reed and The Platters,' or 'Herbert Reed of the Original Platters' . . ." (Para. No. 1).

3. That ". . . REED shall not, other than as set forth, use the name 'The Platters'. . ." (Para. No. 3).

4. That REED sell his stock to The Five Platters, Inc. (Para. No. 4).

5. That REED ". . . shall make himself available for testimony at the request of The Five Platters, Inc . . ." (Para. No. 5).

6. That the parties shall not file, without notice, infringement suits against one another (Para. No. 6).

7. That ". . . should a court of competent jurisdiction enter a final order . . . that The Five Platters, Inc., has no right in 'The Platters,' nothing shall limit REED'S rights in the name 'The Platters,' and this agreement shall not insure to any party other than 'The Five Platters, Inc., and Herbert Reed . . ." (Para. No. 7).

D. RJN Exhibit No. 7 is a Dismissal of all claims with prejudice.

IV.

REED WAS EITHER IN PRIVITY OR BECAME IN PRIVITY WITH THE FIVE PLATTERS INC., AS TO THE 1974 CALIFORNIA JUDGMENT AGAINST FPI, AS TO THE ROBI 1985 AND 1990 JUDGMENTS AGAINST FPI OR THERE ARE QUESTIONS OF FACT IN THAT REGARD.

A. If REED was in "privity" or became in "privity" with FPI at the time or after the 1974 FPI v. Robi State of California Court Decision, REED may be barred from taking a position contrary to ROBI's rights.

B. If REED was in "privity" with FPI at the time of the 1976 FPI v. Purdie, decision, REED may be estopped from taking a position that the trade name "The Platters" is not transferrable, as found in The Five Platters, Inc. v. Purdie, supra.

C. REED had agreed to jointly assist The Five Platters, Inc., in litigation with regard to stopping other groups from using the name, and REED had established a concurrent interest with The Five Platters, Inc., in the name "The Platters."

D. REED may have been in "privity" with The Five Platters, Inc., in 1989 when ROBI prevailed against The Five Platters, Inc. REED, through both the April 1, 1975, Agreement and the December 10, 1987, FPI/REED Agreement, established a concurrent

* * *

APPENDIX HH

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

[Filed January 9, 1989]

No. CV 84-3326 (CBM)

PAUL ROBI, *Plaintiff*,	)
v.	)
THE FIVE PLATTERS, INC., JEAN BENNETT, and BUCK RAM, *Defendant*.	)

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The above-entitled case came on regularly for trial before the Honorable Consuelo B. Marshall, United States District Judge, sitting without a jury. Allen Hyman, of the law office of Nagler & Schneider, Los Angeles, California, appeared on behalf of plaintiff; and Cheri S. O'Laverty, Los Angeles, California, appeared as counsel for defendants. The case having been submitted for decision, the Court now makes the following Findings of Fact and Conclusions of Law.

FINDINGS OF FACT

1. This case is the second to be adjudicated by the Court between these two parties. In a companion case, The Five Platters, Inc. v. Paul Robi, et al. , CV 84-9873 (CBM), this Court filed an order granting summary judgment on May 22, 1985, which was affirmed by the Ninth Circuit in its opinion filed on January 27, 1988.

2. On June 21, 1988, this Court issued an order in this case granting Robi's motion for summary adjudication of issues not in controversy and issued its findings. Those findings are incorporated herein:

a. Thirty years ago, in September 1954, Paul Robi joined Herbert Reed, Tony Williams, Zola Taylor and David Lynch in a singing group which had been formed in 1953. The group was called "The Platters."

b. When Robi joined the group, he assisted the other Platters with musical arrangements and organized and led the group's rehearsals.

c. In early 1955, "The Five Platters" emerged as a performing group. Success came quickly. During the period from 1955 to 1960, The Platters recorded many hit records; thirteen of their recordings made during this period sold more than a million records. Among their hits were "The Great Pretender" and "Twilight Time."

d. All told, The Platters sold over forty million records during this time period. They performed throughout the United States and all over the world. They made appearances in movies and on television shows, including the "Ed Sullivan Show."

e. From 1955 through 1964, The Platters had a recording contract with Mercury Records. All of The Platters' hit records were recorded during this nine-year period. The only persons to perform as The Platters during this period were Robi, Taylor, Reed, Williafns and Lynch.

f. The Five Platters, Inc. has presented a list of major hit records and performance credits of The Platters. This list evidences the goodwill created by Robi, Taylor, Reed, Williams and Lynch in the name "The Platters."

g. From 1955 on, The Platters was managed by Buck Ram. Ram managed the group, promoted the group, and composed many of its songs. He also acted as The Platters' financial advisor. Ram represented to Robi and to the other members of the group that he would look after their welfare. Robi and the other Platters were young and inexperienced in business. Ram obtained control of the financial, legal and business affairs of The Platters.

h. In 1956, based on Buck Ram's advice, The Platters undertook to form a corporation known as "The Five Platters, Inc."

i. Robi, Taylor, Reed, Williams and Lynch were the original stockholders of the corporation.

j. As recommended by Ram, Robi and the other Platters assigned their rights to the trade name "The Platters" to the corporation in exchange for stock in the corporation.

k. Between 1960 and 1965, Ram illegally obtained all the shares of stock in the corporation; The Platters worked as the corporation's employees.

l. Robi left The Platters in 1965 after several disagreements with Ram, after Robi had come to believe that Ram had unfairly taken advantage of Robi and the other Platters, and, apparently, after some personal problems as well.

m. Robi then formed his own, group called "The Platters."

n. From 1965 to the present, there have been two performing groups known as "The Platters." One group is controlled by Buck Ram and his corporation, The Five Platters, Inc. The other group is Robi's.

o. During the period 1967 to 1976, Robi was a defendant in a series of legal actions brought by The Five Platters, Inc. in Los Angeles County Superior Court. This prior litigation spanned a nine-year period.

p. On three occasions, The Five Platters, Inc. attempted unsuccessfully to obtain preliminary injunctions against Robi.

q. This prior litigation resulted in a judgment at trial against The Five Platters, Inc. and in Robi's favor.

r. There has been extensive litigation in California Superior Court concerning the identical claims and issues now brought before this Court by The Five Platters,

Inc. against Robi and against, the owners of venues at which Robi was to, or did, perform.

s. The prior litigation filed by The Five Platters, Inc. involving Robi consisted of the following:

(1) A complaint was filed by The Five Platters, Inc. against Robi, et al. on September 28, 1967 in Los Angeles Superior Court (Case No. 918695) requesting a temporary restraining order, preliminary and permanent injunction against Robi and others, prohibiting Robi from appearing, performing or recording under the name "The Platters."

(2) The Five Platters, Inc.'s application for a temporary restraining order was denied on September 28, 1987.

(3) On November1 , 1967, The Five Platters, Inc.'s motion for preliminary injunction was denied.

(4) This action was dismissed on October 10, 1972 for failure to prosecute.

(5) One month after the first action was dismissed for failure to prosecute, The Five Platters, Inc. filed another complaint against Robi, et al. One of the nightclubs in which Robi was performing was also named as a defendant; early in the litigation, this defendant entered into a stipulated judgment, agreeing to an injunction.

(6) The second action was tried, commencing on September 4, 1974.

(7) A trade name/trademark was issued for the use of the name "The Platters" to The Five Platters, Inc. for one year.

(8) Proof of registration was entered into evidence at the trial. The Five Platters, Inc. also filed a trial brief which argued its trade name/trademark rights to use the name "The Platters."

(9) The trial brief argued that The Five Platters, Inc. was the owner, of the U.S. trademark registration "The Platters"; that The Five Platters, Inc. claimed infringement of its trademark, and that the resolution of the trial turned on questions of trademark law; and that The Five Platters, Inc.'s marks and Robi's marks were similar, and that the parties were in direct competition.

(10) The findings of fact and conclusions of law and a judgment in Robi's favor were filed on November 14, 1974. This Court has adopted the following findings of the Superior Court (Case No. C43926) as binding on the parties in this case.

(a) During the year 1954, a singing group of five individuals began appearing professionally under the name of "The Platters" and Paul Robi was a member of the group.

(b) During the period 1954-1959, when the group became enormously popular, the composition of the group remained the same and included Paul Robi. The name "The Platters" was owned by the five individuals comprising the group as a partnership, and the five individuals, including Robi, are the individuals in the public's mind who comprise the group "The Platters" and were responsible for its success.

(c) The Five Platters, Inc. was formed by a lawyer selected by Buck Ram and shortly thereafter, Robi and the other members of the group executed employment contracts with the corporation where the right to the name "The Platters" purportedly was transferred to the corporation in return for the corporation's stock.

(d) The corporation's stock which was thereafter issued to the members of thegroup was issued illegally and the issuance was void in thatit did not comply with the terms of the permit issued by the Division of Corporations of the State of California.

(e) Robi's purported transfer of his rights in the name "The Platters" to the corporation was never effectuated, since the stock transfer was illegal and in violation of California's securities laws.

(f) Members of The Platters received nothing from the corporation for their interest in the name "The Platters," or other assets of the predecessor partnership, and the corporation was dominated by Buck Ram and was a sham used by Ram to obtain ownership of the name.

(g) An unequal bargaining position existed between Ram and the members of The Platters, including Robi.

(h) The group sponsored by The Five Platters, Inc. includes noneof the people who made the name "The Platters" famous.

(i) The Five Platters, Inc. has been acting with the intention of misleading the public

into believing that the group it is presenting as "The Platters" is the original Platters, and a substantial portion of the public has been misled by the corporation's acts.

(j) The Five Platters, Inc. has been guilty of laches, does not come into equity with clean hands and is not entitled to injunctive relief.

(k) Until January 1956, the name "The Platters" was owned by the five individuals comprising the group as a partnership. Buck Ram represented to the group that it was necessary for the best interest of the group and to protect the group to form a corporation, and that the formation of a corporation would prevent others from utilizing the group name and trading on the group's reputation

(l) At the time the corporation was formed, Buck Ram was a law school graduate, while the members of the group were young and inexperienced in business. An unequal bargaining position existed between the parties. In the years 1962 through 1966, all of the original five members of the group sold their interest in the corporation to Buck Ram as an individual.

(m) The corporation has continued to present and is presenting to the public a group called "The Platters." This group includes none of the five people who made that name famous. Plaintiff has been and is doing this with the intention of misleading the public into believing that the group it is presenting as "The Platters" is the original "The Platters." This group used the same arrangements and fifty percent or more of the the same repertoire and the same singing style as that popularized by the members of the original group.

(n) The Five Platters, Inc. and Buck Ram have misled a substantial portion of the public into believing that the group now presented as "The Platters" is the same as the original group, and a substantial potion of the public is misled by the way the present group is presented.

(o) The representation by Buck Ram that the formation of the plaintiff's corporation was for the best interests and protection of the members of the group was false. The Five Platters, Inc. corporation has been used to obtain the right of the original members of the group to the name "The Platters."

(11) Since the time that the above final and binding determination was entered in 1974, The Five Platters, Inc. instituted litigation against Robi, based on the same claims that were decided by the 1974 judgment.

(12) One such action resulted in an Australian court granting a temporary restraining order against Robi.

(13) There is no evidence that a court hearing was held in Australia or that the Australian court was made aware of the prior California judgment in Robi's favor.

(14) The Five Platters, Inc. sent letters to venues at which Robi was scheduled to or did appear threatening litigation should Robi be permitted to perform using the name "The Platters" in connection with his "act."

(15) These threats have interfered with Robi's ability to pursue his business.

3. The 1974 decision rendered by Judge Levit was adverse to defendants' claim of ownership of their trademark in that the court determined that defendants were not the only parties entitled to use the registered name and, accordingly, denied injunctions prohibiting such use by others, including the plaintiff herein.

4. The defendants in this case are a California corporation, The Five Platters, Inc., Buck Ram, a director of that corporation who owns 60% of its stock, and Jean Bennett, the president of the corporation who is an owner of 80% of the stock of Personality Productions, Inc., which is the owner of 20% of the stock of defendant The Five Platters, Inc.

5. During the period 1968, up to and including the trial in this case, defendants have engaged in acts which prohibited and inhibited plaintiff Paul Robi from performing under the trade name "The Platters."

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24. Defendants are guilty of such conduct. Therefore, punitive damages are awarded in the amount of $2,000,000.

25. Any Finding of Fact deemed to be a Conclusion of Law shall be treated as a Conclusion of Law.

DATED: JANUARY 9, 1989

/s/_____
CONSUELO B. MARSHALL, JUDGE
UNITED STATES DISTRICT COURT

APPENDIX II

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed March 4, 1998]

No. 97-16909

D.C. No. CV95-01029-LDG

MARTHA ROBI,
Plaintiff-Appellant,

v.

HERB REED, et al.
Defendant-Appellee.

APPELLANT'S OPENING BRIEF

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEVADA THE HONORABLE LLOYD D. GEORGE, PRESIDING

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The District Court erred when it granted summary judgment for *Counter-Claimants/Appellees,* Herb Reed, John Villano, and John P. Productions, Inc., (collectively "REED") finding that REED had superior rights over MARTHA ROBI to the musical performing group trademark "The Platters."

A. The District Court erred in not finding that, at a minimum, that there were existing questions of fact (if not conclusively determined in MARTHA ROBI's favor) of whether REED was in privity with or had a mutuality of interest with The Five Platters, Inc., and its President, Jean Bennett, that barred REED's counter-claims based upon this Court's decision in Martha Robi vs. The Five Platters, Inc., Jean Bennett and Buck Ram 918 F.2d 1439 (9th Cir. 1990), upholding the judgment and finding of the California District Court in

B. The District Court's decision is also erroneous in the District Court's determination of ownership rights to the "goodwill" of the musical partnership "The Platters." The District Court reasoned that under Partnership Law (pertaining to partners in a musical performing group) that the last partner remaining in a group (apparently REED), when all other partners have "left the group," owns all of the goodwill to the trademark. There are questions of fact and errors of law in that: (1) None of the "Original Platters", Tony Williams, David Lynch, Zola Taylor and Paul Robi, left a partnership that they owned and controlled as partners. (2) There are questions of fact if these partners "left" an organization, The Five Platters, Inc., controlled by RAM and REED, which had misappropriated all of the original partners partnership property and goodwill. (3) California Partnership Law, which would govern the determination of rights in a dissolution of a 1954 Platters musical partnership, which law the District Court did not consider, would result in a conclusion contrary to that of the District Court, and would find REED's conduct from 1960 to 1996 was adverse to the interests of the original Platters partnership. REED would not be entitled to any of the goodwill or trademark right of "The Platters" partnership whatsoever.

C. The District Court also erroneously concluded that, as a matter of law, that "Original Platter," Paul Robi (Appellant Martha Robi's deceased husband) could not, prior to the time of his death in February, 1989, have transferred to his wife and heir, Martha Robi, Paul Robi's rights and interest in the goodwill to the musical trademark, "The Platters." The District Court erred in finding, as a matter of law, that Martha Robi cannot, as a "non-performing" owner, hold rights in a musical performing group trademark.

The District Court erred procedurally, in that prior to granting Summary Judgment in favor of REED, The District Court granted REED's request for a Protective Order, and denied Martha Robi's request to complete outstanding discovery under FRCP 56(f), precluding Martha Robi from inquiring into REED's past and/or present relationship with The Five Platters, Inc., and Bennett.

The District Court then further erred under Federal Rule of Evidence 201(a) and 201(d) by not granting Martha Robi's Request to Take Judicial Notice of the files of both the December, 1996, Nevada Bankruptcy Court filing of The Five Platters, Inc., and the files of the District Court of the Southern District of Florida in the 1984 case of The Five Platters, Inc. v. Reed, Case No. 84-8324 (in which the Ninth Circuit Motions Panel did grant judicial notice over REED's objections), both of which demonstrated that there is, at a minimum, a question of fact whether or not since April 1, 1975, REED has been in privity with and had a mutuality of interest with The Five Platters, Inc., and Bennett, with regard to the trademark "The Platters."

The District Court erred in not granting Martha Robi summary adjudication of issues and in not dismissing REED's counterclaim as barred by the doctrine of claim and issue preclusion as enunciated by this Court in Paul Robi v The Five Platters, Inc., 838 F2d 318 (9th Circ., 1988) and by dismissing ROBI's counter-claims in Reply against REED

Martha Robi does request attorney's fees

THE DISTRICT COURT COMMITTED ERROR IN GRANTING SUMMARY JUDGMENT IN FAVOR OF REED 21

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(CR 142, ER 123). Martha Robi's Appeal is timely as provided by FRAP 4(a) (1). ROBI's right to appeal is provided by 28 U.S.C. 1292(a) (1). The Judgment entered by the District Court (CR 141, ER 122) is not a final judgment within the meaning of 28 U.S.C. 1291, in that the District Court has reserved for adjudication the issue of damages (Judgment at 10:7-9) (CR 141 ER 122)[1] though the judgment grant of a "Permanent Injunction", against Martha Robi (Judgment at 9:20-23; CR 141, ER 122). The Judgment is interlocutory and appealable under 1292(a) (1).

The District Court's entry of a "Permanent Injunction", presents to this Appellate Court the identical procedural

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[1] On December 6, 1997, Martha Robi moved this Court, among other matters, to exercise pendant appellant jurisdiction, which the Motions panel did not address.

disposition described in Marathon Oil v. U.S., 807 F.2d 759, 764 (9th Cir. 1986).[2]

Under the doctrine of pendant appellate jurisdiction, ROBI seeks review of the underlying Summary Judgment Orders at this time, asserting that the District Court's granting of Summary Judgment is "inextricably bound up" in the District Court's orders granting and denying preliminary injunctive relief. All claims and counterclaims have been

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[2] In Marathon, supra., this Court held:

". . .The entry of summary judgment and partial dismissal, however, was not a final judgment within the meaning of 28 U.S.C. Sec. 1291 because the district court retained jurisdiction to conduct an accounting. . . . Therefore, the injunction, although permanent in nature, is an interlocutory order appealable under section1292(a) (1).(Citations)

* * *

. . . [W]e see no need to refrain from determining the validity of the legality and enforceability if the order is inextricably bound up with the injunction that requires Marathon to comply with the orders. The district court has completed its consideration of the liability issue, retaining jurisdiction only for an accounting of damages. We conclude therefore, that we have jurisdiction pursuant to section 1292(a) (1) to review the summary judgment and partial dismissal and that we should do so in this case. . ." Marathon, supra, at 807). (Emphasis added.)

adjudicated (CR 141, ER 122). The record is complete as to all substantial issues.[3]

STATEMENT OF THE CASE

On October 26, 1995, Appellant Martha Robi filed her Complaint asserting unfair competition, and other tort claims against REED, REED's manager and agent John Valano, and J.P. Productions, and others not directly associated with REED (CR 1, ER 1). On December 15, 1995, REED moved Court to Dismiss or change venue (CR 7, ER 2).[4]

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[3] ". . .Although the Supreme Court has indicated that the doctrine of pendant appellate jurisdiction should be limited, Swift vs. Chamber County Commerce, 514 U.S. 35, 115 S. Ct. 1203, 1208-1212 (1995), the Supreme Court also found that pendant appellant jurisdiction is appropriate when the "non-reviewable orders were" inextricably intertwined with the reviewable order. . ." Swift v. Chamber County, supra., 115 S.Ct. at 1208-1212.

[4] Also on December 20, 1995, REED filed a parallel action as plaintiff, asserting claims pertaining to the same ownership of trademark issues in the United States District Court for the Southern District of New York, not informing the New York District Court of the Nevada Action (Exhibit F to the December 18, 1995, Affidavit of REED in Support of Motion to Dismiss (CR 8B, ER 3)).

On April 24, 1996, pending the District Court's consideration of REED's Motion to Dismiss, Martha Robi applied for a Temporary Restraining Order and an Order to Show Cause why a Preliminary Injunction should not issue, precluding REED from interfering with Martha Robi's activities of promoting and

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Motion for Summary Adjudication of issues, denied Martha Robi's Request to take Judicial Notice of the Nevada Court's Bankruptcy filing of The Five Patters, Inc., and issued a permanent Injunction enjoining Martha Robi from any further use of the tradename The Platters (CR 141, ER 122).

On October 1, 1997, Martha Robi filed her Notice of Appeal (CR 142, ER 123). On October 6, 1997, Martha Robi filed an Ex Parte Application for a temporary stay of injunction (CR 144). On October 8, 1997, the District Court, in part, granted a stay and set a scheduling order for briefing of the parties (CR 155, ER 125) .

On October 22, 1997, Martha Robi filed her Request to Take Judicial Notice of the U.S. District Court for the Southern District of Florida files of The Five Platters, Inc. v. Reed, Case No. 84-8324 (CR 162, ER 126), which included an eight (8) page April 1, 1975, Agreement between REED and The Five Platters, Inc. (CR 162-2, ER 128), and a December 10, 1987 Agreement between The Five Platters, Inc and REED (CR 162-6, ER 129).

On October 28, 1997, The District Court denied Martha Robi's Request for a Stay of the prohibitory elements of the injunction, pertaining to her use of the trademark "The

Platters, and granted a stay to the mandatory aspects of the injunction (Court Minutes of October 28, 1997 hearing (CR 168, ER 130); Transcript of Proceedings (CR 168-1, ER 132)).

On December 5, 1997, Martha Robi filed a Motion with the Ninth Circuit Motions Panel, for an order, expediting the Appeal, staying the Injunction, pending appeal, for an Order to have Martha Robi's Motion papers be deemed the Opening Brief in the Case, requesting the Appellate Court to Take Judicial Notice of certain filings in the Five Platters, Inc. vs. Reed Florida District Court 1984 Case No. 84-8324, and requested injunctive relief enjoining REED from proceeding with his litigation against Martha Robi. The

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for the Central District of California. Martha Robi vs. Five Platters, Inc., supra, 918 F.2d 1439 (CR 51-6, ER 54).

24. ROBI brought a Motion for Summary Judgment against FPI, based upon the 1974 California Judge Levitt's decision, which motion was upheld based upon the doctrine of claim and issue preclusion, which decision of the District Court granting Summary Judgment was upheld in Paul Robi's favor against FPI in 1988. Robi vs. Five Platters, Inc., supra, 838 F.2d 318, 323-324 (CR 56-75, ER 53).

25. Unknown to ROBI, in 1984 FPI had sued REED for violating the April 1, 1975 agreement in the Florida District Case 84-9873. (CR 162-1, ER 127) Request to Take Judicial Notice (CR 162, ER 126). Upon ROBI's grant of Summary Judgment in ROBI's favor by the District Court in California, REED attempted on several occasions to

utilize the ROBI decisions in California as collateral estoppel against FPI, without success. (9th Cir.-2-5, ER 140) Florida District Court acknowledging California Orders denied REED summary judgment.

26. In the Florida District Action in 1987, REED introduced before the Florida District Court all the favorable Robi vs. Five Platters, Inc, decisions obtained before the California Superior Court in 1974 and Judge Marshall's Summary Judgment of 1985. (9th Cir.-2-5, ER 140) The Florida District Court would not grant REED collateral estoppel based upon the Robi Judgments, but indicated the Florida District Court would reconsider, if this Ninth Circuit upheld Judge Marshall's decision on appeal. (9th Cir.-2-5, ER 140) Prior to this Ninth Circuit upholding Paul Robi's decision on summary Judgment (the January 27, 1988 decision Robi vs. Five Platters, Inc., 838 F.2d 318), REED entered into a second agreement with FPI on December 10, 1987, again ratifying FPI's rights, affirming his status as FPI's licensee, agreeing to assist FPI in litigation and enforcement of the FPI rights, and it provided as so long as FPI had rights, REED would be bound by this agreement in favor of FPI. (9th Cir.-2-5, ER 140) REED/FPI December 10, 1987 Agreement (CR 168-6, ER 129)

27. In 1989, ROBI's claims against FPI, Bennett and RAM went to trial and resulted in a judgment against FPI, Ram and Bennett three million five hundred thousand dollars ($3,500,010.00), a cancellation of the FPI three (3) trademark registrations, and the entry of a permanent injunction in favor of ROBI against FPI, Bennett and RAM and those actions on their behalf from taking any action, any litigation, or communicating to anyone, that Paul Robi did not have rights to the name The Platters. Martha Robi vs. Five Platters, Inc., 918 F.2d 1439 (CR 56-76, ER 54)

28. In February 1989, Paul Robi died, Martha Robi was substituted as the party Plaintiff in the case, Bennett, FPI and Ram filed bankruptcy and took the case on appeal to the Ninth Circuit. Martha Robi vs. Five Platters, Inc., 918 F.2d 1439 (CR 56-76, ER 56)

29. On May 30, 1990, an amended judgment was entered by the California District Court in favor of Martha Robi, which judgment awarded Martha Robi damages, and a permanent injunction against FPI, Jean Bennett, Ram, and those associated with them, from initiating litigation, or in any manner interfering with Martha Robi's (not Paul Robi's) rights or communicating to anyone that ROBI did not have rights in the name The Platters. (ER 56-73, ER 51) (Injunction at page 2 of Judgment)

30. Martha Robi then undertook considerable effort and expense to establish rights in District Courts and before the public from 1989 to 1996. (CR 56-77, ER 95; CR 56-78, ER 56; CR 56-79, ER 57; CR 56-80, ER 58) REED took no action to claim rights until in 1996 when ROBI applied for a U.S. registration. REED then filed an opposition. REED then in 1996 commences sending letters

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the request to take judicial notice is mandatory under Federal Rule of Evidence 201(d), as Martha Robi requested in this case, Appellant has not found authority setting forth the standard of review.

SUMMARY OF ARGUMENT

The District Court's basis for granting Summary Judgment finding that all rights to "The Platters" trademark belonged to REED was that REED, as the last member of The Platters who left the group, owned the rights to the trademark. This finding on Summary Judgment is erroneous in its application of the facts and consideration of the Law of Partnership.

The District Court's finding on summary judgment that Paul Robi cannot transfer to Martha Robi rights in a musical performance group trademark is erroneous as a matter of law, and is not based either upon any factual basis in the record as to the public's recognition of The Platters as being associated with particular performers, and is supported as a matter of law.

The District Court's granting of REED's motion for a protective order and denial of Martha Robi's timely Motion under Rule 56(f) for continuance of the Summary Judgment Motion to take discovery of matters pertaining to REED's relationship with The Five Platters, Inc., information clearly within REED's knowledge and not readily available to Martha Robi was an abuse of discretion.

The District Court's denial of Martha Robi's request to take judicial notice, under Federal Rule of Evidence 201(d), of court orders and documents filed in the Nevada Bankruptcy Court and the District Court for the District of Florida, in Case CV 84-9873 including 1997 court orders directly pertaining to REED's position taken before the Florida District Court (9th Cir.-2-5, ER 141) was clearly an abuse of discretion.

The District Court committed error in dismissing Martha Robi's counterclaim in Reply and committed error in not granting Martha Robi's Motion for Summary Adjudication of Issues against REED, when considering the evidence presented in the Martha Robi's Request to Take Judicial Notice.

ARGUMENT
THE DISTRICT COURT COMMITTED ERROR IN GRANTING SUMMARY JUDGMENT IN FAVOR OF REED

The District Court granted summary judgment on its own theory not advanced by either party. As the District Court held in its Order, REED's premise was that REED owned all the rights to The Platters in 1997 because ". . . in 1953, he formed a musical group and named it The Platters . . ." (Order at 3:6-8) (CR 140, ER 121) The Nevada District Court Order does not accept REED's basic premise, and held that ". . . Although rights to a mark arises from prior use, the Court also notes that when a partner brings a valueless name to a partnership, which then gains value through the joint effort of all the partners, the name is deemed property of the partnership. . ." (Order 3:10-15) (CR 140, ER 121)

While the Nevada District Court's premise that the name "The Platters" was partnership property as of 1954 appears unquestionably correct, and is consistent with all prior state and federal court decisions that have addressed this matter, the District Court Opinion becomes anomalous in reaching its conclusion that, forty-three (43) years later, as of 1997, all partnership property in the 1954 Platters Partnership of Williams, Taylor, Lynch, Robi and Reed belong to REED because REED was the last to leave the group. "Since Reed was the original member who remained with The Platters as

the others left, it is Reed who now owns the exclusive right to the mark The Platters." (Order at 7:2-3.) (CR 140, ER 121)

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In Smith v. Bull, 50 C.2d 294; 325 P.2d 463 (1958), the California Supreme Court found that the Estate of a deceased partner was entitled to an accounting for goodwill from the partners that carried on the business; "continuing partner liable to deceased partner's widow for $26,695.83, in value of goodwill of the ongoing service business, after partnership dissolved, as part of the winding up of the affairs of the partnership" (Smith, supra. at 302). ". . . Appellant continued to operate the business and to capitalize on the goodwill of the business as a going concern. This was an asset of the partnership which he was using for his own benefit. . ." (Miller v. Hall, 656 CA.2d 200 (1944)); continuing partner required to account to partner that left the partnership for the goodwill, appropriated by the partner that continued the business (Miller, supra, at 206)). Contrary to the District Court's Order in this case (CR 140, ER 121), even if partners do leave a partnership, the remainin9 partners must account to the departing partners or their heirs (Martha Robi, for one).

As to the rights to the goodwill of departing partners, California Corporations Code Section 15038(3) also provides for ". . . The rights of partners to partnership property. . ." under dissolution caused by wrongful acts of a partner when dissolution is caused in contravention of the partnership agreement, the rights of the partners shall be as follows:

> ". . . (b) The partners who have not caused the dissolution wrongfully, if they all desire to

> continue the business in the same name, either by themselves or jointly with others, may do so. . ."

The Nevada District Court in its Decision found ". . . that Williams, Taylor, and Paul formed a new group in 1967, and identified themselves as The Platters, did not divest the original group of its exclusive right to the name, since none of the individuals had taken with them the right to use the name. . ." (CR140, ER 121) (Order at 6:15-18) The District Court's conclusion is simply inconsistent with California Corporations Code Section 15038(2) in that there are questions of facts that, if REED undertook acts inconsistent with the partnership by supporting the claims of FPI as against the partners. The REED 1967 testimony, stating that FPI owned all rights to the trademark (CR 56-49, ER 33), the July 12, 1968 letter of REED asserting exclusive rights owned by The Five Platters, Inc.) (CR 56-48, ER 32.) According to California Corporations Code 15038(2) The Robi Platters, formed when Robi left in 1965, were entitled to carry on the business of the Platters partnership. California Corporations Code further states:

> ". . . (c) (with regard to a partner who has caused dissolution wrongfully) A partner who has caused the dissolution wrongfully shall have. . . If the business is conducted under paragraph (2) (b) (the) right to have the value of his interest less any damages caused to his copartners. . . but in ascertainment the value of the partner's interest the value of the goodwill of the business shall not be considered. . ." (If REED caused the dissolution by wrongful acts, REED is the one not entitled to an accounting for goodwill, not

the partners who left The Five Platters, Inc. controlled group).

Also, if the District Court is correct that REED was the remaining partner, REED had a fiduciary duty to those that left. In Rosenfeld, Myer & Sussman v. Cohen, 146 Cal.App.3d 200, 194 Cal.Rptr. 180 (Aug. 1983), the Court stated that with regard to a partnership that had been dissolved ". . . a partner of a dissolved

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"The Platters," in that the "partnership property" had been misappropriated by The Five Platters, Inc., (CR 56-74, ER 52) (Findings, Para. (10) (a) to (o), p. 6 to p. 9, January 5, 1989, CV 84-3326 CBM), (with REED's assistance) (then under California Corporations Code Section 15038(2) (b)), the partnership goodwill came to reside in the "ROBI Platters" group (the non-breaching partners), not the continuing "Five Platters, Inc., Platters" group, which included breaching partner REED. REED, who continued to support and ratify the acts of The Five Platters, Inc. (CR 1622, ER 128) appears to have forfeited his rights to partnership goodwill under California Corporations Code Section 15038(c) (2) (II).[10]

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[10] ROBI's Counter-claims in Reply (CR 103, ER 97) p. 22: paras. 20 to 25) asserted breach of partnership duties by REED, which claims were dismissed by the Nevada District Court (Order, 3:24-26; CR 140, ER 121).

REED WAS IN PRIVITY WITH THE FIVE PLATTERS, INC. AS OF APRIL 1, 1975

Also the District Court two authorities involving the Boogie Kings, supra, or the Buckinghams were cases undertaken apparently immediately upon the partnership dissolution. The Nevada District Court's decision purports to resolve the partnership dissolution of the 1954 Platters partnership in 1997, forty (40) years after its dissolution after numerous State and Federal Courts decisions, pertaining to the rights to The Platters. Partnership analysis does not resolve the effect of forty-three (43) years of differing decisions applicable to the different members of the "Original Platters." As this Circuit Court found in Robi v. Five Platters, Inc., 838 F.2d 318, (1988) (Ex. No. 8, 321), original member Paul Robi won, original member WILLIAMS lost, and original member Zola Taylor stipulated to an adverse injunction (Robi, supra., 838 P.2d 318 at 321, fn. 1). REED as well during

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(b) As to the issuance and ownership of stock by The Five Platters, Inc., on April 1, 1975, at Paragraph "B," REED and FPI agree:

> ". . . FPI was formed in 1956. At the time of its formation it was contemplated that FPI would be jointly owned by the members of the original Platters, and its stock was attempted to be issued to such members. In or about 1964, it was discovered that such stock issue was defective, in that the permit for the issuance of such stock had not been complied

with. Nevertheless, all of the parties receiving such stock, and in particular the parties hereto, have at all times treated it as validly issued and validly transferable, and such stock has at times been transferred among various of the original members of the Platters and some of the parties hereto.[11]

(c) REED agrees that, as of April, 1975: ". . . that FPI was and is a validly formed and existing corporation, which is owned by the parties hereto. . ." (Emphasis added) (CR 162-2, ER 128)

(d) The April 1, 1975, Agreement provided that FPI shall ". . . render to REED a full and complete accounting of all of its activities for each fiscal year ending 1969 through 1974. . ." for that period of use (Para. "B").

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[11] REED, in 1996, changes his position and now, in his Affidavit, attempts to adopt, twenty-three (23) years later, the 1974 Robi v. Five Platters, Inc., finding: ". . . My supposed assignment of rights to the corporation and supposed relinquishment of ownership of such rights were fraudulently obtained, not understood, and ineffective. . ." (REED Aff. in Opposition to Motion for Preliminary Injunction and in Support of Motion for Summary Judgment (CR 56-100, ER 77), para. 43, last sentence. The fundamental problem with this position by REED in 1997 is that the District Court Judge in Florida District Court Five Platters v. Reed 84-C3778 rejected REED's attempted switch in sides, not finding that finding binding on REED's behalf against The Five Platters, Inc., Ninth Circuit granting of Robi's Request to Take Judicial Notice (9th cir-2-5, ER 141)

(e) REED also agreed at Paragraph 4(a) (Vol. 8, 2176), that ". . . neither Reed nor any of his agents, employees . . . shall utilize the name 'The Platters' and that . . . REED may present himself and his group as 'Herb Reed, formerly of The Platters'. . ." (CR 1622, ER 128)

(f) And on April 1, 1975, REED promised FPI that he ". . . shall assist FPI in all of its litigation and other proceedings undertaken against persons utilizing the name 'The Platters'." (CR 162-2, ER 128)

(g) At Paragraph No. 6 of the April 1, 1975, Agreement, REED agreed that ". . . Ram, Bennett, FPI and PP shall use their best efforts to assist Reed in obtaining advantageous employment for music groups with which he performs. . ."

(h) The April 1, 1975, Agreement provides at Para. No. 7 that the Reed v. Buck Ram lawsuit, Case No. C-960429, and The Five Platters, Inc., lawsuit in Florida, Case No. 69-13784, were both dismissed with prejudice.

The Nevada District Court in its September 26, 1997, Order in this case (CR 140, ER 121 at 5:1-9) references the California Superior Court's November 14, 1974 findings as to the exchange of stock for rights in the name "The Platters," and questions why this finding is supportive of ROBI but not REED:

> ". . . this Court will likewise adopt the following findings of the California Court, which are binding upon Robi:
> Robi has failed to offer any argument, nor could she, suggesting that the group's assignment of the name owned by the group

was ineffective as to Paul but not as to REED. . ." (CR 140, ER 121, at 5:10-11).

The answer to the Nevada District Court's question is found in the April 1, 1975, REED/FPI Agreement (CR 162-2, ER 128) and more particularly in the Florida District Court Order of May 5, 1987 (9th Cir.-2-5, ER 141) in which the Florida District Court in Five Platters, Inc. v. Reed rejected REED's claim of collateral estoppel, and invites REED to resubmit his Motion if the Ninth Circuit upholds the Robi/FPI District Court decision. REED does not wait for this Appellate Court to rule and enters into a second agreement with The Five Platters, Inc., on December 10, 1987 CR 162-6, ER 129), one month before this Court renders its decision in Robi vs. Five Platters, Inc., supra, 838 F.2d 318.

ROBI suggests that the April 1, 1975, Agreement of five (5) months after the entry of the Findings by the California Superior Court, adverse to FPI, establishes that REED was in privity and had a mutuality of interest with FPI as of April, 1975, and that REED ratified the acts of FPI, and that again in the December 10, 1987 FPI/Ram Agreement (CR 162-6, ER 129) REED ratified the acts of FPI, which though REED has an opportunity by the District Court in Florida to await the decision of whether this Circuit Court will affirm Judge Marshall's decision favoring Paul Robi to obtain collateral estoppel (9th Cir. 2-5, ER 140), REED does not do so but enters into a Second Settlement Agreement on December 10, 1987, approved by the Florida District Court Judge.

It was an abuse of the Court's discretion, under Federal Rule of Evidence 201(d), not to take judicial notice of the Florida Court files. The court file of the United States District Court of the Southern District of Florida Case No 84-

8324 was subject to Federal Rule of Evidence 201(d) Request to take judicial notice Mullis v. United States Bank Ct. 828 F.2d 1385, 1388 (9th Circ., 1987).

Federal Rules of Evidence 201(d) is mandatory and requires the court to take judicial notice of "adjudicative facts." Adjudicative facts are those documents that consist of court files in other lawsuits, including orders in those lawsuits, including the Florida District Court Five Platters Inc. vs Reed District Court Case 84-8324, and the bankruptcy proceeding of The Five Platters, Inc. in the Nevada Bankruptcy Court.

* * *

APPENDIX JJ

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

[Filed June 3, 1998]

No. 97-16909

D.C. No. CV95-01029-LDG

MARTHA ROBI,	)
Plaintiff-Appellant,	)
	)
v.	)
	)
HERB REED, et al.	)
Defendant-Appellee.	)
	)

APPELLANT'S REPLY BRIEF

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEVADA THE HONORABLE LLOYD D. GEORGE PRESIDING

I.

INTRODUCTION

A. Appellant Martha Robi (MARTHA ROBI) asserts that her rights in the trademark "The Platters" is superior to that of Appellee Herbert Reed (REED). REED asserts to the contrary that his rights are superior to those of MARTHA ROBI.

B. ROBI first asserts that she prevails on Appeal in that there are questions of fact (if not conclusively decided in MARTHA ROBI's favor) that REED was in privity with or had associated himself with The Five Platters, Inc. during the period 1966 to 1996, and that, based upon REED's privity with the FPI, REED's claim of rights to "The Platters" trademark, vis-a-vis ROBI, were no better than those of the Five Platters, Inc., over whom MARTHA ROBI had prevailed and had obtained a permanent injunction enjoining the Five Platters, Inc., Ram and Bennett, and those associated with the Five Platters, Inc. (including most likely Herbert REED), from taking any action, in court or otherwise to interfere or inhibit MARTHA ROBI's use of the trademark "The Platters" (CR 56-73, ER 51), affirmed by this Appellate Court in Martha Robi vs Five Platters, Inc., 918 F.2d 1439 (9th Cir. 1990) (CR-56-76, ER 54).

C. ROBI asserts that the Nevada District Court could not under any legal theory provide offensive collateral estoppel granting to REED the benefit of all of the findings which Paul and MARTHA ROBI obtained in their twenty-five (25) years of litigation against the Five Platters, Inc., especially when the sole purpose of granting REED the benefit of those rights won by ROBI was to allow REED to defeat the rights MARTHA ROBI the

court and only those portions referred to in the summary judgment memoranda." (REED's Brief at 24).[1]

2. In dispute is ROBI's Request to Take Judicial Notice and those documents accompanying that request pertaining to the Five Platters, Inc. vs. Reed Southern District of Florida Case No. 84-8324 litigation (CR 162 and CR 162-1 to 162-6, ER 126, ER 127, and ER 128).

3. Though REED asserts (Brief of REED at 15), "In sum the only materials ROBI properly placed before the district court in opposition to summary judgment appear at Tabs 92-93 (CR 97 and 98 A) and Tab 15, 32, 35, 48, and 52. (Exhibits referenced in ROBI's summary judgment opposition.)" ROBI's review of her submission to the District Court in her Opposition to Summary Judgment, Tabs 92-93 (CR 97 and 98A) indicate references to the following Tabs: 52, 53, 54, 34, 35, 70, 15, 48, 50, 66, 32, 17, 18, 70, 106.)

4. Given REED's correct citation to Local Rule 56.1 of the Nevada District Court, requiring the party to

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[1] REED is also correct in REED's citation to Local Rule 56.1 of the Nevada District Court (Brief of REED at 6 (Note 1)) which requires that "Motions for summary judgment and responses thereto shall include a concise statement setting forth each fact material to the disposition of the motion which the party claims is or is not genuinely in issue, citing the particular . . . evidence on which the party relies." Given the above, REED's position on Appeal is restricted to those issues and evidence presented in REED's specific listings of issue of fact in REED's Motion for Summary Judgment (CR 87, ER 86).

"Cit(e) the particular portion. . . of the evidence on which the party relies, that Rule as well limits REED as to what evidence REED can present "in the record," The Record on REED's Motion for Summary Judgment is limited as well to REED's Statement of Undisputed

* * *

APPENDIX KK

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed October 4, 1996]

Case No. CV-S-95-10129-LDG (LRL)

MARTHA ROBI, an individual,
Plaintiff,

v.

HERB REED, an individual, dba HERB REED and THE PLATTERS, an entity unknown; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation; THE FIVE PLATTERS) INC., a California corporation.
Defendants.

POINTS AND AUTHORITIES IN OPPOSITION TO THE MOTION FOR SUMMARY JUDGMENT

I.

INTRODUCTION

A. Herbert REED ("REED") has moved this Court for an Order granting Summary Judgment, among other matters,

* * *

[4]

who himself had assigned all of his rights to "The Five Platters, Inc.," avoids that assignment which would have divested him of all trademark rights relying only upon ROBI's victories in the California State Court, and before the District Court of Calitornia, and the Ninth Circuit Court of Appeals in which ROBi obtained certain findings that "The Five Platters, Inc.," obtained the rights from ROBI unlawfully, and than the California Courts in favor of ROBI found that the assignments were deemed ineffective (REED cites to the Robi v. The Five Platters, Inc., 918 F2d 1439 (1990), the case which in which ROBi was through considerable effort and energy the victorious party).

C. What is of course totally inconsistent is that while REED wishes this Court to accept the findings of the California State Court and the District Court and the Ninth Circuit Court of Appeals with regard to some matters, REED wishes this Court to ignore specific findings from the California State and Federal Court and the Ninth Circuit Court with regard to other matters totally inconsistent with REED's claim of rights and Summary Judgment in this case.

D. Plaintiff refers this Court to the Findings of Fact and Conclusions of Law of Judge Consuelo R. Marshall

in U.S. District Court Case CV 843326 (Exhibit No. 74 at the Preliminary Injunction, admitted at that time).

E. REED argues that he has exclusive rights in that he first used the trademark. (Even though this is not set forth in the Statement of Facts at Issue).

F. Certain findings in the Federal Court Action are totally inconsistent with Herbert Reed's claims to ownership and exclusive rights of the trademark.

G. The District Court in California (upon which REED relies in finding that his assignment to "The Five Platters, Inc.," was ineffective) also found at Paragraph (10) (b) ". . . During the period 1954-1959, when the group became enormously popular, the composition of the group remained the same and included Paul Robi. The name "The Platters" was owned by the five individuals comprising the group as a partnership, and the five individuals including Robi, are the individuals in the public's mind who comprise the group 'The Platters' and were responsible for its success. . ." (This was the same finding of the Los Angeles Superior Court in 1974 which was adopted by the U.S. District Court in its findings in 1989, Exhibit No. 74 upon which Herbert Reed relies). The findings of the District Court were upheld by the Ninth Circuit in Exhibit Nos. 75 and 76 presented at the Preliminary Injunction Hearing. Robi v Five Platters, Inc., 838 F2d 318 (1988) and Robi v. Five Platters, Inc., 918 F2d 1439 (1990).

H. In that the Court found that the five (5) individuals, Paul Robi included, owned the tradename "The Platters" as a partnership, and ROBI is the successor in interest to her husband Paul Robi, REED's interest if it exists at all is that of one (1) of five (5) Platters to include Zola

Taylor who is still alive, to include Mrs. Robi, to include Helen williams and to include the Meirs of David Lynch.

I. REED assumes that the findings of the District Court as to the partnership are of no importance, and that the findings that the five (5) individuals (not REED alone) made the name famous and generated its great good will are of no importance. And REED assumed that the other findings of the Court ". . . when Robi joined the group he assisted the other Platters with musical arrangement and organized and let the groups rehearsals . . . . " was of no importance.

J. ROBI also in the Preliminary Injunction hearing put into evidence the recording contracts of the original "Platters" ROBI included Exhibit No. 8, the March 21, 1955 Contract. On the last page of the Exhibit No. 8 1955 Contract, REED, along with Rob and the other original "Platters" ". . . warrant that they (collectively) are the owners of the copyright issued in connection with the name 'The Platters'." (Herbert Reed's name is right below that of Paul Robi (Last Page Exhibit). The second Recording Contract of 1959 (Exhibit No. 52 entered into evidence at the Preliminary Injunction Hearing) at Paragraph 20, Page 8 two (2) pages before the signature page states ". . . The individuals singing the agreement comprise the vocal group known as 'The Platters' and do hereby warrant to Mercury that they are the true and lawful owners of the exclusive right to use the name 'The Platters'."

K. REED signed Exhibit No. 52 as both a member of "The Platters," and as President of "The Five Platters, Inc."

L .Now thirty-five (35) years later after REED signed two (2) recording contracts in which he agrees that the

five original individuals own the name "The Platters" jointly and equally, and after REED relies on a Court decision which finds that the name was owned by the partners, all of whom made the name famous, REED now asserts that he is the exclusive owner of the name.

* * *

[8]

that the five Platters or their heirs obtain and receive royalties from the sale of records under the 1955 and 1959 Recording Contracts.

D. Robi Suggests to the Court that REED has serious equitable difficulties, or that there are questions of fact as to these equitable and legal difficulties of REED, with regard to his claim of owning all of the partnership property, to the trademark "The Platters" as follows:

1. Did REED undertake acts inconsistent and indirectly contrary to that of the partnership, by assisting The Five Platters, Inc., to obtain the other partners interest in The Platters. Robi argues that the evidence shows that REED during the period of 1960 to 1969 undertook to assist the Five Platters Inc. in its actions against Robi against Zola Taylor, against Williams attempting to harm his partners in their use of partnership property. There is a question of fact that REED should be estopped from even asserting that he retains any partnership property in that he undertook consistent actions against his partners inconsistent with a claim to the existence of the partnership property.

2. REED apparently undertook to sign contracts with Musicor and receives Royalties from Platters recordings in which none of the Partners other then reed perform

inconsistent with his partnership obligations under Exhibits Nos. 8 and 56.

3. REED apparently appeared on behalf of "The Five Platters, Inc." against Paul Robi in the 1969 litigation asserting that Paul Robi had no rights and that he had given up his rights to the corporation "The Five Platters, Inc." "The Five Platters, Inc." sued Paul Robi in 1967 (Exhibit No. 15) and REED signed a Declaration in Support of "The Five Platters, Inc." in 1967 (Exhibit No. 48) indicating that the corporation owned the trademark and that REED had signed a new recording contract with Musicor (Exhibit No. 48, Page 4, Declaration of REED in support of The Five Platters, Inc.'s claims against Paul Robi in 1967).

4. REED was president of "The Five Platters, Inc." as late as 1969 (Exhibit No. 50 entered into evidence at the. Preliminary Injunction hearing).

5. REED was apparently enjoined by "The Five Platters, Inc.' for period of five (5) years Exhibit No. 66 entered into evidence in the Preliminary Injunction Hearing). And according to REED's own testimony, entered into an agreement in 1975 whereby was enjoined from utilized the name "The Platters" in favor of "The Five Platters, Inc."

6. As opposed to REED, Paul Robi fought "The Five Platters, Inc." from the time he left in 1962 to 1989, did not agree to an injunction and eventually prevailed against them in 1989. Robi spent hundreds of thousands of dollars in his fight against "The Five Platters, Inc." REED now asserts that all of his rights are revived as a result of Paul Robi's victory, although REED asserts that he is the sole owner and not a partner. There is question of fact as to REED's

contribution to the other partners for their efforts in their fight against "The Five Platters, Inc."

7. And there is the question of the other partners' claims against REED for his actions inconsistent with that of the partnership through putting out competitive recordings, and assisting "The Five Platters, Inc."

IV.

CONCLUSION

A. Even if one accepts the fact that REED's alleged rights are revived as a result of ROBI's victory in the California Courts, REED has not established there is no question of law as to what rights were revived. ROBI has requested REED to turn over his documentation showing his agreements with "The Five Platters, Inc.," and REED has refused to do so.

B. The very findings upon which REED relies that his rights have been reestablished also find that the trademark was owned by a partnership.

C. REED's activities may have and appear totally inconsistent over a thirty (30) year period with that of revival of his rights and a full hearing on this matter should be allowed after discovery as requested by ROBI in his Motion to continue the hearing on the Motion for Summary Judgment.

Respectfully submitted,

DATED: October 4, 1996

MAHAN AND ELLIS CHARTERED

By: /s/_____
AVIVA Y. GORDON
Attorneys for Plaintiff
MARTHA ROBI

APPENDIX LL

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

[Filed September 17, 1996]

Case No. CV-S-95-10129-LDG (LRL)

MARTHA ROBI, an individual,
Plaintiff,

v.

HERB REED, an individual, dba HERB REED AND THE PLATTERS, an entity unknown; JOHN VALANO, an individual; J.P. PRODUCTIONS, an entity unknown; TONY CEE ASSOCIATES, an entity unknown; CUZIN RICHARD ENTERTAINMENT ASSOCIATES, an entity unknown; UNITED CONCERT PRODUCTIONS, a New York Corporation; THE FIVE PLATTERS) INC., California Corporation,
Defendants.

DEFENDANTS AND COUNTERCLAIM PLAINTIFFS HERB REED, JOHN VILLANO AND JOHN P. PRODUCTIONS, INC. FOR SUMMARY JUDGMENT WITH POINTS AND AUTHORITIES

Pursuant to Fed. R. Civ. P. 56, defendants and counterclaim plaintiffs Herb Reed, John Villano ("Villano") and John P. Productions, Inc. ("JPPI") move for summary judgment in their favor and against plaintiff and counterclaim defendant Martha Robi:

* * *

[4]

POINTS AND AUTHORITIES

UNDISPUTED FACTS

More than 43 years ago, defendant Herb Reed organized, founded and named the musical group "The Platters." (HR Aff.[1] ¶ 5). Since he formed "The Platters" in 1953, Herb Reed has earned his living solely by singing and performing as "The Platters"-- the group he created. (Id. ¶ ¶ 5-92; DX[2] 1-65).

When he formed the group in 1953, The Platters were Herb Reed, Joe Jefferson, Alex Hodge and Cornell Gunther. In 1954, Jefferson and Gunther ceased performing with Herb Reed, and David Lynch and Tony Williams began performing

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[1] "HR Aff." refers to the Affidavit of Herb Reed, sworn to May 7, 1996, which was admitted at the May 14, 1996 evidentiary hearing.

[2] "DX" refers to Defendants' Exhibits attached to the Affidavit of Herb Reed and admitted at the May 14, 1996 evidentiary hearing.

with him and Alex Hodge as The Platters. After they recorded several songs together as The Platters, Zola Taylor joined them as part of the ensemble. (HR Aff. ¶¶ 5-19; DX 1-5).

Paul Robi began performing with Herb Reed as a member of The Platters in August or September 1954, when he replaced Alex Hodge. Around 1957, plaintiff Martha Robi (then using a different surname) and Paul Robi met one another. (HR Aff. ¶¶ 18-22).

Martha Robi never performed with The Platters. Martha Robi is not a musical entertainer or performer. (Id. ¶ 23).

Herb Reed is the only original member of The Platters who is still personally performing musical entertainment. (Id. ¶ 21).

* * *

[8]

Herb Reed, Villano and JPPI denied the allegations and filed a six count counterclaim against Martha Robi. Herb Reed alleges that he has exclusive rights to "The Platters" mark and, accordingly, Martha Robi is liable to him, Villano and JPPI for violations of 15 U.S.C. §1125(a), interference with contractual and prospective relations, fraudulent application and receipt of state service mark registrations, and unfair competition, deceptive trade practice and false advertising in violation of Nevada statutes and the common law.

On April 24, 1996, Martha Robi applied for a temporary restraining order and order to show cause why a preliminary injunction should not enter against Herb Reed.

This Court denied the restraining order and, on May 14, 1996, held a one-day preliminary injunction hearing.

Under oath as a witness at the hearing, Martha Robi admitted she personally did not use "The Platters" mark until 1988, that she herself is not a musical performer and has never performed under "The Platters" mark, that her former husband Paul Robi did not first perform under "The Platters" mark until August or September 1954, that she understood Herb Reed was performing with The Platters group prior to Paul Robi joining the ensemble, and that the groups she bills and promotes as The Platters have never included any of the singers associated with The Platters in the 1950s.

On August 13, 1996, this Court issued a seven page Order in which it denied Martha Robi's preliminary injunction motion. The Court concluded that "plaintiff has not demonstrated a likelihood of success on the merits." Order at 6.

* * *

[11]

County Cream. Ass'n v. Tillamook Cheese & Dairy Ass'n, 345 F.2d 158, 160 (9th Cir. 1965) ("A right to use a trademark stems from prior appropriation and use.") cert denied, 382 U.S. 903; Bell v. Streetwise Records, Ltd., 640 F.Supp. 575, 579-80 (D.Mass. 1986) ("It is settled law that ownership of a mark is established by priority of appropriation."). Common law rights can be acquired through interstate or intrastate use, and instant commercial success is not required to establish priority. Bell, 640 F.Supp at 580.

Plaintiff has not even attempted to refute Herb Reed's testimony that in 1953 he formed a musical group, named it "The Platters," began using that mark extensively in public performances and, by early 1954, had further used and commercialized the mark to the point of recording songs for Federal Records. (HR Aff., ¶¶ 5-16; DX 1-4). Martha Robi, who did not enter the United States until 1958, has never personally performed using the mark "The Platters." She obviously had nothing to do with Herb Reed's origination and use of the mark in 1953. Martha Robi did not use the mark in any respect until 1988, when she purportedly acquired Paul Robi's rights by assignment. That invalid assignment (see pages 15-16 below) did not convey priority to Martha Robi. Even assuming arguendo Martha Robi assumed Paul Robi's first use of the mark, she remains junior to Herb Reed. It is undisputed that Paul Robi's use of "The Platters" mark did not begin until August or September 1954.[5]

In sum, whether the Court considers Martha Robi's first personal performance under the mark "The Platters" (never), her first non-performance use (1988), or Paul Robi's first use (August-September 1954), she is unquestionably junior to Herb Reed (1953). Accordingly, Herb Reed has ownership of and exclusive rights to "The Platters" mark. Martha Robi has no rights to the mark. Consequently, summary judgment should enter in favor of Herb Reed (as well as Villano and JPPI) dismissing plaintiffs' complaint and for liability on the counterclaim. E.g., New West Corp., 595

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[5] At the May 14, 1996 hearing, all of the witnesses -- Herb Reed, Jean Bennett and Martha Robi herself -- testified that Paul Robi's use of "The Platters" mark did not begin until August or September 1954. (HR Aff. ¶ 18).

F.2d at 1200-1201 (affirming summary judgment under 15 U.S.C. § 1125(a) where no fact issue of priority and both parties were using an identical mark in the same market).

III. EVEN WITHOUT PRIORITY, HERB REED HAS THE RIGHT TO EXCLUDE MARTHA ROBI FROM USING "THE PLATTERS" SERVICE MARK

Even assuming arguendo that Herb Reed's clear priority is somehow not dispositive - which it is -- Martha Robi still cannot, as a matter of law, use "The Platters" mark herself or exclude Herb Reed from using his service mark.

A service mark connotes the goodwill and quality associated with a particular service. When the service mark symbolizes the personal goodwill, skill and ability of a particular individual, the mark cannot be assigned to or appropriated by another person. It is a form of fraud and consumer deception to represent a service as symbolizing the goodwill of a person who is no longer performing the service. McCarthy, Trademarks and Unfair Competition § 18.10[4] at 18-53 (Release #4, 3/95). For those reasons, "the norm in the music industry is that an artist or group generally owns its own name." Bell, 640 F.Supp. at 581.

Here, the Court is faced with a simple choice: Herb Reed, the performer who has used "The Platters" mark for the past 43 years (HR Aff. ¶¶ 5-92; DX 1-65), or Martha Robi, who has never performed and since the purported 1988 assignment has never produced a so-called "Platters" performance that included any original member of The Platters. It is absurd in the extreme for Martha Robi to claim she has rights over Herb Reed.

Even if the Court were to accept plaintiff's contention that Paul Robi, along with Herb Reed, were among the five persons who made famous "The Platters" mark, Martha Robi's claim against Herb Reed still fails. At best, under that scenario (and again ignoring Herb Reed's clear priority only for-the sake of this argument), the goodwill would have been shared personally among Herb Reed, Paul Robi, Zola Taylor, David Lynch and Tony Williams. See PX 70[6] -- Findings of Facts and Conclusions of Law in The Five Platters, Inc. v. 12319 Corp., Los Angeles Superior Court, No. C. 43926 ("The public thought of The "Platters" as the five individual performers [Herb Reed, Paul Robi, Zola Taylor, David Lynch and Tony Williams] and in the public mind, the individuals who comprised the group were responsible for its success.").[7]

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[6] PX 70 is Plaintiffs' Exhibit 70 from the injunction hearing. Copies of that document and Judge Marshall's decision dated January 9, 1989 (marked as PX 74 at the hearing) have been previsously filed with this Court. Defendants will submit additional copies if the Court so desires.

[7] Herb Reed, who was not a party to the case between Paul Robi and The Five Platters, Inc. in which the 1974 findings were made, does not concede the correctness of this finding. The correct result is that Herb Reed, as the founder of, originator of and longest-running performer with The Platters has the goodwill associated with the mark and ownership of the mark. Furthermore, Herb Reed in no way concedes that Paul Robi was one of the original Platters. In fact, the original members of the group were Herb Reed, Joe Jefferson, Alex Hodge and Cornell Gunther. Those four men performed together, appeared on television in 1954, and recorded songs together -- all as "The Platters," -- before Paul Robi joined The Platters.

Such personal goodwill cannot be assigned unless the assigning person's services remain a part of the performances. Lanham Act § 10, 15 U.S.C. § 1060; McCarthy, supra, § 18.10[4].

Here, it is undisputed that Herb Reed is the only original member of The Platters who is still performing. Paul Robi is deceased and Martha Robi has admitted that she has not employed Williams or Lynch (both of whom are deceased) or Taylor as members of the group she promotes as The Platters.[8]

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[8] In this respect, Martha Robi is just like Buck Ram, whom her husband successfully vilified for presenting a group of "Platters" which did not include any of the five persons who performed from late 1954 to 1962. In 1974, the California Superior Court found, in response to Paul Robi's request:

> The corporation [The Five Platters, Inc.] has continued to present and is presenting to the public a group called the "Platters." This group includes none of the five people who made that name famous. Plaintiff has been and is doing this with the intention of misleading the public into believing that the group it is presenting as the "Platters" is the original "Platters."

(PX 70, ¶ 10). In the posttrial decision dated January 9, 1989, Judge Marshall in the Central District of California adopted that finding of the California Superior Court (PX 74, ¶ 2.s(10) (m)), and concluded that Buck Ram's group had misled the public by using "The Platters" name without any original members (PX 74, ¶ 42).

Because Paul Robi is deceased and any personal goodwill he may have had could not be assigned as a matter of law, Martha Robi cannot rely on the purported "Assignment of Trademark."

The supposed assignment is invalid for the additional reason that it was not supported by consideration. Martha Robi testified that all she gave in return was the same support and business services to Paul Robi that she had been giving him prior to the "assignment." (Order at 3). Under the law of California, where the assignment document was allegedly executed, a promise to continue a previous obligation to the other party is inadequate consideration to support a contract obligating that other party (Paul Robi) to do more. Leonard v. Gallagher, 45 Cal. Rptr. 211, 218, 235 C.A.2d 362 (1965).[9]

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[9] Furthermore, the name of a musical group may not be assigned when, as here, the name is associated with the personal goodwill of the performers. In the present case, the goodwill of The Platters mark is associated with Herb Reed, the man who originated the mark and has performed under the mark for the past 43 years. (HR Aff. ¶¶ 5-92; DX 1-65). Martha Robi has no such association. In Marshak v. Green,746 F.2d 927 (2d Cir. 1984), the court held that a musical group's service mark was not subject to attachment because the subsequent auction of the mark would not include a transfer of the performers' goodwill. "Entertainment services are unique to the performers." Id. at 930. The suggestion that assignments might be valid if there is continuity of management or the same quality and style of music is nothing more than dicta and, in any event, is inapplicable in light of the undisputed facts that -- between Herb Reed and Martha Robi -- the goodwill of The Platters mark is associated Herb Reed (the founder and performer) not Martha Robi (the non-performing latecomer).

IV. MARTHA ROBI'S ONLY DEFENSE -- THAT HERB REED CLAIMS RIGHTS THROUGH THE FIVE PLATTERS, INC. -- IS FATALLY DEFECTIVE, BOTH FACTUALLY AND LEGALLY

Tacitly acknowledging the hollowness of her claim to exclude the originator and senior user of "The Platters" mark, Martha Robi has attempted to tar Herb Reed with the adverse judgments against The Five Platters, Inc., arguing that he claims his rights through that alleged corporation. Plaintiff's claim is absolutely false and all evidence is to the contrary. In 1969, Herb Reed disassociated himself from Buck Ram and The Five Platters, Inc. (HR. Aff. ¶ 45; DX 25). Thereafter, Herb Reed and The Five Platters, Inc. were adversaries, litigating against one another. Notwithstanding a limited preliminary injunction and alleged settlement agreement, [10] Herb Reed continued to perform using "The Platters" mark from 1969 to the present. (HR Aff. ¶¶ 45-92; DX 26-65).

Moreover, both the California Superior Court and federal court for the Central District of California have ruled that The Five Platters, Inc. was a sham corporation and that its so-called stock was issued illegally to Herb Reed, Paul Robi, Zola Taylor, Tony Williams and David Lynch:

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[10] Under the November 1987 settlement agreement between The Five Platters, Inc. and Herb Reed, he conditionally agreed not to use the name "The Platters" by itself unless The Five Platters, Inc. was found to have no such rights in such name. In fact, in January 1989, the federal court in California determined that The Five Platters, Inc. has no rights in the name "The Platters" (PX 74), a decision affirmed by the Ninth Circuit in 1990 Robi 918 F.2d at 1443-46.

In January 1956, the plaintiff corporation [The Five Platters, Inc.] was formed by a lawyer selected by Buck Ram. Shortly thereafter, defendant Paul Robi, and the other members of the group [Herb Reed, Zola Taylor, David Lynch and Tony Williams], executed employment contracts with the corporation by which purportedly the rights to the name the "Platters," were transferred to the corporation in return for the corporation's stock. The corporate stock was thereafter issued to the members of the group. This stock issue was illegal and void in that it did not comply with the terms of

* * *

APPENDIX MM

INDEX OF EXCERPTS OF THE RECORD

CR #	Description	Tab #
	Volume I	
CR 1	October 26, 1995, Complaint of Plaintiff, Martha Robi (pp. 1-13) (without Exhibits. Exhibits to the Complaint were put into evidence at the Preliminary Injunction hearing and are prior District Court and Ninth Circuit decision and are a matter of judicial notice.)	1
CR 7	December 20, 1995, REED'S Motion and Memorandum to Dismiss for Improper Venue (pages 1-8 and signature page (21) only)	2
CR 8B	December 18, 1995, Affidavit of Defendant, REED in Support of Motion to Change Venue (with Exhibits Ex. F, the Reed v. Robi N.Y. Complaint, pp. 1-5 only)	3

INDEX OF EXCERPTS OF THE RECORD

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CR 31	April 24, 1996, ROBI's Application For A Temporary Restraining Order and An Order To Show Cause Why A Preliminary Injunction Should Not Be Issued	4
CR 33	April 19, 1996, Declaration of Stanley Jay Blitz	5
CR 37	April 26, 1996, Minutes of the District Court setting a one-day hearing for a Preliminary Injunction	6
CR 56	May 14, 1996, Minutes of the Court, Hearing on Preliminary Injunction held May 14, 1996	7
CR 56-1	Preliminary Injunction Hearing ("PIH"), Ex. No. 1, 1954 Photo of "The Platters"[1]	8

[1] The Preliminary Injunction exhibits admitted at the one (1) day Preliminary Injunction Hearing ("PIH") on May 14, 1996 are identified by separate Tab No. The number associated with an exhibit admitted at the Preliminary Injunction hearing CR 56, i.e.,

INDEX OF EXCERPTS OF THE RECORD

CR #	Description	Tab #
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CR 56-2	PIH, Ex. No. 2, 1955 Photo of "Zola Taylor and Paul Robi of the Platters"	9
CR 56-3	PIH, Ex. No. 3, Album Cover, "Encore of Golden Hits, The Platters"	10
CR 56-4	PIH, Ex. No. 4, 1950's cover page Souvenir Program, "The Platters"	11
CR 56-7	PIH, Ex. No. 7, Mercury Record Album Cover, "The Platters"	12
CR 56-13	PIH, Ex. No. 13, July 6, 1956., Minutes of Board of Director's Meeting of The Five Platters, Inc.	13

CR 56-1, is the exhibit number by which the exhibit was identified and admitted at the hearing.

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CR #	Description	Tab #
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CR 56-14	PIH, Ex. 14, Registered May 15, 1973, U.S. Patent Office Registration of Service Mark for "The Platters," No. 959, 115, certified February 15, 1983	14
CR 56-15	PIH, Ex. 15, September 28, 1967, Complaint for Injunction, The Five Platters, Inc. v. Taylor and Robi, Los Angeles Superior Court, Case No. 918695	15
CR 56-18	PIH, Ex. 18, November 21, 1972, Complaint for Damages and an Injunction, The Five Platters, Inc. v. 12319 Corp., Paul Robi, Los Angeles Superior Court Case No. C43926	16
CR 56-19	PIH, Ex. 19, November 14, 1974, Findings of Fact and Conclusions of Law, The Five Platters, Inc. v. 12819 Corp. and Robi, Los Angeles Superior Court, Case No. C43926	17

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CR #	Description	Tab #
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CR 56-22	PIH, Ex. 22, January, 1966, Oriental Booking Advertisement Program of "The Platters" with pictures of Robi, Taylor and Williams	18
CR 56-23	PIH, Ex. 23, April, 1970, Publicity photo of "Paul Robi, "World Famous Platters" in Buenos Aires	19
CR 56-24	PIH, Ex. 24, November 26, 1977, cover page of "Platters" Queensland Tour, Australia	20
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